

## PATENT LAW WORKSHOP SCRIPT

### Introduction

Özlem will introduce herself and qLegal.  
Secondly Ayşenur will introduce herself.

We will be asking you lots of questions throughout the presentation and we will discuss, please feel free to raise your hand or directly chime in.

We will have quizzes in between; they will help you consolidate what you have learnt.

We will have 15-minute break.

The slides will be shared afterwards.

Ozlem:

*-Guinness bottle opening-*

The workshop will begin with a Guinness bottle opening which is our patent professor's lecture opening. It starts with showing the bottle to the audience saying that:

We introduced ourselves and now we want to introduce our mystery item (bring the bottle out of the case). This is as you see a beer bottle but there is something significant and unique about it that it is patented. Could you please make a guess and try to find the patented part of this bottle?

(After students guessed, we move on to the answer and show the widget) I did a little experiment last night. Warning: Don't try at home! And took out our little answer for you. This is a widget ball. (Then we will explain the following description briefly and show the patent saying: ) Now, we introduced ourselves and our mystery friend, let's see the patent.

Further Information about the Guinness Bottle

How they describe their widget- <https://www.guinness.com/en-gb/our-craft/guinness-innovation>

Description of the widget during the presentation:

“Most beers are carbonated with carbon dioxide (CO<sub>2</sub>). When the beer is in the can some of this CO<sub>2</sub> is dissolved in the beer and some is at the top of the can. The CO<sub>2</sub> that is dissolved in the beer is what makes it fizzy. When the can is closed the pressure inside is higher than the pressure outside, so that when you open the can the sudden drop in pressure and the agitation of pouring causes some of the CO<sub>2</sub> to bubble out of solution, forming a head on your beer.

A stout like Guinness has a creamier, longer lasting head than a canned lager beer. In addition, Guinness is less fizzy than a regular lager beer. Guinness is canned with a mixture of carbon dioxide and nitrogen. Nitrogen is not absorbed into the beer nearly as well as carbon dioxide, so even though a can of Guinness may be at the same pressure as a can of lager, it contains less CO (and is therefore less fizzy) because the nitrogen makes up some of the pressure.

Because a beer like Guinness contains less dissolved CO<sub>2</sub>, if you poured it from a can with no widget, the head not be very thick because most of the CO<sub>2</sub> would stay dissolved.

The purpose of the widget is to release the CO<sub>2</sub> from some of the beer in the can to create the head. The widget is a plastic, nitrogen-filled sphere with a tiny hole in it. The sphere is added to the can before the can is sealed. It floats in the beer, with the hole just slightly below the surface of the beer.”

Their US patent to be shown to the students:

**United States Patent** [19]

Forage et al.

[11] **Patent Number:** 4,832,968

[45] **Date of Patent:** May 23, 1989

[54] **BEVERAGE PACKAGE AND A METHOD OF PACKAGING A BEVERAGE CONTAINING GAS IN SOLUTION**

[75] **Inventors:** Alan J. Forage, Seer Green, Great Britain; William J. Byrne, Mount Merrion, Ireland

[73] **Assignee:** Arthur Guinness Son & Company Limited, Dublin, Ireland

[21] **Appl. No.:** 916,656

[22] **Filed:** Oct. 8, 1986

[30] **Foreign Application Priority Data**

Nov. 29, 1985 [GB] United Kingdom ..... 8529441

[51] **Int. Cl.<sup>4</sup>** ..... B65D 85/72

[52] **U.S. Cl.** ..... 426/112; 426/115; 426/124; 426/131; 426/394; 426/398; 426/407; 53/79; 53/127

[58] **Field of Search** ..... 426/112, 115, 124, 131, 426/316, 474, 477, 394, 398; 53/79, 127

[56] **References Cited**

**U.S. PATENT DOCUMENTS**

3,085,714	4/1963	Lighter	
3,513,886	5/1970	Easter et al.	426/115
4,147,808	4/1979	Liepa et al.	426/477
4,186,215	1/1980	Butchel	426/477 X
4,399,158	8/1983	Bardsley et al.	426/124 X
4,518,082	5/1985	Ye	426/124 X
4,693,902	9/1987	Richmond et al.	426/521

**FOREIGN PATENT DOCUMENTS**

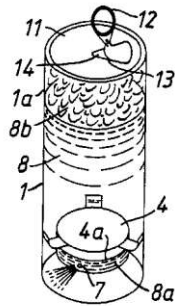
1266351 3/1972 United Kingdom  
 1588624 4/1981 United Kingdom

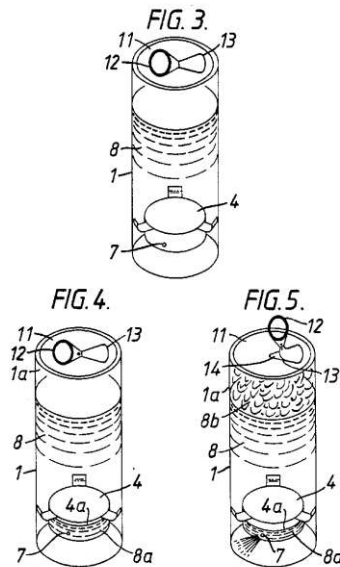
*Primary Examiner*—Barry S. Richman  
*Assistant Examiner*—Timothy M. McMahon

[57] **ABSTRACT**

A beverage package and a method of packaging a beverage having gas (preferably at least one of carbon dioxide and inert (nitrogen gases) in solution) has a non-resealable container 1 within which is located a hollow pod 4 having a restricted aperture 7 in a side wall. The container is charged with the beverage 8 and sealed. Beverage from the main chamber of the container enters the pod 4 (shown at 8a) by way of the aperture 7 to provide headspaces 1a in the container and 4a in the pod 4. Gas within the headspaces 1a and 4a is at greater than atmospheric pressure. Preferably the beverage is drawn into the hollow pod by subjecting the package to a heating and cooling cycle. Upon opening the container 1 by draw ring/region 13, the headspace 1a is vented to atmosphere and the pressure differential resulting from the pressure in the pod headspace 4a causes gas/beverage to be ejected from the pod (by way of the aperture 7) into the beverage 8. Said ejection causes gas to be evolved from solution in the beverage in the main container chamber to form a head of froth on the beverage. The pod 4 is preferably formed by blow moulding and located as a press fit within the container 1 which latter is preferably a can, carton or bottle.

35 Claims, 2 Drawing Sheets





**Why do you think they applied for a patent and revealed their secret?** (question to the audience).

**What is intellectual property? IP slide**

Why the law is involved? Why do we have IP law? So that people can benefit from their ideas and to encourage innovation.

**What to expect today:** (Talking about what we are going to cover today: Ayşenur)

We are going to talk about patent law and how it applies to you. We will introduce '6W&1H' questions which we can also refer as 'patent FAQs'. These are also the questions that we discussed with your friends on our initial call.

These are: WHAT- WHY- WHEN- WHO- HOW- SO WHAT- THEN WHAT.

- According to this we will answers the questions of: What is a patent, what can be patented, what cannot?
- Why do engineers/companies apply for patent?
- When can you apply for a patent? What are the requirements?
- Who can apply for the patent? Who owns the patent? Do you need help in the application process?

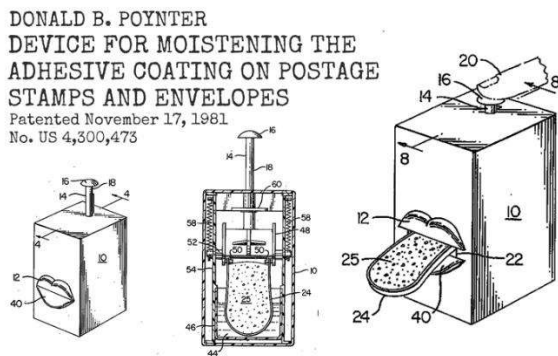
- How do you apply for a patent? What is the process? How much does it cost?
- You applied for a patent, so what?
- And last but not least- You are granted a patent, then what?

We strongly believe in the importance of a practical approach so we will be discussing patent examples as much as possible and the story behind a patent document.

Before we go into the substance we would like to show you some old patents. WIPO chooses ‘weird and wonderful’ patents each year. Let’s take a look:

### WIPO’s Patent Picks

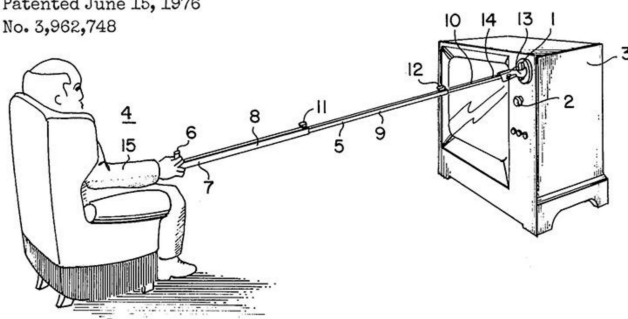
#### Device for Moistening the Adhesive Coating on Postage Stamps and Envelopes (1981)



Do you like sending handwritten letters but dislike the taste of envelope and postage stamp glue? In 1981, Donald B. Poynter patented a solution: “an apparatus for moistening the adhesive coating on a postage stamp, envelope or the like”. The device features a plunger that lifts “an absorbant applicator from the liquid and passes the applicator through an opening in the side of the enclosure”. And, of course, function meets form for this device: “the applicator may be in the form of a human tongue and the closure may be in the form of a human lip”. Now that’s a clever hack!

#### TV Control Device (1976)

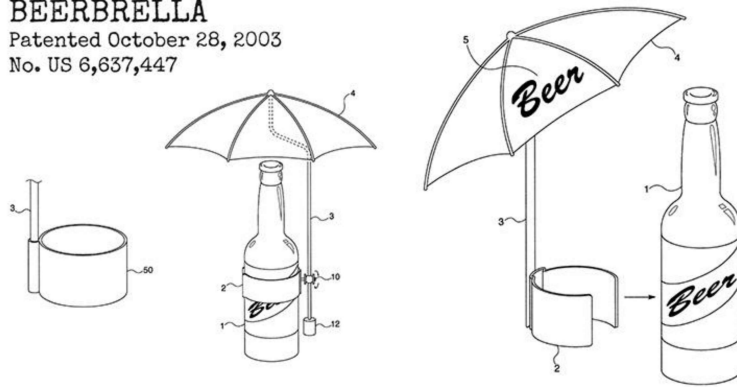
CHRIS T. MICHAELS  
 TV CONTROL DEVICE  
 Patented June 15, 1976  
 No. 3,962,748



This TV control device, patented by Chris Michaels in 1976, allows you to change channels, adjust volume and more from the comfort of your sofa. Resembling a pool cue, the rod is of “variable adjustable length” and “considerably less expensive than its electrical and electronic counterparts, and functions efficiently” – the patent explains. And it’s for sure easier to find than a misplaced classic remote control.

## Beerrella (2003)

MASON SCHOTT MCMULLIN; ROBERT PLATT BELL;  
MARK ANDREW SEE  
**BEERRELLA**  
Patented October 28, 2003  
No. US 6,637,447



Nothing is worse than a lukewarm beer (or soft drink) on a hot summer day – or any day for that matter. And who said umbrellas are only for humans? Inventors Mason Schott McMullin, Robert Bell and Mark Andrew See obviously agreed, patenting a unique beverage accessory. Their invention features a small umbrella “which may be removably attached to a beverage container in order to shade the beverage container from the direct rays of the sun”. Practical and stylish!

After looking at the examples, our first question to you is what do you think patent protects? - Ayşenur

### First Menti Quiz:

What does patent protect?

-There will be 4 options.

- (a) an easily recognisable symbol, phrase, or word (Trade mark)
- (b) original works such as drawings (Copyright)
- (c) functional innovations – right answer
- (d) aesthetic, design (Design rights)

(Give the brief description of trademark-copyright- design and patent)

### **What is a patent?**

Patent is an exclusive right granted for an invention. In other words, a patent is an exclusive right to a product or a process that generally provides a new way of doing something or offers a new technical solution to a technical problem.

Patent allows the owner of the patent (the patentee) to take legal action against others who use their invention without permission.

A patent owner has the right to decide who may – or may not – use the patented invention for the period in which the invention is protected. In other words, patent protection means that the invention cannot be commercially made, used, distributed, imported, or sold by others without the patent owner's consent. Otherwise, anyone doing any of these activities is considered to be infringing the patent and is liable to legal action from the patentee.

Before going deeper into the subject, there is an important point that we need to point out to you now and that we will come back to a little later in the workshop. - Ayşenur

Since we are currently in the UK today, our patent workshop will be explained within the framework of the UK. Please note that the patent regulations of other countries may be different.

*Do you think that all inventions can be patented? – Ask to the room: Ayşenur*

### **Requirements of Patentability:**

First requirement is novelty. A patent must be ‘new’ it must not have been made publicly available anywhere in the world, for example it must not be described in any publication that is available to the public.

The invention must show an element of novelty; that is, some new characteristic which is not known in the body of existing knowledge in its technical field. This body of existing knowledge is called “prior art”.

The invention must involve an “inventive step” or be “non-obvious”, which means that it cannot be an obvious change to something that already exists.

**Industrial application/utility:** the invention must be capable of being used for an industrial or business purpose beyond a mere theoretical phenomenon, or it must achieve a beneficial result.

**Sufficiency of disclosure:** the invention must be disclosed in an application in a manner sufficiently clear and complete to enable a person with ordinary skill in the relevant technical field to carry it out.

<https://patents.google.com/patent/EP2825100B1/en> opening the chest during surgery (which is related to their project)

You cannot patent the following:

- literary, dramatic, musical or artistic works (COPYRIGHT)
- a way of doing business, playing a game or thinking
- a method of medical treatment or diagnosis (MONOPOLY ISSUE)
- a discovery, scientific theory or mathematical method
- the way information is presented
- ‘essentially biological’ processes like cross-breeding animals or varieties of plants
- software that has a ‘non-technical’ purpose

Why? we will discuss why you cannot patent the above referring to our explanations about other IP rights such as trade marks, copyright and design rights.

*Question to students:*

Well, if we ask the following question based on this, how would you answer it? **Instagram question**

⇒ You came up with an idea and you have turned this idea into a product. You showed your invention to your friends or advertised it. Let’s say that you shared it on your Instagram story. In such a case, do you think your invention loses its patentability or not? Please explain your answer with your justification.

### *Explanation:*

By far the most common mistake made by people new to the world of patents is to reveal their invention too early. If you disclose your invention in any way – by word of mouth, demonstration, advertisement, article in a journal or any other way – before you apply for a patent, you are making your invention public. This could mean that you lose the possibility of being granted a patent. For a patent to be granted, the invention must be novel, once a public disclosure is made the invention can no longer be novel.

### **Beware who you talk to...**

If you feel the need to talk to someone before considering protection, such as a potential business partner, you should ask them to sign a confidentiality agreement (Non-Disclosure Agreement – NDA) before you talk to them. This means they have to treat what you tell them in confidence.

If the existence of an invention has been revealed to one or more members of the public, enabling an experienced person to reproduce the invention (known as public disclosure), then it will not be patentable= Definition of ‘public disclosure’.

Is there an exception for public disclosure? What if the invention is presented at a science fair?

- Unless you went somewhere where everyone signed an NDA
- If in doubt always file your patent first
- Very specific so do not mention the exhibition

Test is whether it is an “enabling disclosure” – in other words, was it disclosed in a way that the person to whom it is disclosed is able to replicate the invention. Added level of test

Is it disclosure when a student discuss their invention with the tech team or some academics

- The papers are read by at least two academics and a neutral external academic?
  - They could be under NDA or not. So specific do not answer – speak to relevant innovation team- they will tell you if the requirements are met
  - The product probably owned by the university
  - They have policies in place

We said do not share it early. But why would you share it at all? **Why would you share your secret with the public?**

**Trade Secrets v. Patents** pros and cons. – to discuss the decision of disclosing the secrets v. keeping it as a ‘secret’

These are the things we should consider when deciding if we should disclose the information and apply for a patent:

- 1- How easy is to detect the invention? (reverse engineering and detectability)  
For readily detectable inventions, patents are often sought in order to be in a monopolistic position. For example, let’s think of engines for an aircraft. There are certain inventions that you can detect by looking at the engine whereas there are some that you need to pull the pieces apart to see and understand the inventions.
- 2- How likely is it to get a patent? Is it patentable? (Patentability) This would tell us if it is worth risking the disclosure to try and get a patent. Things we need to consider here are: novelty, inventive step, industrial application, excluding subject matter.

- 3- What is your intention for your invention? Do you want to sell it? Is licensing something that you are looking for? The commercial intentions would determine if you 'need' the patent protection.

### **Why do we apply for a patent?**

Patents promote innovation and help develop new products. When an inventor obtains a patent, they secure the right to exclude others from using, making and selling their product or method of use for 20 years, while maintaining the right to sell the item exclusively and for a higher price.

*Especially why do engineers apply for the patent?* Think of any high honour or award: the Nobel Prize, an Oscar, a Pulitzer or a Grammy. Most engineers would add obtaining a patent to that list. There are several benefits of a patent for the individual and their employer. The patents awarded to an engineer provide external affirmation of their skills and expertise. The patent plaque is a badge of honour to hang on their office wall. Moreover, it is a tangible demonstration that their solution to a real-world problem was unique and worthy of acknowledgement.

(Source: <https://michelsonip.com/benefits-of-a-patent/>)

Example.

<https://patentyogi.com/latest-patents/apple/apple-builds-an-application-to-open-the-world-of-sound-to-the-deaf/> Apple's patent for deaf hearing

*Questions to students:*

Do you think patent protection is universal? Is it enough to obtain a patent in a single country?

*Explanation:*

Territoriality. Patents are territorial rights. In general, the exclusive rights are only applicable in the country or region in which a patent has been filed and granted, in accordance with the law of that country or region.

A patent granted by the UK Intellectual Property Office only covers the UK.

For protection overseas, you need to apply to patent offices in individual countries or through the international patent system, known as the Patent Co-operation Treaty (PCT). Or, you can get patent protection in most European countries by filing an application under the European Patent Convention (EPC).

*~Question:* How long do you think patent lasts?

A patent lasts up to 20 years, but renewal fees must be paid every year from a certain point onwards to keep the patent in force. In the UK, renewal fees must be paid from the 5th year onwards.

### **The question may come to mind: When does an employee own an invention?**

What we need to consider here within the framework of the UK is Article 39 of the Patent Act. Under this article; Under section 39 of the Patents Act 1977, an invention made by an employee will belong to the employee unless it was made in the course of their "normal" duties or duties specifically assigned to them, provided that their duties were such that an invention could



reasonably be expected to result – i.e. they must be ‘employed to invent’. The invention will also belong to the employer if the employee had a special obligation to further the employer’s interests, which often arises in the case of directors and partners.

Let’s discuss what happens when you invent something while you are at a university

1- Inventor is the first owner.

2- If you are employed by the university as an inventor,

We need to look at your duties: is it highly likely that it is a part of your job to invent things?

If yes, employer is entitled to own the right.

If not, for example you work as a cleaner and you invented a MP3 player which is clearly something out of your job duties/employment. The employer is not entitled to own your invention.

3- Lastly, we need to check the contractual obligation which requires a case-by-case analysis. You would need to check the QMUL IP Policy for your questions regarding your IP when studying at QMUL. You can also look for guidance from the Queen Mary Innovation team.

When it comes to engineers, under section 38 of the Patent Act 1977, it is highly likely that the invention will be owned by an employer.

Internal route:

Within universities, there are tech transfer teams who are responsible for handling patents. They decide if there is a financial benefit of applying for a patent. They are the ones who apply and manage the patents on behalf of universities.

External route:

It would be better to receive clearance from the university before applying for a patent independently. It could be risky to apply for a patent without being confident about entitlement or the right to apply. Additionally, it could be costly. Therefore, you can contact the University IP team to clarify ownership rights and funding options.

*We cannot continue the presentation without mentioning AI, which is a very popular topic today.*

*Surprised?*

*Why do you think we are talking about AI now? How do you think AI and patents can be related? (Waiting for the answers from students)*

There is an important case to be mentioned here: the DABUS case. The summary and importance of the DABUS case will be explained. AI ownership is an important issue in the DABUS case.

Brief case history:

It is a case where Dr. Thaler argues that the inventor is the machine, AI, that he generated but not himself.

Questions in this case are: (we can refer to them in plain English and discuss it with the audience before answering them)

- (a) Does section 13(2)(a) of the Patents Act 1977 (the "1977 Act") require a person to be named as the inventor in all cases, including where the applicant believes the invention was created by an AI machine in the absence of a traditional human inventor?
- (b) Does the 1977 Act provide for the grant of a patent without a named human inventor?
- (c) In the case of an invention made by an AI machine, is the owner, creator and user of that AI machine entitled to the grant of a patent for that invention?

In December 2023, the UK Supreme Court dismissed Dr. Stephen Thaler's appeal, confirming earlier rulings that inventions made by AI without a human inventor cannot be patented. The court explained that under the Patent Act 1977, only a person can be named as an inventor, ruling out AI systems like Thaler's 'DABUS.'

Despite Thaler's claim that he owns DABUS, the court found no legal basis for him to apply for patents for its inventions. This decision reflects a worldwide trend, with similar cases being turned down in other countries.

The court's ruling highlights the current limitations of patent law when it comes to AI-generated inventions, showing that such inventions made without human involvement cannot be patented in the UK. However, it recognises that AI technology is evolving, and there's a need for lawmakers to consider how to protect AI-generated works. While no immediate changes to patent law were deemed necessary, ongoing discussions are expected globally as policymakers try to address this complex issue.

*Facilitate a discussion: We will then discuss the ruling of the case and the AI ownership topic with the engineering students.*

### **How to obtain a patent?**

To obtain a UK patent you need to apply to the UK Intellectual Property Office (UKIPO). If they decide your invention is patentable, the patent application will be granted.

If we look within the scope of UK from the time an application is filed, the UK patent application process usually takes between three and four years before the patent is granted.

(The following part will be added in the presentation like a diagram or as a visual)

⇒ Getting a patent is complicated - you are unlikely to get a patent without professional help and it can take several years.

If you're confident your invention is new and a patent meets your needs, you must:

- prepare detailed documents that describe your invention
- file these documents with the IPO

You must then ask IPO to carry out their own check into whether your invention is new and inventive (a 'search').

Around 18 months after you apply the IPO will publish your application in full.

The IPO must then make a thorough check of your application to decide if your invention can be patented (known as a 'substantive examination'). This could take several years after you apply.

You may have to amend your application based on the IPO's recommendations. Your patent will only be granted if you can resolve all the issues raised by the examination.

### Substantive examination

The substantive examination is a thorough check of whether your invention is new and inventive. The examination also checks if there is any other reason the IPO cannot grant a patent, for example if your documents do not describe your invention in enough detail.

You must ask the IPO to carry out a substantive examination - it will not happen automatically.

The substantive examination could take place within 6 months of your application if you request it when you file your initial application. If you request it later, it may be several years before it's done.

Once your patent is examined

If your application does not meet the requirements the IPO will tell you why.

You can either:

- amend your application and have it examined again.
- stop your application.

There is no limit on the number of times you can amend your application to try to meet the requirements. If you meet the requirements, your patent will be granted.

In this timeline you can see that patent application timeline provided by WIPO:

<https://assets.publishing.service.gov.uk/media/62b014a4e90e0765d348809c/Patents-Timeline.pdf>

In this part, we will briefly talk about the application process through the patent timeline which you can find on the UK Government's website.

## Patent timeline



- 1** Before you apply  
You should only apply if:
  - You're confident your invention does not already exist and is inventive
  - You have the time and money for the application process
- 2** Prepare your application



Important remarks for the application: What do you need to watch out while applying for a patent?

- 1- Overcoming the prior art, search reports from the Patent Office are especially relevant here.
- 2- Argue against the objections.
- 3- Finances involved: every office action will require attorney fee.

These are the points that you need to think carefully while deciding to apply for a patent.

*Question to students:*

Can you apply for a patent without a patent attorney?

- Why do you think you need legal assistance to apply for a patent?
- Is there a rule that you must involve a patent attorney in the application process?

*Explanation:*

There's no rule that you must involve a patent attorney in the application process. If you have the time to personally commit to the process and willingness to learn the requirements of the country in which you are going to apply, you can file an application on your own.

This is known as being a "pro se" applicant.

Yes, we admit that patent attorney fees can be quite expensive. The numbers can be around £10-25,000, which we are going to explain in a minute.

But please when you decide whether or not to work with a patent lawyer, consider:

- Whether you will have the time to conduct your own research and follow through with the application process.
- The complexity of your invention. The more complicated and advanced your invention and technology are, the more likely you will need an attorney.
- What is the likelihood others will challenge your patent? If it's similar to other inventions or in a competitive field, you may need an attorney to draft a patent that will stand up to legal challenges.

### **How much does it cost to apply for a patent?**

For a UK patent the application costs at least £310 to the UK IPO, according to the government's website. On top of that, UK patent attorney fees are around £10-25,000. Without consulting a patent attorney, it would cost less than a thousand pounds. You would need to pay the annual fees to keep the patent enforced throughout the years. In the UK, annual fees are around £100-300 a year and it increases over the years. In addition, writing the claims and prosecuting the application are two different stages. The first is to create the patent document whereas the latter includes the office actions and replies to the potential objections to your patent. We would like to remind you that, applying under a university umbrella would mean that the university would cover all of these costs and more importantly they would be aware of these costs before deciding to apply.

*We have outlined what a patent is, how and in which ways it can be obtained.  
Let's move on to the "then what?"*

*Now you have granted for a patent and want to know how to use it. **How do you make money out of your patent?***

### **I own a patent, now what?**

Patents are negative rights, which basically means that they stop others from using your invention without your permission. We call this enforcing the IP right. How do you transform a negative, “passive” right to a positive, “active” one? By monetising it.

As you can use your patent yourself and generate income from it, this is what we call 'commercialisation of IP'.

Commercialisation is the process of turning products and services into a commercially viable value. Concerning Intellectual Property (IP), this term can be more specifically defined as the process of bringing IP to the market in view of future profits and business growth.

### **Who can commercialise IP: the owner of the right**

Under UK law, the ability to commercialise intellectual property (IP) is not restricted to any specific entity or individual. Generally, anyone who holds legal rights to IP, whether through ownership, licensing, or other contractual arrangements, has the authority to commercialise it: these are the IP owners, the licensees, the assignees, the joint owners and the authorised representatives.

### **How do I commercialise IP?**

**By developing Products or Services:** If you plan to commercialise IP through product development, invest in research, development, and prototyping to bring innovative products or services to market. Ensure that your offerings address market needs and provide value to customers.

**By entering into contracts and agreements:** licensing and assigning the right.

**By using it as an asset for your transactions.**

### **Assignment**

Assignment involves the transfer of ownership of IP rights from one party (assignor) to another (assignee).

- When IP rights are assigned, the assignee gains full control and ownership of the rights, including the right to enforce them against third parties.
- Typically, assignments are permanent and irreversible, meaning the assignor transfers/loses all rights and interests in the IP.
- Assignments are often used in situations where the owner of IP wishes to completely divest themselves of their rights, such as selling a patent.

Sample Clause from the below agreement:

The Assignor hereby assigns to the Assignee, absolutely with full title guarantee, all its right, title and interest in and to the Patents, and in and to all and any inventions disclosed in the Patents....

## ASSIGNMENT AGREEMENT

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This Assignment Agreement (this "**Agreement**") is entered into as of the \_\_\_\_ day of \_\_\_\_\_, 20\_\_\_\_ (the "**Effective Date**")

**By and Between:**

**Assignor:** \_\_\_\_\_ (the "**Assignor**"), located at \_\_\_\_\_

**And**

**Assignee:** \_\_\_\_\_ (the "**Assignee**"), located at \_\_\_\_\_

The Assignor and the Assignee are each referred to herein as a "**Party**" and collectively as the "**Parties**".

The Parties agree to the following:

- I. **THE ASSIGNMENT.** The Parties agree that under this Agreement, the Assignor shall irrevocably assign, convey, grant and transfer all their rights, title and interest in the following to the Assignee for:

\_\_\_\_\_ hereinafter known as the ("**Assignment**"). After the Effective Date, Assignor agrees to make no further use of the Assignment or any confusingly similar assignment in the States of \_\_\_\_\_ and anywhere in the world, except as may be expressly authorized by the Parties in writing. Assignor further agrees to not challenge Assignee's use or ownership of the Assignment.

- II. **CONSIDERATION.**

**Fixed Payment.** Assignee shall pay Assignor the sum of \$ \_\_\_\_\_, payable on \_\_\_\_\_, 20\_\_\_\_ in consideration for the Assignment.

**No Payment.** Assignor is assigning to Assignee with no expectation of monetary payment. If consideration is required for this transaction, Assignee's assumption of the risks and responsibilities of this assignment shall constitute consideration.  In lieu of monetary payment, Assignee will provide \_\_\_\_\_ to Assignor as compensation.

**Gift.** The Assignor is granting this Assignment to Assignee as a gift.

- III. **ASSUMPTION AND LIABILITIES.** Assignor hereby assigns and Assignee hereby agrees to assume, pay, perform, defend and discharge, all duties, obligations, liabilities and debts of every kind, character or description whatsoever with respect to, arising out of or in any way related to the assignment, including, but not limited to all liabilities under the agreements included therein, whether known or unknown, accrued, absolute, contingent or otherwise arising as of and after the date hereof.

- IV. **PARTIES' REPRESENTATIONS.** The Parties hereto hereby represents and warrants that as of the date hereof: (a) it has the power and authority to execute and deliver this Agreement and to perform its obligations hereunder, and all such actions have been duly and validly authorized by all necessary proceedings; and (b) this Agreement has been duly authorized, executed and delivered by it, and constitutes a legal, valid and binding agreement of it.



## Licensing

Licence is a contractual permission to do something which would otherwise infringe the owner's Intellectual Property rights.

Licensing involves granting permission to another party (licensee) to use certain rights associated with the patent, while the owner (licensor) retains ownership of the IP. We can think of this as renting.

- Unlike assignments, licences are typically temporary and revocable, with the licensor retaining ultimate control over the IP rights.
- Licensing agreements outline the terms and conditions under which the licensee can use the IP, including the scope of use, duration, territory, royalties or other compensation, and any restrictions or limitations.

- Licensing is a common strategy used to monetise IP assets, enabling the licensor to generate revenue while retaining ownership and control over the IP.

Sample clause from the below agreement:

The Licensor hereby grants to the Licensee an [exclusive **OR** sole **OR** non-exclusive] licence under the Patents [and the Licensed Know-how] [in the Field of Use] to manufacture, use, and sell or otherwise supply, Licensed Products in the Territory.

State of Wisconsin

Rev. 133C7D8

### LICENSING AGREEMENT

This Licensing Agreement (this "Agreement") is made as of the 17 day of January, 2018 (the "Effective Date") by and between Valerie J Toups ("Licensor") and Matthew K Jordan ("Licensee"). Each of Licensor and Licensee may be referred to in this Agreement individually as a "Party" and collectively as the "Parties." "Affiliate" shall mean an entity controlled by, under common control with, or controlling Licensee, where control is denoted as having fifty percent (50%) or more of the voting power (or equivalent) of the applicable legal entity.

**WHEREAS**, Licensor owns the items of intellectual property defined below as Licensed IP, and Licensee desires to obtain the right and license to use the Licensed IP upon the terms and conditions set forth in this Agreement.

**NOW THEREFORE**, in consideration of the mutual covenants, terms, and conditions set forth in this Agreement, and for other good, valuable, and legal consideration, the receipt and sufficiency of which are acknowledged, the Parties agree as follows:

**1. License.** Licensor hereby grants to Licensee a exclusive, non-transferrable, non-assignable, license to reproduce, distribute, publicly display, publicly perform, and otherwise use the following items of intellectual property (the "Licensed IP"):

(A) Sad Puppy - Cartoon of a sad corgi

solely for the limited purposes of manufacturing and selling T-shirts with the licensed IP worldwide (the "Territory").

Nothing herein obligates Licensee to exercise the rights granted in this Agreement.

**2. Exclusion of All Other Rights.** Except as expressly provided in this Agreement, Licensee is granted no other rights or licenses whatsoever in or to the Licensed IP or any of Licensor's other products, services or other intellectual, proprietary, or personal rights. Licensor reserves all rights and licenses not expressly granted in this Agreement. In particular, nothing in this Agreement conveys to Licensee the legal title to any Licensed IP.

**3. Consideration.** As consideration for the license granted and described in this Agreement, Licensee shall pay to Licensor the following fees and/or royalties:

Type of Payment	Payment Due Date	Payment Amount
Royalty Payment	January 17, 2019	\$20000

Payment shall be made within seven (7) days of the due date. In the event any payment due to Licensor is collected at law or through an attorney-at-law, or under advice therefrom, or through a collection agency, Licensee agrees to pay all costs of collection, including, without limitation, all court costs and reasonable attorney's fees.

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In summary, assignment involves **the transfer of ownership of IP rights, while licensing involves granting permission to use specific rights while retaining ownership.** Each mechanism offers distinct advantages and considerations, depending on the goals and circumstances of the parties involved.



Assignment	Licence
Transfer of ownership of IP rights from one party (assignor) to another (assignee).	Granting permission to another party (licensee) to use certain rights associated with the IP right, while the owner (licensor) retains ownership of the right
Full control and ownership	The licensor retains ultimate control over the right
Ability to enforce them against third parties	Ability to enforce them against third parties is subject to their agreement and type of licence
Permanent and irreversible	Temporary and revocable (scope of use, duration, territory, royalties, restrictions or limitations).
The owner of IP wishes to completely divest themselves of their rights.	Common strategy used to monetise IP assets, enabling the licensor to generate revenue while retaining ownership and control over the IP.

## Non disclosure agreements

### What is a NDA?

A NDA (sometimes referred to as a 'confidentiality agreement'), is used when confidential information is being disclosed to another party. This helps to ensure that the party receiving the confidential information:

1. Will not disclose the confidential information to anyone else (unless expressly permitted in the NDA), and
2. Will not use the information for any other purpose than the one for which it was disclosed (as described by the NDA).

**Protection of Confidential Information:** Intellectual property often involves sensitive information that, if disclosed to competitors or the public, could harm the owner's competitive advantage. NDAs safeguard this information by legally binding the receiving party to maintain its confidentiality.

**Preventing Unauthorised Disclosure:** NDAs specify what information is considered confidential and outline the obligations of the receiving party to keep it secret. This helps prevent unauthorised disclosure or use of the IP by third parties.

**Enabling Collaboration and Transactions:** In many cases, businesses need to share proprietary information with partners, investors, contractors, or potential buyers during

collaborations, investments, or transactions involving IP. NDAs provide a framework for sharing this information while mitigating the risk of misuse or theft.

**Establishing Legal Protections:** By entering into an NDA, both parties acknowledge the importance of protecting confidential information and agree to the legal consequences of breaching the agreement. This provides a basis for legal recourse if a party violates the terms of the NDA and discloses or misuses the IP.

**Facilitating Licensing and Commercialisation:** In the process of licensing or commercialising IP, NDAs are often used to facilitate negotiations and due diligence. They allow the parties to exchange detailed information about the IP, its value, and its potential commercial applications while maintaining confidentiality until a formal agreement is reached.

**When should the NDA be signed?**

It is best practice to sign the NDA before disclosing any confidential information, especially regarding patentable inventions or trade secrets.

## DESIGN RIGHTS

*We know that you have questions about design rights so we want to briefly include 'design rights' in our presentation as it is related to the work you have done and will do in the future.*

**Now that we know what a patent is, how is it different than a design?**

### **What do we mean by design rights?**

A design right protects the overall visual appearance of new and distinctive whole products. In the commercial world, design can mean a lot of things. But just because you've designed something, it doesn't mean you can protect it with a design right. These whole products should have physical and tangible form, be manufactured or handmade, and be produced on a commercial scale. For example, a couch, a car or a dress.

If your product is likely to derive value or attract customers as a result of the way it looks, you should consider registering the design. UK Registered Designs are governed by the UK Intellectual Property Office (UKIPO) and provide protection for the UK only.

A design registration helps protect the appearance of a product, such as its shape or pattern.

Registering your design makes it easier to prove:

- that the design is legally yours
- when you created it

This will help if anyone tries to copy or use your design without your permission.

A design registration lasts 5 years. You must renew your design registration every 5 years to keep it protected - up to a maximum of 25 years.

### **What you can register**

Your design must be new.

The design of something can include one or more of the following:

- physical shape
- configuration (or how different parts of a design are arranged together)
- decoration or colour
- pattern

### **What you cannot register**

You cannot register:

- offensive material, for example swear words or pornographic images
- designs making use of national flags you do not have permission to use
- designs making use of official emblems or hallmarks, for example the Olympic rings or coats of arms
- the functionality of a design, for example a chair that folds down more quickly than others of the same kind

### **What it costs**

Registering a design costs from £50 for one design to £150 for up to 50.

### **The application process**

You can apply online or by post.

You must send the Intellectual Property Office (IPO) detailed illustrations of your designs, including any notes to describe exactly what you are registering. You'll get a decision on your application within 3 weeks.

As Jacob LJ summed up in the *Proctor & Gamble v Reckitt Benckiser* case, "the point of protecting a design is to protect the design **as a design**. So what matters is the overall impression created by it: will the user buy it, consider it or appreciate it for its individual design?"

As an example of a failure; an infringement case Trunki case:  
Facts of the case:

Two companies, Magmatic Limited and PMS International, were in a legal battle over children suitcase designs. Magmatic, the maker of Trunki suitcases, accused PMS International, which produced a similar suitcase called the Kiddee Case, of copying its design.

Magmatic initially won in the High Court, but PMS International appealed the decision. The Court of Appeal ruled in favor of PMS International, saying the Kiddee Case did not copy Trunki's design. This decision was later upheld by the Supreme Court, ending the legal fight.

The Supreme Court emphasised that design rights protect specific designs, not general ideas. Despite Trunki's initial success, the courts ultimately decided that the Kiddee Case did not infringe on Trunki's design.

This ruling has raised questions about the extent of design protection and its impact on the industry. Robert Law, the creator of Trunki, expressed disappointment with the decision, reflecting concerns within the design community about uncertainty in the law.



A Kiddee case (left) and a Trunki case.

*Question to students:* What do you think about this case? Do you think they look alike? Do they infringe the other's design?

Let's look at the difference between design rights and patents.

Design:  
Protects aesthetics, the look and feel of a product.

The application process for registering the design is much quicker than the patent application and not nearly as expensive.  
 The requirements are not strict.

**Patents**

Protects function.  
 The application process takes a few years and is very expensive.  
 The invention must be new, inventive and non-obvious.

Design Rights	Patents
Protects aesthetics, the look and feel of a product.	Protects function.
The application process for registering the design is quicker and would take few days.	The application process takes few years.
The requirements are not strict: the design must be new.	The invention must be new, inventive and non-obvious.

*Group Activity:*

(Assuming that there are 24 students in the workshop; we will divide these 24 students into 4 tables of 6 people each. We will ask them to find out how many patentable inventions and designs there are in a car.)

Car: they can choose any car, it can be a self-driving car, a Ferrari, Tesla or etc.

Engine

Body shape

Aerodynamics ...

A prize will be awarded to the team with the most correct designs and patentable inventions.

**The Last Menti Quiz: What we learned today**

Thank you very much for listening.

15 minutes is the time allocated for questions.