



IPR for researchers: Research and Industrial Property Right -

IPR Strategy

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Agenda

How can I get the name of my company protected?

What about the name of the product I invented, how can I prevent others from using the same name for their similar products?

Is brand the same as trademark?

There are multiple ways of protecting your product and brand of a company. The basic requirements for trademark protection, registering of a domain name and the name of the company will be discussed.

Intangible assets and IPRs

Technical and financial information, competence, know-how, recipes, algorithms, customer information, operating methods, pricing and other financial information, information that is central to the business, information that is not wanted to be made public or to the knowledge of a competitor

Trade secrets

Invention, research and development (R & D) activity results, data

Patent, utility model, trade secret, database and catalog protection

Literary and artistic works, presentations, reports, brochures, company instructions, photographs, computer programs, software, games, maps, films, plays, source code, presentation materials, data in systematic form (database and catalog protection)

Copyright and related rights

Company name, product name (domain)

Trademark, (auxiliary) business name, domain name

Product brand, name, appearance, color, logo, image, pattern, shape, packaging, sound signal

Trademark

The appearance of a product or package (or part of it), industry, industrial manufacturing, manufacturing machinery, spare parts

design right

Brand – Trademarks – Domain - Company name - Other

Brand

“A brand is a name, term, design, symbol or any other feature that identifies one seller's good or service as distinct from those of other sellers”

Goodwill

Trademarks

Registered
Unregistered

Others

Domains
Company names

Know how
Trade secrets

Design

IPR as part of business

**We make sure that
the company's IPR matters
are organized so that the
most central areas of the
business are protected
appropriately and to a
sufficient extent, and
secondly, that we do not
infringe the rights of third
parties.**

There are two "dangers" associated with IPR if things are not taken care of

Risk of violating our IPR

Risk of violating the rights of
third parties

- Let's identify what business is made of and what role intellectual property rights play in terms of business
- On the other hand, we recognize the importance of intellectual property rights in terms of operations
- We try to create added value for the company and make better operating methods.
- IPRs as asset, weapon, shield...

IPR strategy

- What is the company's maturity level, what kind of understanding, readiness and attitude does the company have for the protection / defense / administration of IP rights.
- Main steps:
 - Use of own intellectual property rights: DIY, licensing
 - Identification/evaluation, protection and administration of existing rights
 - How-to-get-IPRs; employment contracts, development work, subcontracting, invention guideline
 - Own use of IPRs; manufacturing, licensing, asset, development cost
 - Defense strategy, contracts, markings, secrecy
 - Use of other intellectual property: Licenses
 - Actions of the 3rd parties: company under attack; safeguards, cancellations, claims
 - Other things: Resources and budgeting, guidelines and policies, processes

THE TOP 100 MOST Valuable Brands 2024

Below, we show the world's most valuable brands based on Brand Finance's Global 500 ranking in 2024.

How is a brand's value determined?

Brand Revenues × Brand Strength = Brand Value

Brand Revenues includes brand royalties

Brand Strength Brand investment, brand equity, and brand performance



Trademarks

- The protection is determined by the goods and services classification of the application / registration.
- Must not be confused with previous trademarks or company names (time priority) and the mark must be distinctive.
- The classification determines the area of exclusive protection of the trademark, and based on the list, the distinctiveness of the mark is evaluated as well as the risk of confusion with other marks.
- Valid for 10 years at a time, but with the option to renew forever.
- Compulsory use: must be used within 5 years of registration
- The trademark is valid in a certain geographical area, i.e. Finland, USA or EU.

**Obtaining
trademark
protection
generally
requires
registration ®.**

SISU Gifu®

Trademark checklist

- Are the brand elements and commercial logos central to the business protected by relevant forms of protection?
- The geographical dimension of the territorial protection of the trademark: does the trademark protection apply to areas relevant to the subject's business?
- Targeting of substantive protection: Does the exclusive right target a category that is essential for the brand's business and industry?
- If the trademark is registered to a third party, is there an agreement on the transfer of the trademark to the object or does the object have contractual control over the trademark registered by the third party?

Company name, auxiliary business name

- The business description to be registered in the trade register of the company should cover the most important functions of the company
- If the business name has not been used within 5 years, and the owner of the business name does not show an acceptable reason for this, PRH can cancel the business name (external parties can apply for cancellation)
- Cannot be licensed, intended to identify the company
- If the name of the company contains the name of a partner/employee, how has it been agreed on the continuity of the name after the end of the contractual relationship? (also connection to the trademark)



**Business name or
auxiliary business
name provides
protection in
Finland - protection
does not extend
outside of Finland**

Domains and Social media

The exclusive right to a registered Finnish business name/trademark does not guarantee that the company will be allowed to register the corresponding name as a domain name.

On the other hand, a registered FI domain name does not guarantee that the company will get a business name/trademark corresponding to the registered domain name.

- The suffix of Finland's country code is .fi (administered by Traficom).
- When registering business names, PRH does not examine whether the business name is mixed with existing domain names.
- FI domain names may not be based on someone else's protected name or brand.
- The Finnish domain name and its owner information can be checked in the Traficom FI domain name search.
- International ones (.com) e.g. from the service providers

**Social Media,
Valuable marketing
channels**

**Recommendation to
register accounts for
the most common
application services
for the company**

Trade secrets and Data

Conditions that must be met in order for information to be considered a trade secret:

1. The information is not generally known or easily accessible
2. Information has economic value in business operations
3. The legal holder of the information has taken reasonable measures to protect it.

Use and licencing data

1. Content and origin of the data
2. The owner/holder of the data and their right to the data
3. the right to transfer data further
4. Who can use the data and where purpose/situations?
5. Can the data be used commercially / in R&D / in the study?
6. How can the data be processed/edited?
7. Possible restrictions on the use of data
8. Confidence?

General notes on all registered IPR

Check	
✓	Registration status: Registered rights, pending applications and their status
✓	Information found in the register: owner information (joint ownership), names (who is the owner, inventor, etc.), addresses, renovations
✓	Territorial scope: where protected (all relevant business areas)
✓	Material scope: to what extent is the right protected, does the classification of goods and services cover e.g. the essential business and the object to be protected
✓	Possible encumbrances (if registered): licensing, securities, pledges and other agreements (franchise agreements, cohabitation agreements, etc.) (if registered)
✓	Search with the company's old business names: Checking changes in the object's business name and performing the search also with the object's old business names in case the holder's name change notice is neglected
✓	Objection, invalidity and infringement proceedings: whether the registered rights (or applications) are subject to objection, invalidity or infringement proceedings

Relevant registers: PRH, EUIPO, WIPO, Tmview, design view, Patent registers, Traficom domain name search, other national registers

Few words about IPR agreements

- Individual agreements serve as a tool for promoting the IPR strategy, even if the main goal of the agreement is not to promote the IPR strategy (e.g. license agreement vs. employment agreement)
- Wide freedom of contract, especially with regard to license agreements, there is generally little regulation
- The following concepts should be distinguished:
 - assignment of intellectual property rights vs. licensing
 - assignment of intellectual property rights vs. assignment of a protected product/work (e.g. delivery of goods)
 - in terms of software distribution, traditional license vs. right of access (SaaS, etc.)
- Licences are mixtures

Party A grants a license to Party B which is:

- i) perpetual/revocable*
- ii) royalty-free/subject to royalty*
- iii) non-exclusive/exclusive*
- iv) sublicensable/non-sublicensable*
- v) transferable/non-transferable*
- vi) worldwide license/limited to region A*
- vii) for unrestricted use for any purpose/restricted for field A*
- viii) Only to reproduce / modify / create derivative works / distribute / publicly perform / publicly display*

KPMG IPR Services

IPR BASIC

IPR Contracts; Licensing & Transfer

IPR internal process, documents

IPR Help Desk

IPR Registrations; (TM)



BUY ←
SELL →

IPR SHIELD

IPR Help Desk

IPR market monitoring

IPR Strategies & Instructions

IPR warning letters

IPR Registrations; (TM)



IPR COMPLIANCE

IPR internal process, documents

IPR Strategies & Instructions

IPR Registrations; (TM)



IPR ANALYSIS

IPR Due Diligences

IPR valuation

IPR legal ground check; registrations, contracts



Links to information

Trademarks:

- PRH / Finland: <https://tavaramerkkietietopalvelu.prh.fi/fi/>
- EUIPO / EU : <https://euipo.europa.eu/eSearch/>
- WIPO / world : <https://www.wipo.int/reference/en/branddb/>

Domains:

- Traficom FI: <https://www.traficom.fi/fi/viestinta/fi-verkkotunnukset/>
- WHOIS (.com): <https://whois.domaintools.com/>



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