

IP Consult Series 2010

Intellectual Property Office of Singapore & Singapore Manufacturers Federation

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Intellectual Property

- ***Inventions – Patents & Trade Secrets***
- ***Trade Marks – Registered ® & Unregistered™***
- ***Copyright © – Literary, Artistic etc.***
- ***Designs – Registered & Unregistered***
- ***Others – CLR (unregistered), PBR (registered)***

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What are Intellectual Property Rights?



TREK 2000[®]
Thumb Drive[®]
Flash Memory Device

REGISTERED DESIGNS

Shape of device

CIRCUIT LAYOUT RIGHTS

IC Layout

PATENT

Hardware & Software

REGISTERED TRADEMARKS

"Thumb Drive" & "TOUCH"

GET UP & REPUTATION

Packaging & Unreg TM's

COPYRIGHT

Software & User Manual

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Registered Designs

“Features of shape, configuration, pattern or ornament applied to an article by any industrial process, being features which in the finished article appeal to and are judged by the eye”

- **Must be “new” design applied to an article**

- **But it may be previously owned design applied to another article**

- **Does not extend to**
 - *Function*
 - *Colour*
 - *Material*

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Registered Designs

- **15 year term from filing; 5 + 5 + 5 years**
- **Relatively cheap cf patent**
- **Relatively narrow form of protection**
- **Be careful that product on shelf is the same as registered design**

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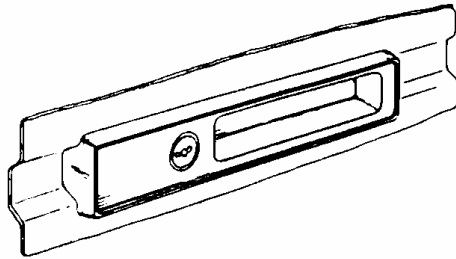
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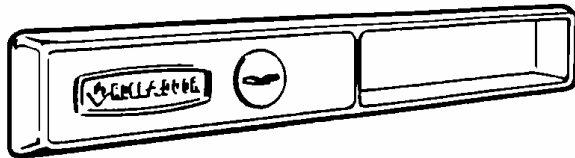


Registered Designs

Visual appearance which appeals to the eye.



Firmagroup Design



B & D Design

The B & D design was held not to infringe the Firmagroup registered design.

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Patents

- *What is an Invention ?*
- *What is a Patent ?*
- *What are the Requirements ?*
- *Patent Procedure*
- *Examples*

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What is an Invention ?

- *It is a new solution to a problem*
 - *Cheaper or faster to produce*
 - *Better performance*
 - *More reliable*

“Anything under the sun made by man”

Diamond –v- Chakrabarty 447 US 303,309 (1980) (Supreme Court)

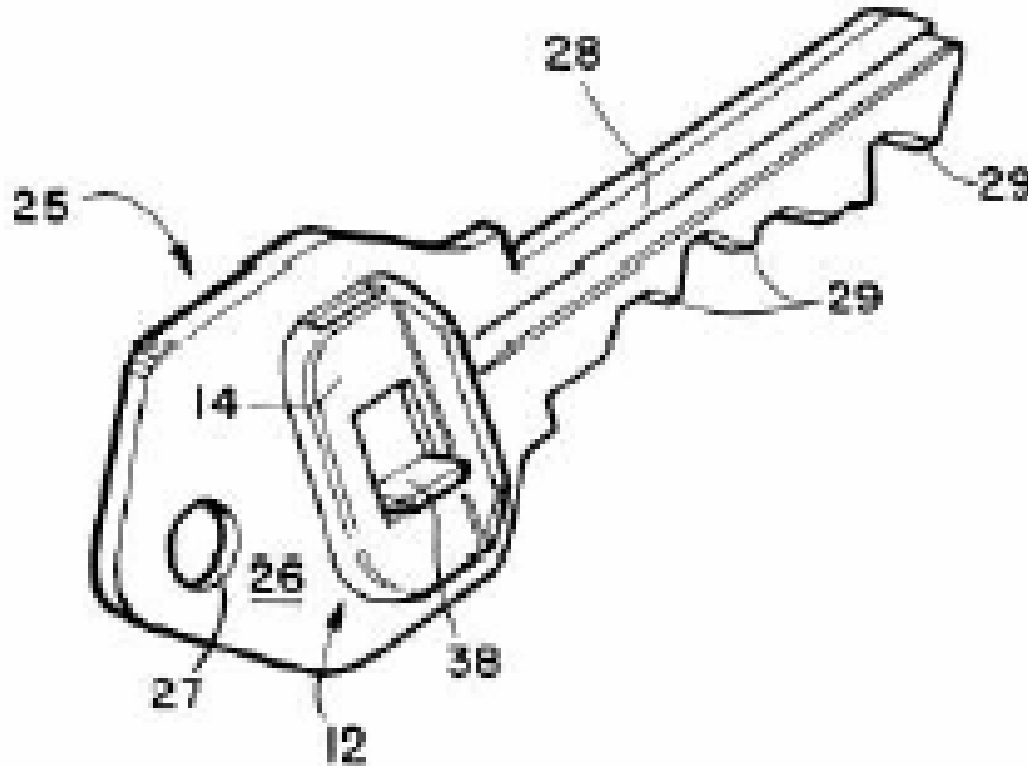
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US 6,575,005 : *Locked/Unlocked Indicator for a Key*



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Beware of Solutions Looking for Problems

- **Is it commercially oriented or merely an interesting technical effect ?**
- **Is there a global market for it ?**
- **Does it have potential for “stellar growth”**

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What is a Patent ?

- *A document giving a legal description of an invention*
- *It provides a legal right analogous to any type of tangible property. It can be :*
 - *Sold*
 - *Licensed*
 - *Mortgaged*
- *It is a right to stop someone using your invention*
- *It is not a right for you to use the invention*

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United States Patent

Grants to the person(s) having title to this patent the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States of America or importing the invention into the United States of America for the term set forth below, subject to the payment of maintenance fees as provided by law.

What are the Requirements ?

*Anything that has been done
or published anywhere in the world*

- **Novelty : Is the invention exactly the same ?**
- **Inventive Step : Is the invention “obvious” ?**
- **Industrial Applicability : Can you sell it ?**

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Searching the Prior Art Base

- *Literature Search*
- *Patent Databases*

http://ep.espacenet.com/advancedSearch?locale=en_EP
(Global Patent Search - European Patent Office)

<http://www.google.com/patents>
(US Patent Search - Google)

www.wipo.int/pctdb/en/search-struct.jsp
(Search for PCT Applications - WIPO)

<http://www.surfip.gov.sg/>
(IP Search Portal - IPOS)

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What is the Procedure ?

Filing the Application – A Typical Option

- It must be secret up to the date of filing (priority date)
There are some exceptions
- File in Singapore first – protected everywhere for 12 months
- File overseas within 12 months
- File PCT to further extend 18 months
- Must make final decision within 30 months of first filing

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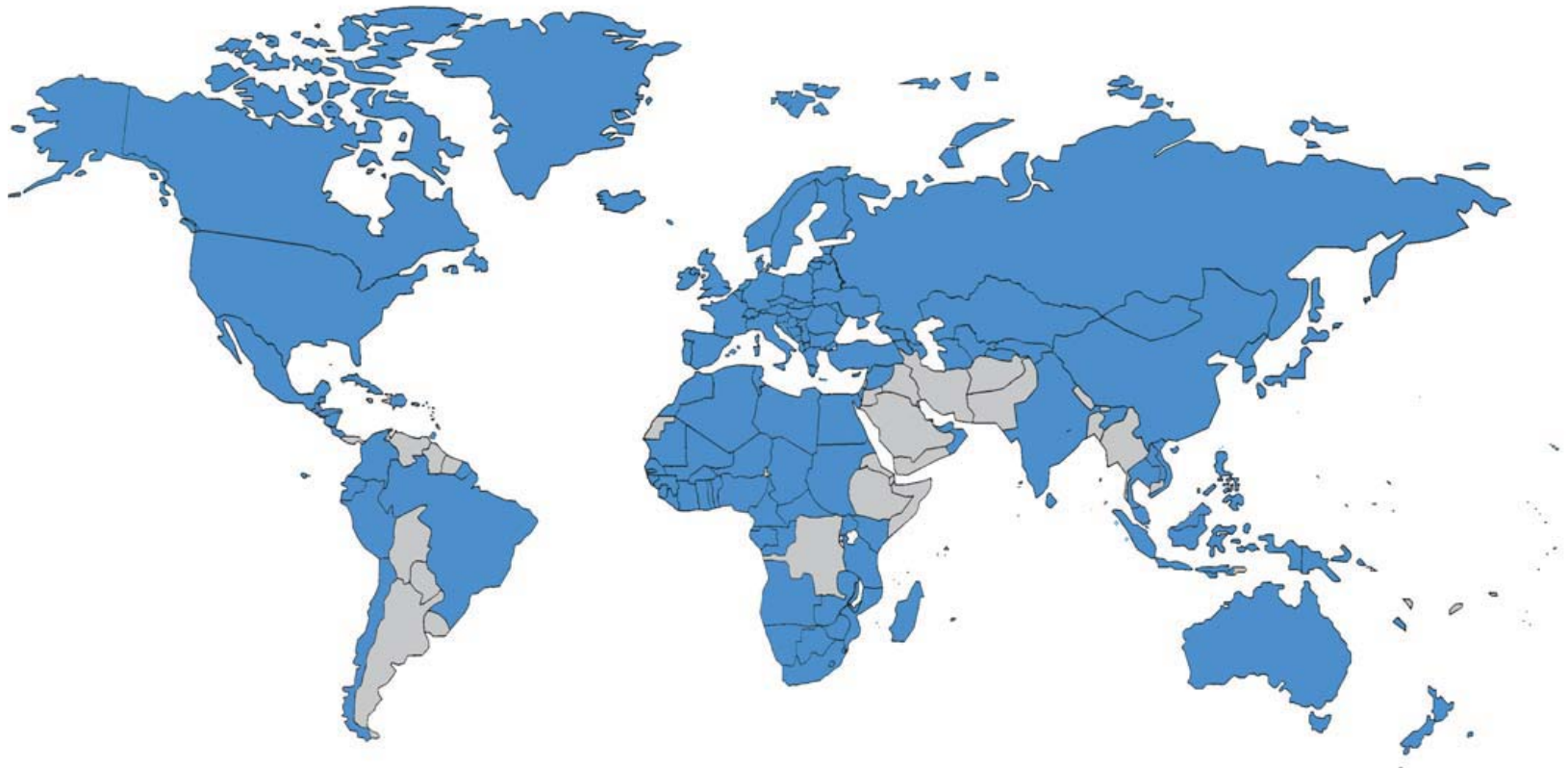
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PCT Contracting States

142 as at 1 May 2010



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Commercial Issues for Intellectual Property Rights

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Issues for Discussion

A. Patent Assessment Process

B. Infringement

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Patent Assessment Process

- *Invention Assessment*
- *Economic Assessment*
- *Filing Strategy*
- *Effective Life*

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Invention Assessment

- **Patent –v- Trade Secret**
 - *Every patent application must be published to the world 18 months after filing*
 - *You must describe the best way of performing the invention*
 - *A trade secret is secret until you release it (or it escapes)*
 - *Unauthorized release may be actionable*
 - *But once its out, its out.*

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Economic Assessment

➤ *Economic Considerations*

- *A patented product should command a premium price*
- *Does that premium cover the patenting costs ?*
- *Do I really need a patent in every country*
- *If my main markets are US and Taiwan, what happens if someone makes it in China ?*

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Filing Strategy

- ***Where to File***
 - ***First Filing : SG; Provisional; PCT***
 - ***Convention Countries : GCC; TW***
 - ***National Phase Entry***

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Effective Life of Patent

- **Effective Commercial Life of Invention**
 - *If my proprietary software is obsolete in 6 months, should I patent this ?*
 - *If the industry changes standards every 5 years, should I keep paying maintenance costs ?*
 - *What if the basic idea is still valid, but I didn't anticipate the change in technology ?*

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What is Infringement ?

If an article or process embodies every the feature of at least one claim of a granted patent, in the country in question, it will be deemed to infringe that claim.

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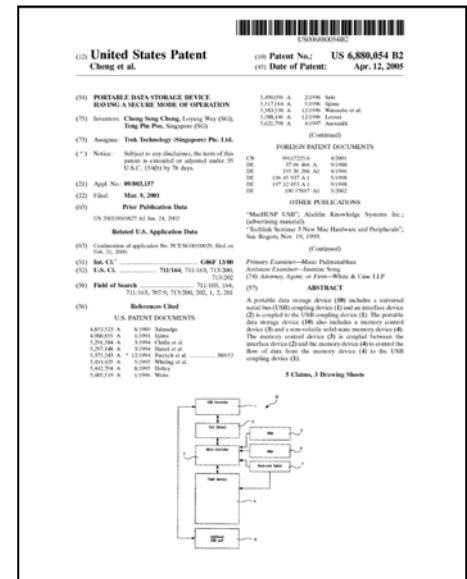
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Patentability –v- Infringement #1

US Patent No 6,880,054 “Portable Data Storage Device having a secure mode of operation”



Flash memory device which connects directly to a USB port

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Patentability –v- Infringement

Improvement on US 6,880,054 – Add a biometric Scanner



Start selling in US

What happens now?

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Issues for an Owner of a Patent Application

- Select the most relevant IPR – Patent/Design
“Thicket Strategy”
- Confirm infringement/validity in that country
- Can the application be expedited?
- Would a divisional application help?

Do not threaten
Do not delay

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Issues for an Owner of a Patent Application

When, and only when, the patent claims are in a good condition

- Negotiate : “best licensee is often a potential infringer”
- Demand : Cease & desist; render up all infringing goods
- Issue proceedings

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Issues for a Potential Infringer

Patent Application

- Watch Brief : “Fore warned is fore armed”
- Validity: “There's many a slip twixt cup and lip ”
- Has a threat, direct or indirect, been made?

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Issues for a Potential Infringer

Granted Patent

- If full infringement
 - Mitigate Loss
 - Re-design to prior art
- If no infringement, or invalid patent
 - “Keep powder dry”
 - Umbrella strategy

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Issues for a Potential Infringer

Granted Patent

- Leverage

Cross license improvements over original invention

Relevant, or close, prior art

Pending opposition/re-examination

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Thank You

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