



BCS @ 50 - CELEBRATING FIFTY YEARS OF BRITISH COMPUTING

Safeguarding the Intellectual Property Rights of both consultant & client

Rachel Burnett, Solicitor
Deputy President, BCS



THEMES

- Introduction to IPR
- Copyright
- EU database right
- Confidentiality
- Patents & trade marks

INTELLECTUAL PROPERTY RIGHTS

- Intangible assets
- Economic value
- Nationally created laws
- Ensure:
 - Legal protection of rights which you own
 - Legal entitlement to use others' rights
- Copyright = one form of IPR
 - Right to authorise or prohibit copying

COPYRIGHT & OWNERSHIP

- 1st owner usually author
- Employers & employees
- Consultants & clients
- Commissioned work
- Assignment & licensing

COPYRIGHT OWNERSHIP

An independent consultant retains rights in the software or other copyright material it/he/she develops, unless there is a specific agreement in writing with the client about ownership.

“LOOK & FEEL” SOFTWARE

- Non-textual copying = ideas & structures
- Software business logic & basic business functions are not protected by copyright

EU DATABASE RIGHT

- Collection of independent works, data or other material arranged systematically, with the components individually accessible
- Substantial quantitative/qualitative investment in *obtaining, verification* or *presentation* of contents

EU DATABASE RIGHT

- “Maker’s” right in EU database
- Commissioning party may be the “maker”, not the database builder or compiler
- Creativity threshold for copyright in database
- Author will own any copyright in database

CONFIDENTIAL INFORMATION

is like ...

an ice cube ... Give it to the party who undertakes to keep it in a refrigerator and you still have an ice cube ... Give it to the party which has no refrigerator or who will not agree to keep it in one and by the time of the trial you just have a pool of water which neither party wants. It is the inherently perishable nature of confidential information which gives rise to unique problems.”

Lord Donaldson

CONFIDENTIAL INFORMATION AT LAW

- unequivocally of a secret nature; &
- imparted in confidence; &
- the defendant made unauthorised use of the information to the detriment of the person communicating it

CONFIDENTIAL INFORMATION PRACTICAL STEPS

- Be aware when material is confidential
- Be careful who knows about it
- Non-disclosure agreements & confidentiality clauses in contracts

PATENTS

Monopoly right for an invention for 20 years

Protects an *idea* which is:

- Novel
- Not obvious
- Inventive
- Capable of industrial application
- Not excluded, e.g.
 - Software “as such”
 - Business method

SOFTWARE PATENTS

- **Aerotel**
system for prepayment of telephone calls –
patentable
- **Macrossan**
system for online completion of forms
– not patentable

REGISTERED ® TRADE MARKS

- Evidence of ownership
- Exclusive right to use
- Continually renewable
- Automatic right to prevent others using
- Asset which may be assigned or licensed

TRADE MARKS & THE INTERNET

- Meta-tags & banner adverts
- Hyperlinks to logos
- Domain names

SAFEGUARDING INTELLECTUAL PROPERTY RIGHTS - IN CONCLUSION

- Variety and different uses of IPR
- Take practical approaches
- Be aware of rights and obligations