



**EXPLOITING INTELLECTUAL PROPERTY
ASSETS ; LICENSING, FRANCHISING AND
MERCHANDISING**

**By
CHANDER M. LALL
Managing Partner
Lall & Sethi Advocates**

Intellectual Property Rights (IPR)

There are 5 different types of IP:

Trade Marks

source identifier

Patents

technology protector

Designs

protection to product shape

Copyrights

protection of creativity

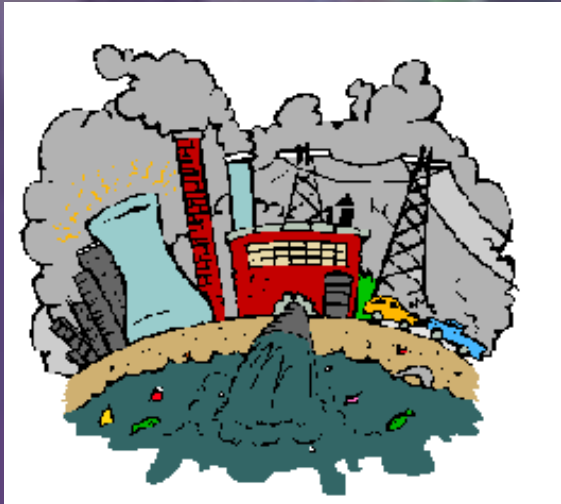
Confidential Information



What is a Trade Mark / Brand

TM

An invisible link between the product source (known or unknown) and the consumer



What constitutes a Trade Mark / Brand ?

word
GUCCI

Product
Shape



Sound



slogan



Character



signature



device



Name



label

TOMMY  HILFIGER



Numerals



USE not Registration the Key...

- The existence and life of a trade mark depends on use.
- Registration provides additional remedy of infringement only.

Trade Mark / Brand Audit

TM

- Are the marks being used ?
- Are the marks registered ?
- Are the registrations use based or on intent to use ?
- Are the registrations periodically renewed ?
- Are the registrations susceptible to cancellation for non-use or other grounds ?
- Are there any cancellation actions pending against the mark ?
- How many successful enforcement actions have been initiated based on the mark ?
- Were any actions unsuccessful ?

Trade Mark / Brand Audit....contd.

TM

- Are there any licenses for the mark ?
- If yes, are these licenses properly monitored ?
- What is the state of the Register ? Are there other similar / identical marks on the Register ?
- Are there similar / identical marks in use by third parties ? For how long ?
- Are there any third parties who can claim concurrent / parallel rights in the mark ?
- Has the mark been diluted for any reason ?

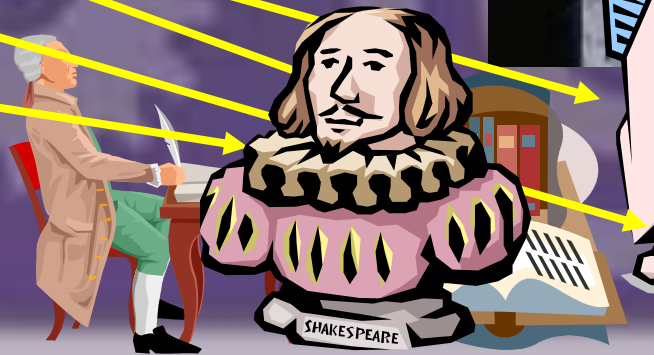


Copyrights



Subject matter of Copyrights

- Films
- Musical works
- Sound recordings
- Literary works
- Artistic works
- Dramatic works



Term and Registration



- Copyrights extend for the life of the author + 60 years.
- No statutory requirement for registration
- Copyrights subsist with the creation of the work
- India a member of UCC & the Berne Convention
- Copyrights enjoy international protection on a reciprocal basis.

ACQUISITION OF RIGHTS

BY

ASSIGNMENT
OR LICENSE

IN WRITING



ASSIGNMENT / LICENSE ESSENTIALS

Identify the work



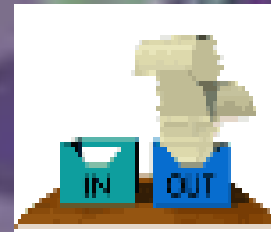
Period



Amount of Royalty



Territorial extent



One year to exercise rights



What does this bundle contain? FOR BOOKS

An exclusive right to:

- **make additional copies (back to back copies) ;**
- **make electronic copies ;**
- **sell or distribute copies to the public ;**
- **read out the work publicly ;**
- **make a film i.e. film script ;**
- **make a sound recording i.e. use it as lyrics ;**
- **translate ;**
- **make an adaptation ;**
- **reproduce in material form.**



What does this bundle contain? FOR SOFTWARE

An exclusive right to:

- **make additional copies (back to back copies) ;**
- **make electronic copies ;**
- **sell or distribute copies to the public ;**
- **Sell or rent a copy**
- **make an adaptation ;**
- **reproduce in material form.**



What does this bundle contain? FOR SOUND RECORDINGS

An exclusive right to:

- **make additional copies ;**
- **to sell ;**
- **to give on rent / hire ;**
- **to publicly play the recording**



What does this bundle contain? FOR CINEMATOGRAPH FILMS

An exclusive right to:

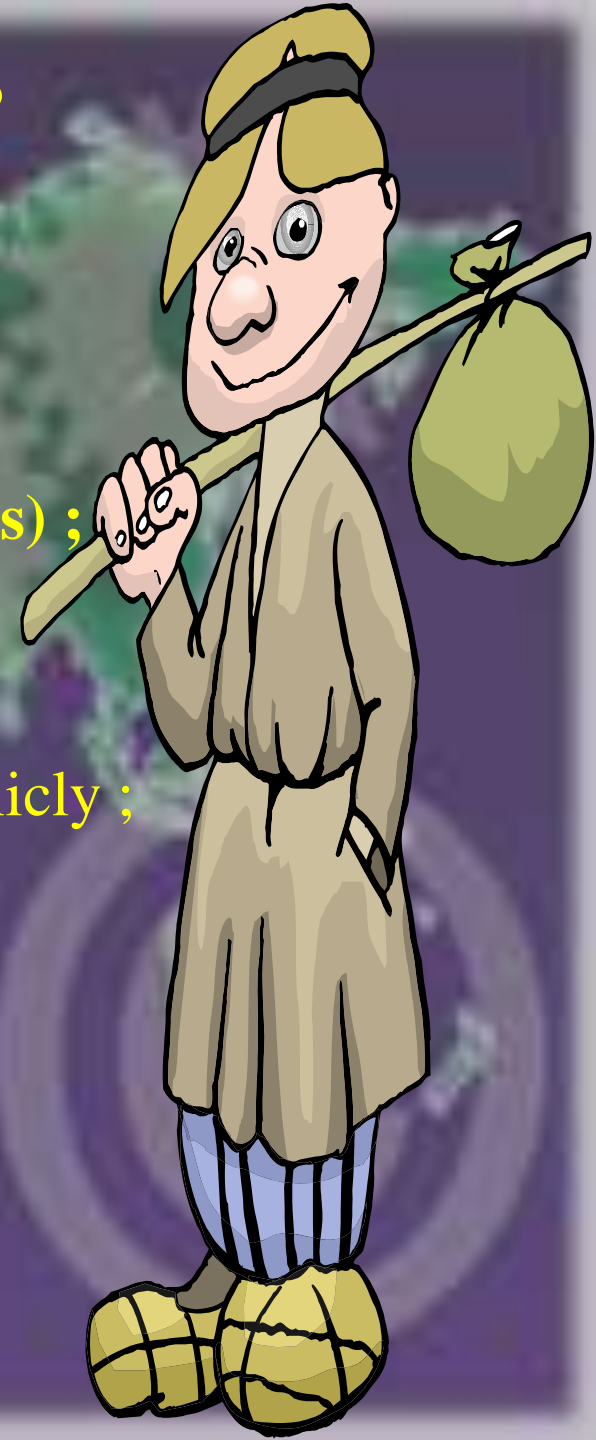
- **make additional copies ;**
- **use one screen shot and make a photograph ;**
- **to sell ;**
- **to give on rent / hire ;**
- **to display publicly**



What does this bundle contain? FOR MUSICAL WORKS

An exclusive right to:

- **make additional copies (back to back copies) ;**
- **make electronic copies ;**
- **sell or distribute copies to the public ;**
- Play the work on an instrument or sing it publicly ;
- make a film i.e. film music;
- make a sound recording ;
- make an adaptation ;
- reproduce in material form.



What does this bundle contain? FOR ARTISTIC WORKS

An exclusive right to:

- **make additional copies ;**
- **make a 3 dimensional image of a 2 dimensional work and visa versa ; i.e. making a sculpture of a sketch or a sketch of a sculpture ;**
- **display publicly ;**
- **include in a film ;**



Copyright Audit

TM

- Is the work Original ?
- Is the work registered ?
- Is the Assignor / Licensor the Author of the work ?
- Does the Assignor / Licensor have the necessary authority to assign / license the work ?
- Are there any joint authors ?
- If the Author of the work is a corporate entity, are the employees bound by proper contracts ?
- Is the work easily identifiable ?



Designs

Designs

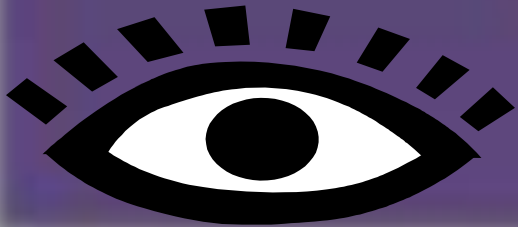
- Feature of shape,
- Configuration,
- Pattern,
- Ornament,
- Composition of lines or colours
applied to any article, whether in two
dimensions or three dimensions

Designs

- Relates solely to appearance - appeal to the eye
- Does not include mode or principle of construction or mere mechanical devices
- Registration mandatory prior to publication
- Valid for 10 years, with one renewal for 5 years

Novelty not Originality the Key..

- Protection granted to New and Novel designs.
- Novelty is the fundamental reason for the protection granted.
- Eye is the ultimate judge, thus novelty should be substantial.



Unregisterable Designs

- Designs that are not new or original
- Designs disclosed to public anywhere, by publication in tangible form, or by use or in any other way.
- Designs not significantly distinguishable
- Scandalous or obscene designs

Patents

- Patent laws give protection to inventions.
- Invention must be new, useful and have industrial application.
- Invention must relate to a product.
- An improvement can also be patented.
- Right to exclude others from making, using or selling the invention.
- Term of protection 20 Years

Transfer of Rights

- Assignment or outright sale
- Licensing / Franchising
- Consultancy
- Joint Ventures

**-THANK
YOU FOR
STAYING
AWAKE**

