

**IP4ENGINEERS**

**Intellectual Property  
Protection for Engineers**

**IP LAW**



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# Entrepreneurship

- What is an entrepreneur?  
Examples?
- what makes an entrepreneur?
- which skill set/competences are required to become successful?
- Advantages/challenges



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# CREATIVITY

- Creative thinking : the must-have ‘skill’ of an entrepreneur
- Creativity is not the exclusive domain of the arts
- Thinking outside the box



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# FOSTER CREATIVITY

- Brainstorming / Free flow of ideas
- Problem solving approach / Improvement of an existing product
- Icebreaking activities: eg. Playing with words / Ideas shower



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# IP

- protect the investments in creativity and innovation
- business development, marketing, product design, expansion through franchising and raising finance, etc



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# Successful businesses:

advantage over their competitors, a **unique selling point (USP)** that separates their business from other, similar businesses and gets people to buy/use/shop with them.

USP allows businesses to get ahead of the competition and take advantage of the hard work and effort they put into creating the innovation.



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# Intellectual property (IP)



legal rights



everyone's daily lives



branding, trademarks



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# Patents

-protection for an invention (product or process)

-prevent others  blocks technology and improvements  limited in time  20 years from its filing date



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# USA

Thomas Jefferson: "*inventions... cannot, in nature, be a subject of property*"

→ free competition

→ they are granted only when-and only to the extent that-they are necessary to encourage invention

→ intellectual property law must give as little protection as possible consistent with encouraging innovation



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# USA

The United States Supreme Court once considered that patentable subject matter included **‘anything under the sun that is made by man’**.



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# PATENTS

In Europe, 3 requirements:

- 1) Novelty
- 2) Inventive step
- 3) Industrially applicable



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# DISADVANTAGES OF PATENTS

- processing time
- publication of the technical details
- needs for annual renewal
- expenses

Thus, many big companies use other IP rights (see Coca Cola)  
+ patents do not protect products as such, but the innovation steps (draft in the patent claim)



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# PATENT REGISTRATION

- 1) in a **specific country** via the national Patent Office
- 2) in one or several European countries via the European Patent Office (**EPO**)
- 3) at global level via the World Intellectual Property Organization (**WIPO**)



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# ITALIAN PATENT REGISTRATION

- 1) Codice della proprietà industriale (CPI), Decr. Lgs. 30/2005, su tutela, difesa e valorizzazione dei diritti di proprietà intellettuale
- 2) Regolamento di attuazione del Codice della proprietà industriale (D.M. 33/2010)



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Ministero delle Imprese e del Made in Italy  
Direzione Generale per la Tutela della Proprietà  
Industriale  
**Ufficio Italiano Brevetti e Marchi**

**Compiti:**

- lotta alla **contraffazione**, anche a livello internazionale
- relazioni** con istituzioni e organismi europei;
- attività di **esame**, **concessione** dei brevetti/marchi nazionali, di convalida dei brevetti europei e gestione delle domande internazionali di brevetto;
- ideazione, definizione e gestione di nuovi strumenti per **favorire l'accesso** al sistema della proprietà industriale da parte delle start-up, interventi per agevolare la **prototipazione**



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# ITALIAN PATENT REGISTRATION

## BREVETTO:

Titolo giuridico che conferisce al titolare il **diritto esclusivo** di realizzare e commercializzare la propria invenzione, in un territorio e per un periodo determinato, al fine di:

- impedire ad altri di produrre, vendere o utilizzare tale invenzione senza autorizzazione
- consentire l'uso libero allo scadere del diritto (il brevetto è valido per 20 anni, poi **non può essere rinnovato né prorogato**)



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# PARTI DEL BREVETTO

- ❑ **Descrizione:** stato dell'arte; descrizione dell'invenzione; utilizzo in ambito industriale
- ❑ **Rivendicazioni:** caratteristiche specifiche dell'invenzione per cui si chiede protezione
- ❑ **Disegni:** senza testo; non sono consentite fotografie o riproduzioni di fotografie



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# PROCEDURA

- 1. Deposito domanda (@Camera di Commercio/UIBM)**
- 2. Tassa di deposito (da 50 a 600 euro)**
- 3. Esame preliminare da parte dell'UIBM**
- 4. Ricerca di anteriorità da parte dell'EPO + Rapporto di ricerca (consegnato all'UIBM entro 9 mesi)**
- 5. Eventuali emendamenti**
- 6. Esame della domanda e del Rapporto di ricerca dall'UIBM**
- 7. Rilascio brevetto italiano e possibilità di estensione con domanda europea**



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# BREVETTO EUROPEO EUROPEAN PATENT



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# MUNICH CONVENTION 1973 = EUROPEAN PATENT CONVENTION

- multilateral treaty = international law  
(not integral part to the EU system)
- all EU Member States
- EU patent = patent granted under the  
EPC = group of independent national  
patents



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# EUROPEAN PATENT

## Advantages

- Single procedure
- Determined and uniform scope of protection
- Payment of staggered fees

## Disadvantages

requirements of novelty, originality and industrial application in ALL contracting states



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# EPC PROCEDURE

EPO= EUROPEAN PATENT OFFICE

A single patent application, in one language, may be filed at the EPO in Munich, at its branch in The Hague, in Berlin, or at a national patent office of a Contracting State

+ Extension / Validation states



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# EUROPEAN PROCEDURE

1. Filing of application
2. Payment of initial application fees
3. **Formal examination** (Analyzes the application in light of the formal requirements) and **research report** (based on claims)
4. Publication of application 18 months after filing or priority date if required
5. Payment of examination and designation fee within 6 months from the date of publication of the research report
8. Application for background examination
9. **Background examination** (check for novelty, originality and industrial application)
10. **Rejection or Concession and publication** (with payment of concession fee)
11. Opposition



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**Article 52 EPC:** European patents shall be granted for any inventions, in all fields of technology, provided that they are new, involve an inventive step and are susceptible of industrial application.

(2) The following in particular shall not be regarded as inventions within the meaning of **paragraph 1**:

- (a) discoveries, scientific theories and mathematical methods;
- (b) aesthetic creations;
- (c) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers;
- (d) presentations of information.

(3) **Paragraph 2** shall exclude the patentability of the subject-matter or activities referred to therein only to the extent to which a European patent application or European patent relates to such subject-matter or activities as such.



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# Article 52(2) and (3) and Article 53 EPC).EXCLUSIONS:

1) Discoveries, scientific theories, mathematical methods, aesthetic creations, schemes, rules and methods for performing mental acts, playing games or doing business, programs for computers and presentations of information are not regarded as inventions and are excluded from patentability only to the extent that the invention relates to those areas as such. This is "a negative, non-exhaustive list.



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2) Inventions contrary to "ordre public" or morality, Plant or animal varieties and essentially biological processes for the production of plants and animals, and Methods for treatment of the human or animal body by surgery or therapy, and diagnostic methods practised on the human or animal body, which have been excluded for "socio-ethical considerations and considerations of public health". Products, "in particular substances or compositions", for use in any of these therapeutic or diagnostic methods are not excluded from patentability, however.



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# Application for a European patent

Art. 64 EPC: In each contracting state for which it is granted, a **European patent gives its proprietor the same rights as would be conferred by a national patent granted in that state.** If its subject-matter is a process, protection is extended to products directly obtained by that process. **Any infringement of a European patent is dealt with by national law.**



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# Agreement on the application of Article 65 EPC – the London Agreement – optional agreement for translation of European patents

**The official languages of the EPO are English, French and German.**

If you file your European patent application in any other language, you need to file a translation into one of the official languages of the EPO within two months of filing the application. If the translation is not filed in time, you will be invited to file it within two months of the notification of the invitation. If the translation is not filed within the time limit set in the invitation, the application is deemed to be withdrawn.



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# Patent reform: The Unitary Patent

unitary patent = a legal title that providing uniform protection across all participating countries in one step, with huge cost advantages and less administrative burdens + Unified Patent Court for a single, specialised patent jurisdiction with exclusive competence over European patents litigation



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**from June 1, 2023**

## **The Unitary Patent**

- ➔ Unitary Patent protection in up to 25 EU Member States.
- ➔ by submitting a single request to the EPO.

## **The Unified Patent Court**

- ➔ 25 EU Member States signed an international agreement to establish the Unified Patent Court (UPC), to which 17 are currently bound.
- ➔ new court for cases of infringement and validity of Unitary Patents and European patents.



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# WIPO

- 193 member states
- 26 international treaties
- Development Agenda – 2007: 45 recommendations to adjust WIPO's activities to the specific needs of developing countries and aim to reduce distortions



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# PATENT COOPERATION TREATY

## WIPO

➔ open multilateral treaty

➔ administered by WIPO

➔ any state can join



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**PCT procedure:** protection in multiple countries, both European and non-European, that are signatories to the Treaty

An **international patent** is **not** granted as a result of an international application, but a national patent is granted in each state designated in the application that decides to grant it

**The PCT is an application, not a patent**



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# PCT PROCEDURE

## BENEFITS:

- ❑ Single international patent application, in one language, at one receiving office, for multiple states in the world
- ❑ Longer time frame to choose the states in which to extend the patent (20 to 31 months from the priority date)
- ❑ Postponement of payments due to national offices
- ❑ Opportunity to amend claims, thanks to the International Search Report, before entering the national stage for patent issuance



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# PCT PROCEDURE

- 1) **preliminary international stage:**  
Application filed
- 2) **national stage:**  
Granting / Rejecting



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# PCT PROCEDURE

The international patent application corresponds to a national patent application in the PCT member states that are designated.

It should be written in one of the 3 official languages- **English, French, German.**

It can also be filed **in Italian**, but a **translation** into one of the official languages must be provided **within 1 month.**



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# PCT PROCEDURE -international stage-

- 1) International Application Filing
- 2) International Search Report
- 3) Publication of application and International Search Report  
(after 18 months)
- 4) Request for Preliminary International Examination  
(optional & non mandatory for national patent offices):  
opinion on patentability criteria (novelty, originality and  
industrial application)
- 5) Preliminary International Examination Report



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# PCT PROCEDURE

## International Search Report

The International Priority Search is conducted by the International Search Authority

➡ to ascertain the state of the art relating to the invention.

➡ 3 months

➡ does not evaluate the invention, but lists documents considered relevant and the international classification of the invention

➡ if the report is positive: good chance of obtaining the patent



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# PCT PROCEDURE

## -national stage-

➔ patents are granted by national or territorial offices.

The national phase begins 20 months after the priority date, which becomes 30 months if preliminary examination has been requested

National Offices of the designated states do not invite the applicant to enter the national stage

➔ failure to enter this stage results in the termination of the effect of the application for that state



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# PCT PROCEDURE-national stage-

National entry involves:

- application to the designated Office within the prescribed time limits,
- payment of the fees,
- designation of the inventor, if not present in the PCT application
- translation
- any other documentation required by the national law of that state

**The national or territorial patent offices will then be responsible for granting or rejecting the patent**



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**Italy (in line with other EPC member states) does not have a national phase**

➔ it is possible to obtain a patent in Italy through a PCT application, through the (automatic) designation of EP and by designating Italy at the European regional phase



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# UTILITY MODEL

=registered right that gives the holder **exclusive use of a technical invention**, in exchange for public disclosure of the workings of the invention and is granted for a limited period



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# Utility model / petty patent / innovation patent

- NO harmonised laws on utility models across the EU
- NO EU-wide utility model protection
- Regulation (EU) No 608/2013 applies to utility models.
- fast and low-cost protection for technical inventions  
(no substantive examination)
- more accessible to individual innovators or SMEs  
(in Italy, around 3500/per year)



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# SUPPLEMENTARY PROTECTION CERTIFICATES (SPCS)

=intellectual property right that serve as an **extension to a patent right.**

→ apply to specific pharmaceutical and plant protection products that have been authorised by regulatory authorities



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# Biotechnological inventions

Directive 98/44/EC on the legal protection of biotechnological inventions, the so-called ‘Biotech Directive’, implemented by all EU countries. Biotechnological inventions relate to products consisting of, or containing, **biological material**, or processes by means of which biological material is produced, processed or used. Such inventions are patentable if they fulfill the general requirements for patentability, i.e. novelty, inventiveness and industrial applicability.



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# Standard Essential Patents (SEPs)

A Standard Essential Patent protects technology that has been selected for use in a standard. Patented inventions that must necessarily be used when implementing a cellular communication standard are “essential” to that standard and should be made available for use under a patent licence on a Fair, Reasonable and Non-Discriminatory (FRAND) basis by their owners.

The FRAND principle is carefully balanced to ensure that cellular technology developers and implementers share in the benefits of cellular standardisation. It ensures that the inventors of cutting-edge telecommunication technologies – which have cost millions of Euros to develop and have been voluntarily contributed to the standardisation process – are guaranteed a fair return on their investment. It also ensures that connected hardware manufacturers have access to the cellular communications standard on a reasonable and non-discriminatory basis. FRAND facilitates the widespread use of the standard and ensures that each SEP owner is able to receive a return on the results of its R&D without gaining an unfair bargaining position.



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# TRADEMARK

IP right

- recognizable sign /design /expression
- detect the source /brand owner
- against brand piracy



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Trade marks → **identify** products

☞ the symbol customers use to pick a product/service out

Trade marks → **distinguish** you from your competitors

In some countries, protection even without trade registration (as long as it is used).

☞ must be clearly defined



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# COMMON LAW RIGHTS

→ protection for unregistered marks

≠

# TRADEMARK'S REGISTRATION

→ precondition for pursuing legal action  
against trademark infringement



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# Protection

- 1) Domestic level
- 2) EU level
- 3) International level



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# Symbols

1.™ ("trademark symbol", for unregistered trademark)

2.™ ("Service Mark", for unregistered service mark)

3.® ("original", for a registered trademark)



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# RIGHTS

Exclusive rights for the registered owner

→ exclusive use of the mark

→ prevent unauthorized use of the mark about products or services which are identical or "colorfully similar" to existing registered ones

→ in certain cases, prevent the use of entirely dissimilar ones

➔ depending on the **confusion test** for the consumer



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# "mark", "brand" and "logo"

are sometimes used interchangeably with "trademark"

"**Trademark**" also includes any device, brand, label, name, signature, word, letter, numerical, shape of goods, packaging, color or combination of colors, smell, sound, movement or any combination thereof which is capable of **distinguishing goods and services** of one business from those of others. It must be capable of graphical representation and must be applied to goods or services for which it is registered.



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# TRADEMARK REGISTRATION

- Trademark distinctiveness
- Maintaining rights
- continuous use
- renewal
- Enforcing rights
- Public policy



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# Sale

→ a trademark may be sold with or without the underlying goodwill which subsists in the business associated with the mark

# Licensing

→ the trademark owner (the licensor) grants a permit to a third party (the licensee) to commercially use the trademark legally



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# Trademark protection @ domestic level: ITALY

- A trademark application can be filed by anyone: natural person, legal person, associations, entities etc., including minors, including foreigners as long as they are domiciled in one of the EU countries.
- More than one person may be the owner of a trademark.
- Trademark application: Telematic mode (fast track); Paper mode at the Chamber of Commerce (CCIAA); Postal mode.



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# Trademark protection

## @ domestic level: ITALY

- Compliance with legal requirements
- choose the Classification of Goods and Services (Nice Classification)
- verify novelty + no infringement + no confusion

### ➤ FEES:

INDIVIDUAL MARK: 101€ for one class + 34€ for each additional class from the second

COLLECTIVE MARK: 337€ for one or more classes

Online filing: 42€ + no stamps

Paper application with the CCIAA: 16€ + 40 € stamps

Postal filing: 16€ + €40 stamps



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# THE NICE CLASSIFICATION

→ multilateral treaty administered by WIPO - World Intellectual Property Organization

→ the International (Nice) Classification of Goods and Services: 45 Trademark Classes  
(1 to 34 cover goods, and 35 to 45 cover services)

→ simplification: goods and services to which a given mark applies are classified the same in all countries that have adopted this system



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# Trademark protection @ EU level: European Union trade mark

- a trade mark registered in EU as a whole (rather than on a national level within the EU)
- unified trade mark registration system in Europe
- an objection against an EU trade mark application in any member state can defeat the entire application
- an EU trade mark registration is enforceable in all member states
- is administered by the **European Union Intellectual Property Office (EUIPO)**



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→it is valid for a period of 10 years  
→ may be **renewed indefinitely**  
→applicable rules of law are similar to those applied to national trade marks by the Member States



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## At the EUIPO you can register



### Word mark

A word mark consists exclusively of words or letters, numerals, other standard typographic characters or a combination thereof that can be typed.

[View examples](#)



### Figurative mark

A trade mark where non-standard characters, stylisation or layout, or a graphic feature or a colour are used, including marks that consist exclusively of figurative elements.

[View examples](#)



### Figurative mark containing word elements\*

A figurative mark consisting of a combination of verbal and figurative elements.

[View examples](#)



### Shape mark

A shape mark consists of, or extends to, a three-dimensional shape. It can include containers, packaging, the product itself or its appearance.

[View examples](#)



### Shape mark containing word elements\*

A shape mark that contains verbal elements.

[View examples](#)



### Position mark

A position mark consists of the specific way in which the mark is **placed or affixed** to the product.

[View examples](#)



### Pattern mark

A pattern mark consists exclusively of a set of elements which are repeated regularly.

[View examples](#)



### Colour (single) mark

A colour single mark is just that – a trade mark which consists exclusively of a **single colour** (without contours).

[View examples](#)



### Colour (combination) mark

A trade mark which consists exclusively of a **combination of colours** (without contours).

[View examples](#)



### Sound mark

A sound mark consists exclusively of a sound or a combination of sounds.

[View examples](#)



### Motion mark

A trade mark that consists of, or extends to a **movement** or a **change** in the **position** of the **elements** of a mark.

[View examples](#)



### Multimedia mark

It consists, or extends to, the combination of images and sound.

[View examples](#)



### Hologram mark

This is a new category of trade mark (as and from 1 October 2017). Hologram marks consist of elements with holographic characteristics.

[View examples](#)



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<https://euipo.europa.eu/ohimportal/en/trade-mark-definition>

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# FEES

the initial cost of filing an application to register an **EU trade mark** is much less than filing **separate national** applications in all EU member states

An online application at the EUIPO costs €850 and is filed in just one language. When we receive your application we check it and process it, and once registered, your trade mark can be renewed indefinitely every 10 years.



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# REGISTRATION IN THE EU

- 1) **protection in one EU Member State:** make a trade mark application at the relevant national IP office.
- 2) **protection at the regional level:** make an application to the Benelux Office of Intellectual Property (BOIP), the only regional-level IP office in the EU, for trade mark protection in Belgium, the Netherlands and/or Luxembourg.
- 3) **protection in more EU Member States:** apply for an EU trade mark from the EUIPO (EU trade mark is valid in all European Union Member States).

The national, regional and EU systems are complementary, and work in parallel with each other.



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# REGISTRATION IN THE EU

- Any signs, or designs, letters, numerals, colours, the shape of goods, or of the packaging of goods or sounds
- To be eligible for registration, your trade mark must be distinctive and must not describe what you sell.



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# Trademark protection @ international level: WIPO

## INTERNATIONAL LAW

→ The **Madrid Protocol** Concerning the International Registration of Marks (WIPO) gives trademark owners the opportunity to extend trademark protection in many countries by simply filing an application directly with the relevant national or regional trademark office.



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# Madrid system

→ centrally administered system for securing trademark registrations in member jurisdictions by **extending** the protection of an "international registration" obtained through the World Intellectual Property Organization

→ This international registration is based upon an application or registration obtained by a trademark applicant in its home jurisdiction

→ The Madrid System is a convenient and cost-effective solution: file a single international trademark application and pay one set of fees to apply for protection in up to 130 countries.



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# Madrid system Trademark Law Treaty

→ establishes a system under which member jurisdictions agree to **standardize procedural aspects of the trademark registration process**

→ it is not necessarily respective of rules within individual countries

→ **eMadrid** : all the online tools and services

<https://madrid.wipo.int/>



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# USA APPLICATION PROCEDURE

- 1) the trademark owner applies with the United States Patent and Trade Mark Office to register the trademark
- 2) 3 months after, review by an examining attorney at the U.S. Patent and Trademark Office
- 3) If approved, publication for opposition
- 4) 30-days for third affected parties to file an opposition proceeding to stop the registration of the mark
- 5) provided that no third-party opposes, the mark is registered



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## Well-known status

Well-known trademark status is commonly granted to famous international trade marks in less-developed legal jurisdictions



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# Domain names

Enforcing trademark rights over domain name owners involves protecting a trademark outside the obvious context of its consumer market, because domain names are global



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→ **Cybersquatting or domain squatting:** registering, trafficking in, or using an Internet domain name with bad faith intent to profit from the goodwill of a trademark belonging to someone else. The cybersquatter then offers to sell the domain to the person or company who owns a trademark contained within the name at an inflated price

→ **Typosquatters** : is a form of cybersquatting, and possibly brandjacking which relies on mistakes such as typos made by Internet users when inputting a website address into a web browser

→ **Gripe sites:** A gripe site is a type of website that is dedicated to criticism of or complaint about a certain individual, sometimes constructive and other times for the purpose of lampooning the target



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# SOFTWARE AND COPYRIGHT

In Europe, software is protected by copyright.

Copyright, and related rights, are protected since their first publication.

No formal fulfillment is required for copyright to arise.

The affixing of the © symbol is for informational purposes only; it is neither mandatory nor necessary for copyright protection.

The user license defines the way copyright in software is administered.

## Software protection

Although some legislations provide for the patentability of software (as an algorithm), the European legal system provides that computer programs are protected by copyright.

In Italy, Article 1 paragraph 2 of Italian Law 633/1941 specifies that "computer programs are protected as literary works."

Since software is developed in the form of source code, it looks a bit as a set of manual instructions for the computer to function.

Thus, software protection specifically covers the source code by means of copyright protection.



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# SOFTWARE AND LICENSES

User licenses indicate how the software is to be used as established by the author.

The same software may be distributed under two (or more) different licenses.

Software is "proprietary" when it is released under a license that places high restrictions on the user, effectively leaving it up to the owner/author alone to modify, copy and distribute.

Software is "free" ("free, not free," as defined by the Free Software Foundation) when it is covered by a license that grants the user the 4 freedoms: to use, study, modify and distribute. Such a license is **copyleft**, and also requires that the original software and its derivatives be distributed under a similar license, preventing anyone from imposing any restrictions on it.



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# SOFTWARE AND LICENSES

Software is "open source" (as defined by the Open Source Initiative) when it is distributed with open source code and under a license that simultaneously satisfies these conditions: free redistribution of the software and derivative works; no discrimination against persons or groups, or against certain industries; and distribution of the license, which must not be specific to a product or place restrictions on other software.

Even distributors of proprietary software can provide for different licenses, particularly in order to separate different types of users (home, professional, business), to be charged different prices. This is possible, although usually the software for each user has differences that eliminate the problem at the outset, being in fact considered different software, each passable under its own specific license.



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# SOFTWARE AND PATENTS

In Europe, software as such is not patentable.

However, if it contributes to the solution of a technical problem, it is potentially patentable.

The 1973 Munich European Patent Convention (EPC) excludes software from being patentable, not recognizing its own characteristics as an invention. But the issue is controversial.

The European Patent Office (EPO) has made ambiguous decisions over time: arguing, first, that software cannot by its very nature have technical character, and therefore is not considered a patentable invention; but then specifying that its execution by hardware can contribute decisively to solving a technical problem, thus itself assuming the technical character required for patenting.



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# Database protection

Databases must be divided in two target groups:  
databases with/without creative character.

**(a) database with creative character:** there are no strict rules to determine when and if the requirement of creative character is satisfied. By way of example, it may be considered a creative database one including an original choice of materials, or organized in a peculiar way.

Whenever the database is considered of creative character, it benefits in Italy from full copyright protection (70 years from the death of the author);



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# Database protection

**(b) database without creative character:** the creator/inventor has the right to prohibit the operations of extraction or reuse of the whole or a substantial part of it. This right can last up to 15 years from the establishment of the database. This is a peculiar right, which the creator can freely and discretionally decide to enforce or not.

The discipline above refers to the database itself and not to the materials it contains, which are protected by their own independent copyright regimes.



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