

Session 3

MONITORING AND ENFORCING YOUR RIGHTS + ENSURING FTO

Content

Presented content

- Recap: monopoly rights
- Infringement and free-riding
- Freedom to operate
- Monitoring, action and enforcement

IP Strategy activity

- Case study FTO and NPD
- I Monitoring and enforcing your rights/ Freedom to Operate



Reminder: IP Rights

- Limited monopoly (exclusion) rights
 - Scope, territory and time
- Use of unauthorised ‘rights’ = infringement
 - If in-force in the relevant territory
- Both registered and unregistered rights can be infringed
- Rights owners can bring an action for damages against infringers

'Freedom to operate' search

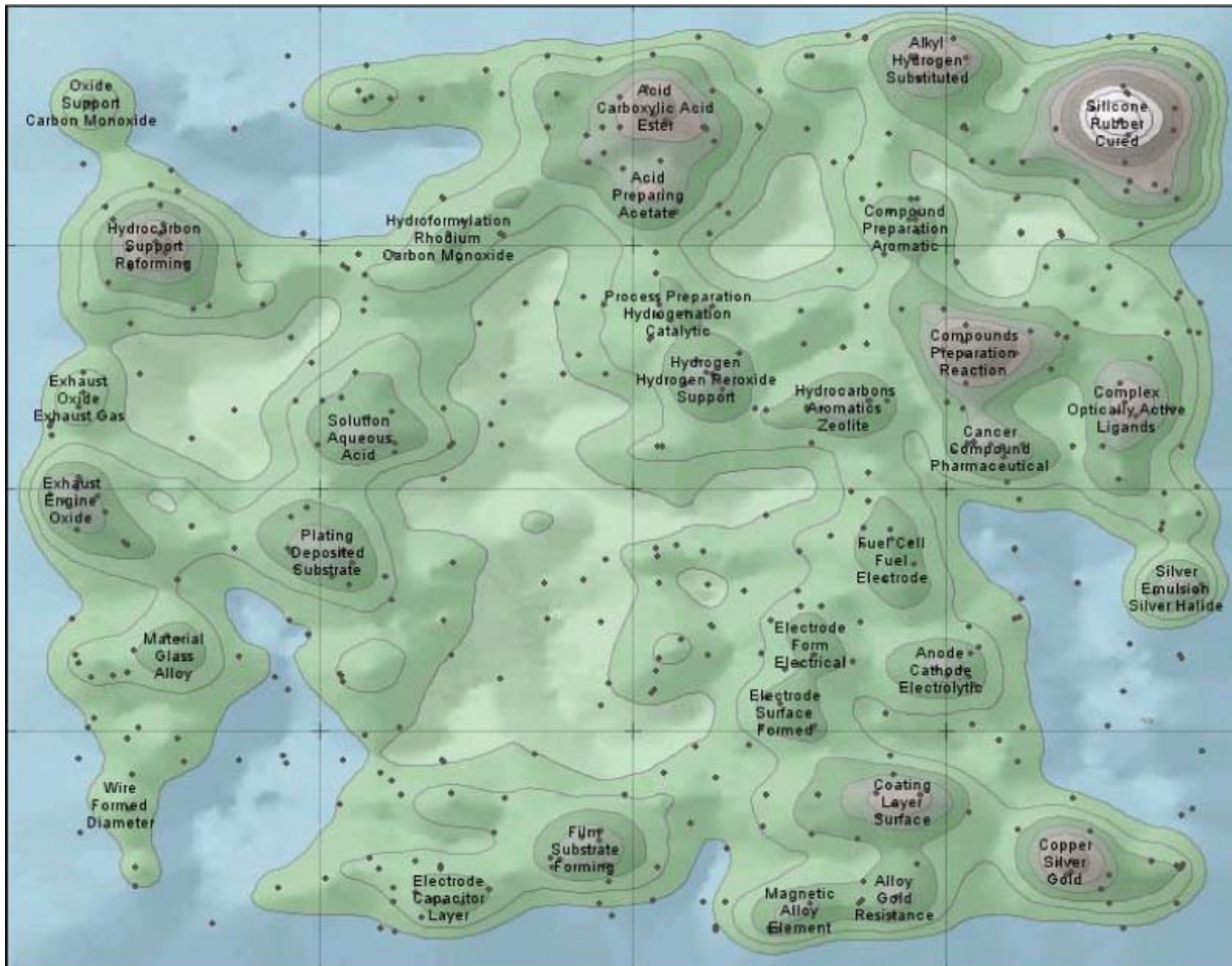
What is it?

- Due diligence process.
- Helps identify potential legal barriers to commercializing your products/ services/ technologies (in the target sectors/ territories).
- Examines the claims of other IP rights holders (scope and territory)
- Assesses your risk of potential infringement.

Methodology

- Search: database of registered IP (patents, trademarks, designs etc)/
- Identify: in-force / pending rights that may overlap with the rights of the company.
- Assess: risk of continuing
- Suggest: mitigating action e.g. **seeking a license of rights/** cross licensing.

IP Landscape



Infringement, counterfeiting and 'free-riding'

- Too close?
- Not close enough?
- Sounds familiar but...?



Monitoring for infringement

- IP databases/ trade magazines
- Identified competitors
- Routine searching
- Follow up on informal information (tip-offs')

- TAKE ACTION!
- 'Cease and desist'
- Be careful of national law that makes it an offence to issue '**Unjustified Threats**'.
- Remember – inviting someone to 'take a license can be a way to generate a new revenue stream!

Case Study: FTO and NPD



Balkans Agri Case study

Questions Part 3 (FTO and Infringement)

Q: If the simple Alfa patent is very broad in scope and covers their new invention, what should Nenad and Andela do when they plan to expand into Poland and Germany?

A: Conduct an FTO to assess whether they will infringe the Swiss patent and any others when they expand into Poland and Germany.

IP Strategy Activity J: – FTO and enforcement

