

## Patent Attorneys

In Australia Patent Attorneys are qualified to deal with Patent, Trade Mark and other allied Intellectual Property matters. Patent Attorneys are not Solicitors.

A Registered Patent Attorney has a degree in Science or Engineering and has undertaken a course of training and passed several examinations to become registered. Registration is administered by the Professional Standards Board for Patents and Trade Marks Attorneys, and study is undertaken on a post-graduate basis through various Tertiary Institutions. The course work covers the law and practice within Australia with respect to Patents, Trade Marks, Designs, aspects of Copyright and the law and practice of dealing with Intellectual Property matters in numerous overseas countries. Practical aspects of drafting and interpretation of Patents, and general practice in Intellectual Property including, licensing and assignment as well as considerations of ethical practice are also assessed.

Patent Attorneys can offer advice in all areas of Intellectual Property.

## Searching

Searches relating to products or processes  
A search, to ascertain whether a product or process being developed is or is likely to be new and inventive, is a critical step in the development of that new product or process.

A very common misconception is that if a concept for a product is not found on the Australian Market or in markets in other countries it is assumed to be new. A lot of time and energy is then put in to developing the product, or process, and more spent on getting it ready for the market. Some way down the path of development the product is found not to be new and/or an infringement of a patent that is currently in force. In many cases this is only ascertained after the product is actually on the market and a letter alleging infringement is received.

Had some literature searching been conducted first it is likely that the full position would have been known. A proper assessment could have been to determine whether the product or process  
a) was an infringement of an existing Patent or  
b) the product or process was described in an earlier document and was therefore not new.

The embarrassment and expense would have been saved had a search been conducted first to establish the actual position.

An additional benefit of searching is that even where the product or process is found to be new, aspects or concepts in use in allied areas that are found by the search can speed up the development process and lead to savings in research or development costs.

Patent records are intended to be a source of information for industry, and we can help you use them to best advantage.

### Database searches

Searches are typically undertaken using electronically available patent databases.

**Specialist databases** are available for Japanese Patents, US Patents, and specific industry databases such as for Chemical literature, DNA and protein sequences and the Rubber and Petroleum industry, as well as many others.

In addition there are now available free of charge, on the internet, a number of databases that can assist with the assessment process. Some of these include:

- Australian Patent searches (limited)
- US Patent searches
- European Patent searches
- Japanese Patent searches
- Canadian Patent searches
- International Application (PCT) Patent searches

It is important to note that these searches should not be relied upon as a full assessment of the infringement potential.

### Country Specific Infringement searches

More thorough and specific searches can be arranged where it is desired to seriously market a product in one or a few specific countries, and manual searches can be conducted in **any country** of interest, for example Germany, US, UK, France, Japan, India, or Australia. This type of search will give an assurance that no patent rights will be infringed in those particular countries. Such searches, for e.g. US may also be desirable when assessing novelty for the purposes of obtaining a Patent.

### Market information searches

Searches often indicate who the major players are in a given **area of technology**. Specific searches can also be conducted using the name or names of a specific **competitor** or player in an area of technology or alternatively to see what direction that company is taking. These specific searches can be done for Australia as well as almost any other country of interest.

**Watching searches** can be conducted, in the case of the databases covering overseas countries, every week, or with Australia for any nominated period. Such Watching Searches can also cover a given area of technology as an alternative to watching the activities of a particular competitor.

## Searches relating to Trade Marks

Where a new Trade Mark or brand name is being devised or the product range of an existing Trade Mark is expanded, only too often the position of whether a conflicting Trade Mark exists in a given market is not checked. Whether a Trade Mark might be registered in view of what is already on the Trade Marks Register of a particular country is also frequently not checked. A Trade Mark is often the **only recognisable asset** that accrues in value following continuing sales or an expensive marketing campaign, and it is of vital importance to spend some effort to ensure that the asset about to be accrued can be protected before proceeding with a particular choice of names.

### Availability or Infringement Searches

Searches for availability of a given Trade Mark can be conducted in **any country**, in some instances such as Australia, US, Canada, UK this can be done by **database**, however in all other countries where a Trade Marks Register exists, e.g. Indonesia, Taiwan, Hong Kong, Thailand such searches can be conducted **manually** by one of our many associates in those countries. Such searches will give an indication of whether it is at all possible to market in a given country and whether registration of a Trade Mark is possible.

Free of charge databases that allow Trade Mark searches are also provided for a number of countries, including:

- Australia
- New Zealand
- United States of America
- Canada
- Madrid Express (International)
- European Union
- Singapore

### Market Information Searches

Market Information Searches can also be conducted to ascertain what steps **competitors** are taking in terms of new product names. A **watching search** can also be conducted, as with patents, so that applications filed with the Trade Marks Office can be regularly searched to ascertain what names are being applied for in a given **Trade Mark Classification**.

### Common Law Searches

Rights can be accrued by reason of use of a Trade Mark that results in a reputation, and whilst there is no absolute way of determining whether such rights exist it is possible to check in a number of obvious places to determine the likelihood of such rights existing. Two areas that can be searched on the internet free of charge include The Australian Securities and Investment Commission (ASIC) and the Yellow Pages.

Business and Company Names can also be searched in **overseas** countries, and where desired we can arrange to establish companies in overseas countries for you.

Please note that whilst we encourage an initial check of names we strongly urge that you do not rely wholly on a search conducted by you or someone not properly qualified to conduct such searches.

## Protecting New Products

### Trade Secrets And Confidential Information

A common problem where a new development or discovery has been made is that the facility where the development or discovery is made does not have appropriate screening. This often results in the **loss of ownership** of the development because steps are not taken to ensure that the development remains **confidential property**. By the time there has been an opportunity to assess whether a Patent should be applied for, the information is no longer confidential and valid protection is not achievable.

It is critical to put into place appropriate **protocols** for handling information leading up to a new development, or at very least immediately protect the new development when it has been made, so that the likelihood or at least the impact of a potential leak of such information can be minimised.

Furthermore it is important that contractual arrangements are made with all **employees** working on the development to ensure that developments made by the employees are owned by the business, and that the material is to be

treated confidentially and according to the protocol that has been developed.

We can **visit** your manufacturing facility and advise on appropriate steps that should be taken and protocols that should be implemented, so that a development taking place within the manufacturing facility remains the property of the owner. These protocols can be introduced with a **minimum of intrusion** into the efficient running of the facility.

Where it is necessary to divulge Confidential Information to another person or company, for example, to have a prototype tested or the concept evaluated, we can prepare appropriate agreements and documentation to maintain your property in that Confidential Information.

#### **Advice**

In many cases it is thought that some registration is better than no registration, however, often expensive steps are taken to put into place protection that is either **inappropriate**, **unnecessary** or **unnecessarily expensive**. Some very fundamental advice is required before any protection is put into place.

Often formal applications are put into place far too early, and protocols for maintaining confidentiality are dropped before it is appropriate in a commercial context. The timing of putting formal protection in place is critical.

#### **Obtaining Patent Protection**

##### ***What can be patented***

Not everything can be patented and it is not always desirable to patent a new development where other forms of protection are available. Apart from the requirement of the development being **new** and **inventive** there are certain other specific **exclusions**. The dividing line for those exclusions is not entirely clear. For example whilst certain **biological** matter is not patentable, in Australia Patents have been granted for certain plants, and animals. Currently there is some uncertainty as to whether medical treatments are able to be patented. **Computer software** is often not patentable but certain software can effectively be patented if it meets with specific criteria.

##### ***Types of Patents***

Specific strategies can be devised for protecting a variety of different products depending upon the product life and the market that is expected to be entered. An **Innovation Patent** in Australia might be appropriate for a product with a short product life expectancy. A **Utility Model** might be best suited for short term protection in overseas markets, for example in Germany, Japan, Mexico

or Ireland, if a product is about to be launched in those countries. Where a product is likely to have a short life, but its release in an overseas country is to be delayed, a Utility Model application can be delayed and based on an Australian Provisional application, or a **PCT** (Patent Co-operation Treaty) application. Alternatively a traditional approach of filing a Provisional Application followed by a **Standard Patent** application to obtain maximum possible term of protection might be desired.

#### ***Overseas Protection***

Applications for Patent protection can be filed through our services into all countries that have Patent systems. It is critical however to make an early assessment of the likely countries of interest because not all countries provide for a so-called "**convention**" application wherein filing can be deferred for 12 months based on an Australian Application. Additionally careful assessment should be made not to file in too many countries because the cost of doing so can be to the detriment of the commercial progress of the product.

#### ***Plant Variety Rights***

Specific legislation in Australia allows separate protection for plants and a new variety of plant can usually be registered in **Australia** under the Plant Variety Rights Act. In some circumstances **Patents** may also be used to protect a plant. A number of **other countries** have specific legislation for the protection of plants, and thus in the US three different possible avenues are available, Utility Patents for plants that have been genetically engineered, or otherwise meet the standard of "non-obviousness", Plant Patents for asexually reproduced plants, and Plant Variety Rights, similar to the right available Australia, for sexually reproduced varieties. The timing of filing plant protection is quite different to that of filing for a Patent, however, there are very strict limits in terms of commercial use. We can make application for protection for your plants and give advice on the most appropriate balance of protection for your plant variety.

#### ***Design Registration***

Design Registration in Australia relates to the appearance, but not to the function of an article. This type of protection is only particularly relevant where the appearance of the article is important. Generally Registered Designs are considered to be somewhat narrower than Patent protection, however, more than one registered Design can, at times, prove to be particularly difficult for a potential competitor to avoid. In some circumstances Design Registration can act as a useful adjunct to Patent protection.

### **Overseas Protection**

The practice of Design Registration in other countries is quite different to the practice in Australia, for example, in France it is possible to file one application covering about 50 different designs in the same classification scheme, albeit attracting a higher fee after the second design. In the UK it is only possible to have an Unregistered Design Right for a design whose shape is entirely dependent upon function, and provided that steps are taken to first market the product in the UK or in other designated countries (does not include Australia). Formal registration is only possible for "non-functional" designs in the UK. In South Africa two types of registration are possible, depending on whether the shape is dictated by function or not.

### **Copyright**

There is considerable potential for confusion as to whether Copyright actually subsists in a particular article or not. On the one hand, in Australia, Copyright is said not to subsist in a first article where the article has been industrially applied, on the other hand, however, Copyright might still subsist in the same work as applied to a different article. Where Design Registration is not possible for the first article because of reasons other than that the Design is old, Copyright protection may still subsist notwithstanding the industrial application of the first article. The position in other countries is quite different, for example, the position of Copyright in the UK is further compounded by the Unregistered Designs Right.

We can give advice in this complex area and if necessary obtain advice from overseas associates advice on whether Copyright subsists or what specific steps need to be taken to ensure that rights will be maintained.

Where it is thought that copyright will subsist in overseas countries by reason of the Berne Convention the position must be looked at very carefully.

For general advice in relation to copyright where it does not relate to a product we would refer you to a suitably qualified solicitor. Further general information regarding Copyright can be obtained on the internet from the Copyright Council of Australia.

## **Protecting Product Names**

### **Advice**

A common problem arises with the **initial choice** of Trade Mark for a product in that Trade Marks are often chosen to facilitate ease of market recognition by reason of their descriptive nature. Regrettably such a choice may only be useful for **short term marketing** objectives and is not one that leads to an easily protectable identity. Accordingly competitors can readily come in close with a similar Trade Mark.

A good Trade Mark is one that gives an indirect indication of the goods or services but does not describe them. Advice at the early stages of selecting a **distinctive** Trade Mark can ensure that the name selected can be protected at a later date and that other traders cannot easily benefit from money spent by you on advertising. We can help you or your marketing professional with this selection process.

Specific steps should be taken to ensure that Trade Mark rights are maintained and not gradually **diminished and lost**. For example it is prudent to draw attention on brochures and labels, to the fact that you regard a certain word as your Trade Mark. Whilst there are specific exclusions as to what you should or should not do, following a simple set of rules can ensure that your asset is protected.

Using a Trade Mark incorrectly can also lead to a loss of rights. For example the Xerox corporation has in the recent past spent considerable sums of money to ensure that their house mark "Xerox" did not become a generic name. Thus instead of making reference to a "Xerox machine" reference should be made to a "Xerox™ Photocopying machine" We can provide you with specific details of how a Trade Mark should be used, or we can consult with you your advertising and Marketing Professionals to ensure that your Trade Mark is protected by **proper use**.

### **Common Law Rights**

Trade Marks and Trade Dress can be protected under Common Law or the Trade Practices Act. Such protection however only extends to the region for which a **reputation** can be proven. Thus where for example a reputation exists in Adelaide, but not in Mt Gambier or Melbourne the rights that arise by reason of reputation cannot be enforced in Mt Gambier or Melbourne, and accordingly another individual is free to make use of the name in Mt Gambier or Melbourne. Those Common Law rights whilst they are awkward to enforce do not require any registration or positive steps to be taken.

Thus where a Trade Mark has not been registered there is still a possibility that some recourse could be had where a competitor uses a similar name. In this situation, however, a great deal depends upon the extent to which the Trade Mark has been used, and what other traders have been using.

In some instances this type of protection is the most appropriate protection for example this type of protection is usually relied on to protect Trade Dress of an article. Where it is not possible to register a Trade Mark this type of protection may need to be relied upon, however the packaging and other aspects of **Trade Dress**, should be looked at carefully so that the best possible protection is achieved for unregistrable Trade Marks.

### **Trade mark Registration**

By far the simplest means to ensure that a product name is protected is by registering the name as a Trade Mark. The Registration does not rely upon reputation, however, **continued use** within certain parameters is necessary to ensure that the rights are defensible. Rights by reason of registration are far simpler to establish than by reason of reputation.

### ***In overseas countries***

Some countries, typically those that were not part of the former British Empire, have no provision for Common Law Rights in Trade Marks. For example, in Indonesia a registration is necessary to ensure that Trade Mark rights subsist. Rights must be registered for each country where it is thought that use will commence. There is a trend to regional protection of Trade Marks thus for example it is possible to achieve registration for much of the European Union in a single application.

In some countries such as in the US it is necessary to prove that use has commenced before registration takes effect, and therefore in some instances there is little point in making applications before there is a relatively firm intention to use the Trade Mark in that country.

On the other hand where your product begins to establish a reputation, a third party can register your Trade Mark in another country, and force you into a position of having to choose another name for that other country.

## **Commercialisation**

### **Advice**

There is little point in protecting a new product or process or a Trade Mark without some prospect of commercialisation. The type of protection sought must be **commercially sound**. Whilst we are acutely aware of the reality of commercialising new products, and the advice we give reflects that reality, we do not offer a hands on service of commercialising new products.

### ***Grants and Financial assistance***

We can give some directions and some **practical advice**. Several grant schemes are administered by Governmental bodies and particularly now directed to export products, to subsidise costs incurred. Such grants can be used, for example, to pay for patent costs. Industry Research and Development assistance is also available where there are tax losses to offset. Certain financial institutions also put together syndicates for tax loss purposes for research, however the level of such finance is usually substantial. Grants are available for unemployed for starting up a business, monies are available for some initial stages such as prototyping. There is also a scheme available for placement of tertiary students to undertake research at your facility.

### ***Assessing local help***

The number of local enterprises who might be interested in a particular invention is somewhat limited, but it is important to identify those that might help. We can at least direct you to the resources available to help you in that endeavour.

### **Assignment and Licensing**

One of the most convenient and common ways of commercialising a new product is not to make the product but is either to sell rights or to grant a licence for that product. Even where you are able to service a given market it may be desirable to seek out another person or company that can extend your product into another market.

It is vital to ensure that the rights that are sold or licensed are sold to best effect. There is no point in licensing to a company for a given territory, if that company will not be able to service that territory.

Usually where a **Patent** exists for a product, other rights are also attached to that product, such as certain **Technical Know-How**, ability to source materials, **Copyright** in drawings, **Confidential Information** or **Trade Secrets** relating to other aspects. All of the rights may be withheld, attract an up-front payment, or be part of the royalty payment.

Similarly for **Trade Marks**, where it is desired to licence a Trade Mark several issues need to be addressed, including to what extent protection exists for the name, is there a registration, are the goods adequately covered, whether conflicting Trade Marks exist and so on.

We can either **draft licenses or assignments** that involve Intellectual Property or we can give practical guidance and **opinions** where a license is about to be made as to whether the license meets your needs.

Where a sale of a Patent is effected, it is important that the assignor has free title to the Patent, and it is also important to have an assessment made to determine the extent of the rights. Where it is intended to enforce rights it is important that the assignment is **recorded** at respective Patent Offices. The timing on this recordal can at times be critical, because in some instances considerable savings can be made depending upon which stage the assignment document is signed. Whether stamp duties are payable is also an issue that does need to be addressed.

Similarly where you are about to licence-in some rights in contrast to the above position where you are about to licence-out some rights, we can give an opinion on the merit of the rights and the licence.

## Intellectual Property Management

### Procedures Audit

It is important to ensure that appropriate procedures are in place so that potential opportunities are accurately assessed. New developments do need firstly to be identified, and appropriately handled. The commercial prospect of those developments need then to be accurately assessed, thereafter an assessment does need to be made as to whether the development is to be formally assessed or not, and then what milestones should be met so that protection and commercialisation continue.

In larger organisations an audit of existing procedure is particularly helpful to assess the effectiveness of existing measures and to put in place procedures within the existing structure of the organisation.

### Inventory Audit

Where several projects are undertaken, or where collaborative work is undertaken, it is critical to ensure that an inventory of intellectual property is maintained. This is more than merely a list of Patents or Patent Applications, but includes specific know-how and Confidential Information. The inventory is to be updated and serves as a useful tool where disputes of ownership arise. A reporting protocol should be put into place to ensure that the inventory is appropriately handled.

## Dispute Management

### Infringement

A first step to be taken where infringement is threatened is to check your position. A great many **Patents** that are drafted and accepted by the Australian Patent Office are subsequently held not to be valid. This is a result of the fact that at the stage of a Patent Application the onus is on the Australian Patent Office to show that a Patent should not be granted rather than the onus being on the Applicant to show that it should be granted. Accordingly it may be that a particular Patent over which infringement is alleged, is **not valid**. Renewal fees are also payable on Patents and often threats are made where Patents have not been granted by the Patent Office, and a check needs to be made as to whether a Patent is actually **in force**. Often the rights that are granted do not **encompass** the article alleged to be infringed. The interpretation of Patent claims is not always straightforward and where there is any alleged infringement it is important that a full opinion is sought.

Thorough scrutiny is also necessary where infringement of a registered Trade Mark is alleged, to ascertain whether the registration is at all vulnerable, and what the exact extent of rights granted are and whether your use of a particular name does in fact infringe the rights

Where you have a Granted Patent or Registered Trade Mark and either you are aware of an infringer, or there is likely to be an infringer soon, we can devise an appropriate strategy to deal with the infringement. Generally it is recommended that the background is checked thoroughly to ensure that the product that is made, or method used does actually infringe the rights concerned.

### Licensing

In some instances the individual concerned is unaware of the existence of a Patent, and the matter can be resolved quickly. Furthermore where an infringer persists because of his commitment to a certain market it can at times be an advantage to have him continue, especially

where he is servicing a market that is not covered by you. Often this type of dispute can be resolved by the granting of a **licence**, with limitations of use being defined clearly. The expensive and time consuming step of taking a matter to court can, in many cases, be avoided to the benefit of the Patentee. **Commercial settlements** are often the most cost effective, however that is not to say that a timid approach is by any means recommended. A critical assessment of likely costs should also be made to determine to what extent the matter should be pursued, and what means should be taken to exit from the dispute once the level of budgeted cost is exceeded.

It is possible to arrange insurance to cover the litigation of Patents or Trade Marks, and where a very valuable Patent is concerned it is prudent to arrange such insurance at an early stage.

### **Opposition to Grant**

Often where it is likely that a dispute will arise once rights are granted there is an opportunity to act to forestall those rights. If you become aware of a Patent or a Trade Mark Application, for example where we have kept a Watching Search for you, there are formal procedures for **opposition** to such applications to prevent them from ever being granted. These opposition procedures, include the procedures of submitting evidence supporting a position that the Patent or Trade Mark either should or should not be registered. The evidence is considered and in many instances an unreasonably wide claim can be reduced in scope, or a Patent or Trade Mark application may be rejected outright.

**Informal representation** may also be taken once there is an awareness of the existence of an application. This representation can influence the way in which both Patent and Trade Mark applications are treated. Often such an approach is made, usually for a minimal outlay, to ensure that inappropriately broad claims are not granted.