

IP / IT LAW

PLAN (1)

➤ **PART I: INTELLECTUAL PROPERTY LAW**

- Title 1: Intellectual Property- General points
- Title 2: The right of the Intellectual Property
 - Chapter 1: Trademark
 - Chapter 2: Patent
 - Chapter 3: Domain name
 - Chapter 4: Industrial Design
 - Chapter 5: Copyright

PLAN (2)

➤ **PART 2: INFORMATION TECHNOLOGY LAW**

- Title 1: E business
- Title 2: Private Data

➤ **PART 1: INTELLECTUAL PROPERTY LAW**

Title 1: General points

❖ **Intellectual Property**

Intellectual Property consist of **two** parts:

➡ The Literary and Artistic Property (LAP)

➡ The Industrial Property (IP)

❖ The difference between LAP and IP :

LAP

- The protection is granted to the work because of the only fact of its creation.

INDUSTRIAL PROPERTY

- The registration at an office to obtain a right is an compulsory.

❖ Definition

All of such IP rights are exclusive rights allowing their owners to acquire a **monopoly to exploit** of the rights' object, within given territory.

→ Policy of the fight against the counterfeiting

❖ The main sources of the IP

- Intellectual Property Code
- Paris Union Agreement about the Industrial Property protection
- Berne Agreement about the copyright
- Other International agreements
- Case law

Websites: www.inpi.fr ; www.oeb.org; www.oami.europa.eu;
www.afnic.fr

➤ Title 2 : The IP rights

CHAPTER 1: TRADEMARK

I / The granting and the legal consequences

❖ Definition

Trademark = Title of industrial property granted by an office in order to protect a sign capable of **graphic representation** used to distinguish the goods and/or services of a person or an entity.

The trademark protects the goods and/or services designated by the applicant when the registration proceeding.

❖ Validity of the sign → 3 requirements

- Lawful sign (1)
- Distinctive sign in relation to goods and services designated (2)
- Available sign (3)

1. Types of signs

- Word signs
- Audible signs
- Figurative signs unwritten

❖ Unlawful signs

- Signs contrary to public order and morality
- Signs misleading (« *deceptive* »)
- Specific prohibitions ex: Olympic motto

2. Sign distinctive in relating to goods and/or services designated

Ex: the word « *chocolate* » does not consist of a valid trademark if it designs the chocolate as a product, but it is distinctive for clothes or mobile phone.

3. Availability of the sign

→ This trademark should not have been registered

- **Principle**: A sign is unavailable when it has been already registered as trademark in the **same business sector** and on the **same territory**.
- **Exception**: the **well-known** mark → the business sector and the territory are irrelevant.

❖ Legal effects and owner

- Exclusive right allowing to the owner a monopoly to exploit its trademark.
- The duration of the protection is **10 years**, renewable without limitation.
- The owner is the **first applicant**.

II / The registration proceeding of a trademark

1. The application file at a specific office

- National Trademark → INPI
- Community trademark → OHMI
- International trademark → OMPI

The proceedings for international and community trademarks are similar as the French proceeding.

The trademark is delivered after the exam of the material requirements and formal requirements.

→ No prior rights research by the office.

► **Two options** for the office:

**REJECT OF
THE
APPLICATION**

**ADMISSION OF
THE
APPLICATION**

Registration at the National Register of the
Trademark (NRT) at the **application date**

Publication in the BOPI (opening of the opposition
period)

2. Tax payment

- In front of all the offices, the file for the registration of trademark must be accompanied by the payment of taxes (proof)
- The amount of taxes depends on each office and on the number of goods and/or services classes designated in the application.

III / The exploitation of the Trademark

❖ The exploitation

- The Trademark can be exploited by its owner **directly or indirectly** (assignment, license).
- Requirement: To register in the RNT any act by which the TM holder transmits or modifies its trademark rights.

❖ Termination of the protection

- The protection can be terminated by decision of the trademark holder (voluntary cancelation), but also by an **action for revocation** of the Trademark.

➔ Any interested person may apply to the court the cancelation of a trademark which is not exploited during **5 years uninterrupted**.

CHAPTER 2: PATENT

I / The granting and legal consequences

❖ Definition

Patent = an industrial property title delivered by an specific office in order to protect the inventions.

Invention = technical solution to a posed problem

❖ Validity of the patent → 3 requirements

- The invention must be **new** (1)
- The invention must imply an **inventive step** (2)
- The invention must be **capable of industrial application** (3)

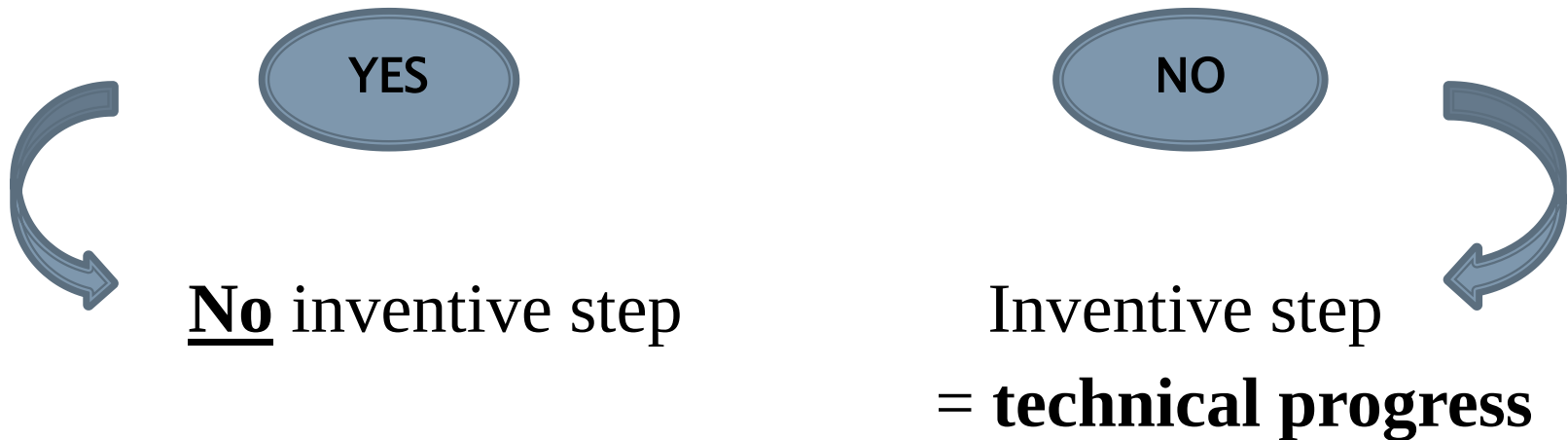
1. **The novelty** → Absolute condition

An invention shall be considered to be new if it does not form part of the **state of the art**.

State of art = Any information available to the public at the application date

❖ Inventive step → “person skilled in the art”

The question is: Compared **to the state of the prior art**, the invention claimed is not obvious to a person skilled in the art ?



❖ Industrial application

Industrial application: when the subject of the invention may be **manufactured or used** in all industries including the agriculture.

II / The application proceeding of a patent

❖ Application of patent at an office

- INPI for the national patents
- European Office of Patents (OEB) for the community patents **
- OMPI for the international patents

1. Step of the granting in front of the INPI

- Application exam (administrative check)
- Production of a prior art report by the INPI
- Publication (18 months from filing date)

2. Form of the application patent (5 parts)

- The **application** (identification of parties, invention, title requested)
- A **descriptive part** (the state of the prior art, its technical effects and the invention itself)
- An **abstract** that summarizes the technical content of the invention
- **Claims (!!!)** = sentences which define the scope of protection
- **Proof of payment of taxes** (application fee, annual fees gradual to retain the protection, any priority fee, additional taxes if more than 11 claims)

3. Effects of the publication

- Duration of protection → **20 years** from the application date
- Monopoly to exploit on the territory covered by the patent allowing the holder to make profit its invention (direct exploitation, assignment, license)
- Deadline of 3 months during which the third parties may formulate observations

❖ The holder of the Patent

■ **First applicant**

- Successor (heir, assignee, public authority having expropriated the holder)
- The person who won with a claim of ownership of patent (invention fraudulently withdrawn to its inventor OR violation of a statutory or contractual obligation)

➔ **Exception:** “The prior personal possession”

❖ **The cost of a patent**

- Filing fee
- Fee for the prior right report
- Issuance fee
- Additional fees (> the 11th claim)
- Fees for the legal person (lawyer, IP attorney)
- Gradual annual fees for the preservation of rights

CHAPTER 3: DOMAIN NAMES

❖ Definition

Domain names (DN): technical way of locating and accessing to web pages.

→ All the DN operate under a concordance called DNS (Domain Names System).

DN is made up of two parts minimum, separated by a dot:

- A top level domain name (1)
- A second level domain name (2)

1. Top level domain name (TLD)

- **The generic domain names** = suffix correspond to an activity sector.

Ex: “.org” for the organizations; “.com” for the company

- **The country code domains** = two letters correspond to the International Classification Code.

Ex: “.fr” for the France; “.eu” for the Europe

2. Second level domain name = Denomination freely

❖ The granting of the protection

Any domain name must be **registered** at an office accredited by a managing organization relating to the chosen extension.

Ex: Second level name “.fr” → AFNIC (*Association française pour le nommage internet en coopération*)

→ 3 requirements:

- The applicant freely chooses its domain name **
- The name chosen must not already registered
- The following rule: “First come, first served”

❖ The preservation of the domain name

A domain name is registered for a limited and renewal duration in accordance to the extensions and the agreements.

- The holder of the domain name shall pay an annual fee to retain its right.
- The renewal is necessary and involves an additional fee.

Nb: the assignment of a domain name is allowed. (The assignor must notify the registration office of this act).

❖ Defense of the domain name → implementation of procedures

→ Specific **administrative procedures**:

- UDRP procedure (suspension of the disputed domain name)
- SYRELI procedure (removal or compulsory transfer of the disputed domain name)

→ **Legal actions**: Risk of parasitism, unfair competition, defamation, ...

CHAPTER 4: INDUSTRIAL DESIGN

❖ Definition

Industrial design = combination of lines or colors presenting an original configuration, a graphical form consisted of a volume

Ex: creation of jewelry, automobile design

❖ Protection of industrial designs

Two possibilities: - Copyright (1)
- Industrial designs law (2)

1. Protection granted by the copyright

An **original** industrial design can be protected by the copyright because of the only fact of its creation, without prior formalities.

2. Protection granted by the industrial design law

→ Material requirements (4) :

- Ornamental
- Specific = concreteness design
- New
- Apparent

❖ Formal requirements

- The filing application by the designer or legal claimant (procedure for filing ordinary or simplified)
- Issuance of the filing certificate by the INPI
- Publication at the BOPI

❖ Legal effects of the protection by the industrial design

- **Monopoly** granted at the first depositor which shall be deemed to be the creator (until contrary proof)
- Duration of the protection: **5years** from the filing date, **renewal** possible per periods of 5 years, up to a limit of **25 years**.

❖ Exploitation of the ID

- The directly or indirectly exploitation (assignment, license)
- Any acts which modifies or transfers the ID rights must be registered at the National Register of Industrial Designs (NRID)

❖ Defense of the ID → Counterfeiting action

Note: Similar rules and effects → International ID → OMPI;
Community ID → OHMI; (Community DM not registered)

CHAPTER 5: COPYRIGHT

❖ Definition

Copyright = Incorporeal property right granted to an author on his work.

➤ Determination of the author

- **The author** = the authorship belongs to the person(s) under the name whose the work is disclosed (until contrary proof).
- He is at the origin of an intellectual work.

❖ The requirements of the copyright protection

■ Material requirements:

- A creation → creative effort / personal distinctive of the author
- The originality of the creation

■ Formal requirements: the protected works have to be fixed on a material support but there is no filing formality.

- The work and his copyright protection are deemed to exist on the only fact of the work creation.
- Exception: legal deposit in particular cases

❖ **Particular cases:**

- Creation generated by computer or assisted by computer **(1)**
- Virtual reality and artificial intelligence **(2)**
- Data bases **(3)**

1. **Creations made by computer or assisted by computer** (electronic and computer systems)

These systems are increasingly used for the creation of text, image, audio/video, data compilations.

→ The enforceability of the copyright varies in the following situations:

- Work generated by computer (a)
- Work assisted by computer (b)

a) Work generated by computer

A work made with a computer will be considered as a creation protected by the copyright, if it is not the result of simple technical manipulation, but of a **creative contribution** by the **computer engineer**.

→ An individual work is not a simply reproduction of existing elements or the result of mathematical calculations.

b) Work assisted by computer

- In this situation the **computer** is used as an **instrument**.
- The copyright protection is granted for the software and/or computer files, used by these programs.
- **Problem** = > The risk of similarities between the different works (ex: textile industry)
- **Legal Answer** = > If these similarities are due to functional constraints, the copyright does not applied (ID law either)

▶ **The copyright holder in the previous cases:**

→ New work **entirely created** by the computer engineer
of = he will normally be the author **

→ **New work integrating existing elements =
“composite work”**

The computer engineer who has created the new work is the author but this authorship is subject to the author permission of existing works.

→ **New work created by a computer manipulation of data without existing elements =** The author is also the computer engineer.

2. Artificial intelligence and virtual reality

- **The artificial intelligence** with the “**Expert systems**”

→ Traditionally 2 components of an “expert systems”:

- An interference engine
- A knowledge base → Can be protected by the copyright as a work of joint authorship or as collective work *

- **The virtual reality** = can consisted of an imaginary world or a real world.

→ imaginary world = copyright applicable

→ Real world = this will be **the technical realization** of this world which permitting the copyright protection and not the representation of the reality

3. Databases protections

- The copyright can be applicable = Protection of the database structure.
- A specific protection exists for the protection of the database content :

Producers = Any natural or legal person who takes the initiative and the risks in terms of **financial, material or human investments** (to be proved).

- **The producer rights**: can prevent the extraction and/or the reuse of all or substantial part of the database (except of the database which is available to the public)
- Duration of the protection = **15 years** after the database completion

❖ The legal effects and the author rights

Moral rights

- Authorship of a work
- Integrity of the work
- Right of disclosure
- Right to reconsider or withdraw

Duration of moral rights = No limit and hand on rights to the heirs.

Economic rights:

- Representation and reproduction rights
- Right of communication or making available to the public
- Distribution right
- Destination right
- Translation right
- Adaptation, arrangement or other transformation rights
- Rental right
- Lending right

Duration of the economic rights = 70 years