

Useful Websites

British Library Patents Collection

www.bl.uk/services/information/patents.html

DTI Intellectual Property

www.intellectual-property.gov.uk

World Intellectual Property Organization

www.wipo.int

Patent Office

www.patent.gov.uk

Chartered Institute of Patent Agents

www.cipa.org.uk

Institute of Trade Marks Attorneys

www.itma.org.uk

Intellectual Property Lawyers Association

www.ipla.org.uk

Kingsgate Chambers IP and Technology Group

www.nipclaw.com

What is Intellectual Property?

Basically, intellectual property is the collective name for a bundle of monopolies and exclusive rights granted by or on behalf of governments to encourage investment in research and development, the arts and design and efficient distribution of goods and services.

One example is a patent. It confers a 20-year monopoly of a new invention. If the invention is a new product, the person to whom the patent is granted ("the patentee") is the only one who may make, sell, import, use or keep it. If it is in demand a patent means that the patentee can charge more for it than he could otherwise. Also, he can negotiate royalties from those who would like to make or supply the product

Another example is a trade mark. Labels like Burberry, Levis and Microsoft promise quality and consistency to consumers. They buy goods with those marks even without seeing them because they trust the signs. Similar unlabelled goods may come from the same factory and be made by the same hands but they do not have the same appeal.

Because the rights described above are valuable they are called "property". Because they are granted to reward innovation, creativity or investment in marketing they are described as "intellectual." However, unlike movables, the criminal law does not comprehensively protect IP. If an IP right is infringed it is up to the owner to take civil proceedings and that can be expensive.

How to acquire Intellectual Property

Different types of IP are acquired in different ways. Some rights, such as copyrights and design rights, come into being automatically when a British citizen or citizen or resident of another country that has agreed to give similar rights to British citizens, writes a book or records a design in a drawing.

Other rights, such as patents, trade marks and registered designs, are granted upon application to a national or

regional intellectual property office. In most cases, the applicant for such right has to satisfy a number of legal requirements which are checked by officials known as "examiners".

Usually, members of the public can also object, either to the application or to the grant afterwards. If they can satisfy the intellectual property office or a court that the application should not be, or should never have been, the application will

be refused or the grant revoked or declared invalid.

Patentees and other IP owners are understandably surprised and indignant when their grant is challenged and sometimes revoked. The reason why these challenges are made and sometimes succeed is that it is impossible for examiners to make anything like the same enquiries before grant as the Patents Court or hearing officer can make in proceedings when the grant is enforced.

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IP Institutions

Patent Office: grants British patents, registered designs and trade marks and resolves certain disputes between IPR owners and third parties

European Patent Office: office in Munich that grants European patents valid for the UK and other countries under the European Patent Convention

OHIM: office in Spain that grants Community trade marks and designs

Patents Court: High Court judges assigned to hear patents and designs cases

Getting Professional Help—*who does what and where to find help*

There are three types of professionals who may be involved in acquiring, commercializing and enforcing intellectual property rights, namely

- patent and trade marks attorneys
- specialist solicitors; and
- patent counsel.

Each profession has different skills and specializes in different things though there is some overlap between them. While there is generally no legal requirement to get professional help of any kind in the UK, it is prudent to do so because IP is a very tricky area of the law. Very few people would feel confident in conveying a £500,000 house or drawing up a will without consulting a solicitor. The value of some inventions, films and sound recordings and brands can be many times greater, and the risks of something going wrong are very much higher.

Patent and Trade Marks Attorneys	Solicitors specializing in Intellectual Property	Patent Counsel
<p>Most patent attorneys are also trade marks attorneys but not vice versa. Patent attorneys prosecute applications for patents, registered designs and trade marks and trade marks attorneys applications for trade marks and sometimes designs. Some patent attorneys entitled to conduct litigation and argue cases before hearing officers and the Patents Court but most prefer to instruct counsel or refer litigation to solicitors.</p> <p>The Chartered Institute of Patent Agents and the Institute of Trade Marks Attorneys have searchable databases of members of those institutes (see overleaf for websites).</p>	<p>Specialist solicitors conduct enforcement and other IP litigation and advise on commercialization of intellectual property rights. Although many law firms claim expertise in IP, very few get enough work to develop expertise and nearly all of those who do are in London. Most specialist firms belong to the Intellectual Property Lawyers Association (see overleaf for website). Other practitioners may be identified from the Solicitors Online database but very great caution is required before instructing. Ask the fee earner whether he or his firm takes the Reports of Patents Cases and the Fleet Streets, when was the last time he was in the Patents or Patents County Court and what proportion of his work is IP.</p>	<p>These are barristers who appear before the Patents and Patents County Courts, the Patent Office and the Intellectual Property lists. They also advise solicitors, patent attorneys and others on difficult points of law and draft complex contracts and other business documents. As with solicitors, it is difficult to develop expertise without doing the work regularly. Most IP specialists are members of the Intellectual Property Bar Association. It used to be necessary to ask a solicitor or other professional to instruct a barrister but it is now possible to get a licence from the Bar Council to approach counsel directly. The rules are likely to be relaxed still further during 2004.</p>

Where to make a Start?

A good place in Manchester is Central Library. The technical library has an extensive collection of British, European and other patents as well as many other materials. It also distributes leaflets from the Patent Office. It operates a patents clinic staffed by a local patent attorney between 2 and 6pm on the third Tuesday of every month. Free appointments may be booked on 0161 234 1987. The library is in St Peter Square, Manchester M2 5PD.

Similar collections in the North are at Leeds, Sheffield, Liverpool and Newcastle public libraries. Patent clinics are also held in all of those cities. Details of those clinics may be obtained from the CIPA or British Library websites.

There is a massive volume of information about intellectual property on the internet. People without legal training and non-specialist lawyers will probably find the British Library, Patents Page the best place to start. The DTI Intellectual Property site is also good as are the Patent Office and WIPO.

Insurance

Save for counterfeiting and piracy there is no protection for IP under the criminal law. IPR owners cannot even rely on business ethics to deter infringement because it is often possible to hold differing views on a patent's scope or validity quite honestly and reasonably. Great care has to be taken even to bring a complaint to a potential infringer's notice because certain words or conduct threatening proceedings may be actionable in patents, trade marks and designs cases. It is important to obtain IP insurance from the moment the IPR is obtained. Insurance cover can be expensive and it is not perfect but it is a good deal better than nothing. There are a number of companies that offer IP cover and these are listed on www.ipwales.com and www.makesparkfly.com.

A Word About Us

This primer has been prepared by John Lambert and Alex Khan of Kingsgate Chambers, Manchester. We are both members of the Intellectual Property Bar Association and to the best of our knowledge and belief are the only ones in the North of England.

John Lambert has the better part of 20 years practical experience of this field and has advised or appeared for over 70 local law firms in IP and related matters since setting up NIPC in 1997. Alex Khan earned his doctorate in life sciences and is developing expertise in biotech and pharmaceutical patents and plant varieties. Although we are not yet allowed to accept instructions directly from, or give legal advice to, the public, we will be glad to talk about IP generally. Anyone who wishes to discuss any matter raised in this primer should write to
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