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INTRODUCTION


GUIDE TO GOING GLOBAL SERIES

Many companies today aim to scale their businesses globally and into multiple countries simultaneously. In order to help clients meet this challenge, we have created a handy set of global guides that cover the basics companies need to know. The Guide to Going Global series reviews business-relevant corporate, employment, intellectual property and technology, and tax laws in key jurisdictions around the world.

INTELLECTUAL PROPERTY AND TECHNOLOGY

Inside this guide, we outline crucial aspects of IPT laws in 29 jurisdictions that are particularly relevant to businesses seeking to expand their operations globally. We also summarize some fundamental commercial terms that customarily appear in IPT-related agreements.

You will find answers to such common questions as:

• Which jurisdictions recognize moral rights?
• What does my business need to do to have an enforceable assignment of intellectual property from an employee, from a consultant?
• What kind of liability can be excluded from a commercial contract?

Our goal is to make the guide as readable and informative as possible, providing you just the background you need to get an overview of the IPT laws in the selected jurisdictions. This is not a substitute for professional legal advice. If you have questions regarding specific matters, we encourage you to contact one of our contributors listed in the contributors section of this guide. With nearly 500 dedicated IPT lawyers around the globe, DLA Piper’s IPT group is ready to handle your legal needs wherever you do business.

Also, please note that the guide’s use of the term “trademarks” also refers to service marks, unless specifically addressed separately. The summary of intellectual property covers only the most commonly used categories worldwide (for example, we have not addressed plant patents). We have also referred to international treaties and conventions with their most commonly used names and not their formal titles (such as the TRIPS Agreement, the Berne Convention, the Paris Convention and the Patent Cooperation Treaty).

We hope that you find this guide valuable and we welcome your feedback.
AUSTRALIA

INTELLECTUAL PROPERTY FRAMEWORK

Intellectual property rights (other than trade secrets and common law trademark rights) are generally governed by the laws of the Commonwealth and interpreted by court judgments. There are no state or territory-based intellectual property laws.

COMMERCIAL CONTRACT FRAMEWORK

Australia’s commercial contract framework is governed by the common law, supplemented by equitable doctrines, statutes (Commonwealth, state and territory) and international law instruments. There is no codification of the law governing contracts.

For consumer goods and services contracts (a consumer may include a business in certain circumstances), the Australian Consumer Law (ACL) (which is a schedule of the Competition and Consumer Act 2010 (CCA)) applies. This legislation covers purchases of goods or services worth less than $40,000.00, or when the goods or services are of a kind that a person would usually buy for their personal, domestic or household use or consumption.

Commercial contracts with Commonwealth and state government agencies may be subject to additional regulations.

RECOGNIZED INTELLECTUAL PROPERTY RIGHTS

COPYRIGHTS

NATURE OF RIGHT

Copyright can subsist in both works, which include original literary, dramatic, musical and artistic works, and subject-matter other than works, which include sound recordings, cinematograph films, television and sound broadcasts and published editions of works.

There is no registration requirement or publication requirement for a valid copyright (with the exception of television and sound broadcasts and published editions of works, which must be published).

The exclusive rights for original works are to reproduce, publish, perform, communicate to the public and make an adaptation of the work, and to enter into commercial rental arrangements for a work reproduced in a program or sound recording.

The exclusive rights for subject matter other than works are to make a copy of the work, communicate it to the public and to enter into a commercial agreement in respect of the work.
LEGAL FRAMEWORK

Copyrights are governed by the Copyright Act 1968 (Copyright Act). There is no state-based copyright law and there is no common law of copyright, but there are court judgments that impact the interpretation of the Copyright Act. The Copyright Act provides for moral rights for original works and subject matter other than works except for sound recordings, sound and television broadcasts and published editions. It also provides performers’ rights for performances.

Australia is a party to the Berne Convention, the TRIPS Agreement, WIPO Copyright Treaty and the WIPO Performances and Phonograms Treaty.

DURATION OF RIGHT

For original works that are published during the author’s lifetime, copyright protection lasts for 70 years after the death of the author. For original works that are not published during the lifetime of the author, the copyright protection lasts for 70 years from the date of first publication.

For subject matter other than works, the duration of the protection depends on the type of work. For television and sound broadcasts, copyright lasts for 50 years from the date of broadcast and for printed editions, 20 years from the date of publication. For sound recordings and cinematograph film, copyright lasts 70 years from the date of publication.

OWNERSHIP/LICENSES

Joint ownership of an original work is recognized where the work has been produced by the collaboration of two or more authors and in which the contribution of each author is not separate from the contribution of the other author(s). Subject to a written agreement to the contrary, all joint owners of copyright must consent to the licensing of the copyright by any other joint owner.

An owner of a copyright may grant a license over some or all of the owner’s rights. Statutory licensing schemes operate to allow certain copyrights to be used without the permission of the copyright owner, but this is conditional on the payment of equitable remuneration for that use. An owner can also assign their copyright or future copyright to another person.

REMEDIES FOR INFRINGEMENT

The court may grant relief for an infringement of copyright by way of injunction, damages or an account of profits. Criminal penalties are also available.

In cases of innocent infringement, where the defendant was unaware or had no grounds for suspecting that their act constituted infringement, damages are unavailable.

The court has discretion to award additional damages. In doing so, the court must consider, among other factors, the flagrancy of the infringement, the need to deter similar infringements, the conduct of the defendant, whether the infringement involved conversion of a work and the benefits that accrued to the defendant by virtue of the defendant’s infringement.
Mask Works/Circuit Layouts

Nature of Right
Protection is given to the layout of integrated circuits (or semiconductor chips, commonly known as computer chips) under the Circuit Layouts Act 1989 (CLA), if the following requirements are met:

(i) The circuit layout is a representation fixed in any material form of the three-dimensional location of the active and passive elements and interconnections making up an integrated circuit;

(ii) The circuit layout is original; and

(iii) The circuit layout is either made by an eligible person or first commercially exploited in Australia or another eligible country.

The owner of an original circuit layout has exclusive Eligible Layout Rights (EL Rights), which include the exclusive rights to:

(i) Copy the layout, directly or indirectly, in a material form;

(ii) Make integrated circuits from the layout;

(iii) Exploit it commercially in Australia; and

(iv) Authorize another person to do any of the above acts.

Authorization is usually given in the form of a license.

Registration is not required for layout rights and protection is automatic.

Legal Framework
Circuit layouts are governed by the Circuit Layouts Act 1989.

Duration of Right
The duration of protection is ten calendar years after the calendar year in which the circuit layout was made. If the circuit layout is first commercially exploited within that period, the term is ten calendar years after the year in which commercial exploitation first took place.

Ownership/Licenses
The maker of an eligible circuit layout is the first owner of its EL Rights. EL Rights are personal property rights that can be assigned, licensed and devolved in a will.

Remedies for Infringement
The available remedies for infringement are an injunction to stop the infringing activities and either damages or an account of profits.

If the defendant’s act was an innocent infringement (that is, they were not aware, and had no reasonable grounds for suspecting, that their act constituted an infringement), the plaintiff is not entitled to any damages against the defendant. In such circumstances the plaintiff is, however, entitled to an account of profits.

Additional damages may also be awarded on the same basis as additional damages for infringement of copyright under the Copyright Act 1968.
PATENTS

NATURE OF RIGHT
A patent must be applied for and a statutory right granted through registration.

An owner of a registered patent for a product has exclusive rights to:

(i) Make, hire, sell or otherwise dispose of the product;

(ii) Offer to make, sell, hire or otherwise dispose of the product;

(iii) Use or import the product; or

(iv) Keep the product for the purpose of doing any of the above.

An owner of a registered patent that is a method or process has exclusive rights to use the method or process, or exercise any of the above exclusive rights in respect of a product resulting from such use.

The owner also has an exclusive right to authorize another person to exercise the above rights.

There are two types of patents: standard patents and innovation patents.

To be patentable, an invention must be a manner of manufacture, novel, involve an inventive step (or innovative step for innovation patents), useful and not have been secretly used.

LEGAL FRAMEWORK
Patents are governed by the Patents Act 1990.

Australia is a party to the Paris Convention, the Patent Cooperation Treaty, the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure 1977, and the TRIPS Agreement.

DURATION OF RIGHT
The duration of protection is 20 years from the effective date of filing for a standard patent and eight years from the effective date of filing for an innovation patent. Patent rights are based on a “first to file” system.

OWNERSHIP/LICENSES
A patent owner can grant a license to another party. The patent owner should register the license for it to be defensible against third parties. However, failure to register the license does not affect the validity of the license. Compulsory licenses may be granted in limited circumstances if the owner fails to exploit their patent.

A patent owner can assign their patent interest (or part of the interest) to another person. They must register the assignment for it to be defensible against third parties. However, failure to register does not affect the validity of the assignment.

Patents can be owned jointly. Co-owners can exercise their exclusive rights without accounting to the other. Co-owners cannot grant a license or assign their interest without consent of the other co-owners.
REMEDIES FOR INFRINGEMENT
The available remedies for infringement include injunction and damages or an account of profits. The damages may be calculated with reference to the value of the diverted sales or the going royalty rate that the infringer would have had to pay had a license been granted.

A court can refuse to award damages or make an order for an account of profits if it determines that the infringement was innocent. An innocent infringement occurs when the defendant was not aware, and had no reasonable grounds for suspecting, that their act constituted an infringement.

TRADEMARKS

NATURE OF RIGHT
Trademarks in Australia are protectable on a first to use or register-based system. Both registered and unregistered marks can be protected. A registered trademark is a sign used to distinguish the goods and services of one trader from those of another.

A sign can be a word, phrase, letter, number, sound, smell, shape, logo, picture, aspect of packaging or a combination of these. The objective of registered trademark protection is to identify and protect a business' goodwill associated with its products and services from abuse by others, and equally to protect the consumer by indicating the trade source of the goods or services.

LEGAL FRAMEWORK
Australian trademark law is based on the Trade Marks Act (TMA) as well as common law use-based rights which provide protection for unregistered rights under the common law tort of passing off.

Trade practices legislation, principally the Competition and Consumer Act 2010 (CCA), provides additional remedies to trademark owners of registered and unregistered trademarks.

Registered trademarks can be signified through use of the ® symbol.

Unregistered trademarks can be signified through use of the ™ symbol.

Australia became a party to the Trademark Law Treaty in 1998.

Australia became a party to the Madrid Protocol in 2001.

DURATION OF RIGHT
Subject to fulfilling the necessary requirements, a trademark registration provides a valuable statutory monopoly for an indefinite period of time. After the initial ten year registration period, the registration must be renewed every ten years and can be extended indefinitely at ten year intervals without the need to provide evidence of use.

OWNERSHIP/LICENSES
A trademark registration grants exclusive rights in the trademark to use, license or sell the trademark within Australia for the goods and services for which it is registered. This means the owner of a registered trademark can prevent others from using the mark or a deceptively similar mark in relation to the same or similar goods or services.
REMEDIES FOR INFRINGEMENT
Where infringement of a registered right is established, the relief that a court may grant includes an injunction to prevent further infringement and either damages or an account of profits at the plaintiff’s option, and legal costs. Registered trademark owners may also give Australian Customs Service a notice objecting to the importation of goods that infringe their registered trademarks.

If a trademark is not registered and another person uses it, a passing off action under common law or a claim for a breach of the prohibition against misleading and deceptive conduct (under the CCA) may be pursued. Successfully pursuing an action for passing off can be considerably more difficult than taking action under the TMA because an action for passing off requires proving goodwill or reputation in the trademark and proving that use of the trademark has misled or deceived consumers as to the origin of goods and services sold under the mark.

TRADE SECRETS

NATURE OF RIGHT
Trade secrets are treated as “confidential information” and can be protected through a breach of confidence claim.

Such a claim can be brought if:

(i) The information was confidential;

(ii) There was an obligation of confidence on the defendant; and

(iii) The defendant used the information without the plaintiff’s consent and to their detriment.

LEGAL FRAMEWORK
Confidentiality of trade secrets is a common law and equitable right. Trade secrets and confidential information do not give rise to a proprietary right but are usually specifically dealt with in contracts between parties in such a manner as to replicate most property related rights.

DURATION OF RIGHT
There are no specific statutory limits applicable to trade secret rights. For breach of a confidentiality agreement (or provisions), a six-year limitation period will apply.

OWNERSHIP/LICENSES
Trade secrets cannot be assigned as they are not property. However, contractual rights to trade secrets can be assigned and licensed. An assignee or licensee can sue others for a breach of confidence.

REMEDIES FOR INFRINGEMENT
Remedies for a breach of confidentiality in trade secrets include the equitable remedies of injunctions, imposition of a constructive trust, delivery-up, equitable compensation and an account of profits, in addition to usual remedies for breach of contract where relevant.

In determining the severity of the remedy, the court may take into account the advantage given to the defendant when they acquired and exploited the plaintiff’s trade secrets.
INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

EMPLOYEES
Copyright – The Copyright Act provides that the employer will own the copyright if an employee made the work “in pursuance of the terms of his employment by another person under a contract of service or apprenticeship.” Recent case law has clarified that it will not be sufficient that an employment relationship exists and instead the employee must have made the work within the scope of their duties or because the contract of employment expressly or impliedly required (or at least authorized) the work to be made.

Patent – Patent legislation does not provide for the ownership of an invention in an employment context. Under the common law, the issue is whether the invention was made in the course of the employee’s employment and whether it was the employee’s role to invent, i.e., whether they had a “duty to invent.” This frequently is (and should be) dealt with in the terms of the contract of employment although the contract may not always be determinative in deciding whether the employee owns the patent.

Confidential information – Employment contracts frequently include a confidentiality provision or there is a standalone confidentiality agreement. Even where there is no express agreement, a court will usually imply an obligation of confidence in an employment relationship and will consider factors such as the nature of the relationship and the nature of the information.

Mask Works/Circuit Layouts – Under the CLA, if a circuit layout was made by a person in the course of his employment under a contract of service or apprenticeship, the employer is the owner unless there is an agreement in writing to the contrary.

CONSULTANTS/CONTRACTORS
An independent contractor (including a consultant) owns the copyright in any work, unless there is an agreement in writing executed by the parties to the contrary.

Equally, an independent contractor has the right to patent an invention that he invented unless the contract between the contractor and the principal states otherwise.

It is often presumed that an independent contractor and a principal have a confidential relationship and thus the independent contractor has an obligation of confidentiality. However, specific confidentiality obligations are usually (and should be) included in the agreement between the parties.

KEY COMMERCIAL CONTRACT CONSIDERATIONS
REGISTRATION OF COMMERCIAL AGREEMENTS
There is no requirement to register commercial agreements. However, if security interests over personal property are created pursuant to an agreement they should be registered under the Personal Properties Securities Act 2009 (Cth). Registration is generally required to perfect the security interest and make it enforceable against third parties. Failure to register will not void the security but may result in the unregistered security interest being defeated by a later registered security interest or bona fide purchaser without notice.

RECOGNIZED LANGUAGE OF COMMERCIAL AGREEMENTS
It is preferable to use consumer friendly English.
COUNTRY-SPECIFIC ISSUES FOR ONLINE CONTENT
The Copyright Act provides a ‘safe harbor’ regime for service providers (‘carriage service providers’ as defined in the Telecommunications Act 1997), which limits their liability for copyright infringement by their customers (i.e., liability by authorizing the infringing acts of their customers). Service providers must satisfy certain criteria in order to be protected by this scheme. Recent case law has left open the possibility of service providers being found to have authorized copyright breaches through a failure to act against infringing customers.

ENFORCEABILITY OF ONLINE/CLICKWRAP/SHRINKWRAP TERMS
These types of terms and contracts are enforceable provided they are validly made, which includes ensuring that the users are made aware of and accept the terms of the contract prior to purchase.

GOVERNING LAW
Governing law and choice of jurisdiction (venue for resolution) clauses will generally be upheld by state and Federal Courts in commercial contracts, provided such choice of law does not (and will not) avoid any mandatory law (e.g., the ACL for consumer contracts) that would otherwise be applicable. That is, for example, one cannot contract out of the ACL for a consumer contract in Australia by choosing the law of a foreign jurisdiction to apply to govern the contract.

KEY COMMERCIAL CONTRACT TERMS

ENFORCEABILITY OF WARRANTY DISCLAIMERS
Warranty disclaimers which purport to exclude, restrict or modify the consumer guarantees as contained in the ACL are unenforceable.

Warranties against defects must be provided in addition to the consumer guarantees. Documents that evidence a warranty against defect, which may include receipts, labels or packaging in addition to a more formal contract, must contain certain information including the following mandatory text which is provided under the ACL:

Our goods come with guarantees that cannot be excluded under the Australian Consumer Law. You are entitled to a replacement or refund for a major failure and compensation for any other reasonably foreseeable loss or damage. You are also entitled to have the goods repaired or replaced if the goods fail to be of acceptable quality and the failure does not amount to a major failure.

ENFORCEABILITY OF EXCLUSIONS/LIMITATIONS OF LIABILITY
Clauses that seek to exclude certain warranties or consumer guarantees or limit liability will be construed strictly against the person that seeks to rely on the clause.

Consumer contracts cannot exclude or limit certain consumer guarantees provided under the ACL or limit or exclude liability for breach of them. Any clause that seeks to do this will be unenforceable and such conduct could be considered to be misleading or deceptive and lead to legal action being taken against a person who included such clause in a contract or statement to a consumer.

INDEMNIFICATION
Express indemnities are recognized and will generally be enforceable.

Caps on liability under indemnification clauses are generally enforceable but, in some circumstances, may be considered unfair and therefore unenforceable.
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AUSTRIA

INTELLECTUAL PROPERTY FRAMEWORK

In general, the intellectual property rights in Austria are governed by specific Federal statutory laws, as follows:

(i) Copyright – the Copyright Act (Urheberrechtsgesetz)
(iii) Utility Models – the Utility Model Act (Gebrauchsmustergesetz)
(iv) Trademarks – the Trademark Act (Markenschutzgesetz)
(v) Semiconductor Protection Act (Halbleiterschutzgesetz)
(vi) Designs and utility patents – the Designs Act (Musterschutzgesetz)

Certain other statutory laws protect other manifestations of intellectual property that do not fulfill the requirements of the intellectual property types cited above in various ways (in particular the Act on Unfair Competition (Gesetz gegen den unlauteren Wettbewerb), which imposes a more general prohibition or limitation to takeover of other persons’ intellectual works and offers certain amount of protection for trade secrets and know-how, the Criminal Code (Strafgesetzbuch), which penalizes certain trade secret related actions, and the Commercial Code (Unternehmensgesetzbuch) and Company Register Code (Firmenbuchgesetz), which provide protection for names and company names).

COMMERCIAL CONTRACT FRAMEWORK

The Austrian law contains extensive Federal legislation (both of dispositive and mandatory nature) on commercial contracts, both considering the general principles (such as interpretation) and the specific contract types. In business-to-consumer, the Consumer Protection Act (Konsumentenschutzgesetz) is also of great relevance.

The general principles of contracts as well as a large number of contracts are regulated in the Civil Code (Allgemeines Bürgerliches Gesetzbuch) and Commercial Code (Unternehmensgesetzbuch); including the publishing contract (Sections 1172 and 1173 Civil Code).

Further regulations are contained in the IP-specific acts mentioned above as well as in statutory laws regulating other specific contract types.

The enforcement of the commercial contracts is subject to the general civil proceedings regulations (the Civil Proceedings Act (Zivilprozessordnung) and the Enforcement Act (Exekutionsordnung)) and is conducted by the courts.
RECOGNIZED INTELLECTUAL PROPERTY RIGHTS

COPYRIGHTS

NATURE OF RIGHT
Copyrights are available for works that are “unique intellectual creations” (eigentümliche geistige Schöpfung) in the fields of literature (including computer programs), musical art, fine arts and movie arts. The term contains the aspects of human creativity and originality/individuality; no specific quality of work is required. There is detailed case law in Austria dealing with the assessment whether a work is subject to copyright. The work does not have to be fixed in a tangible medium in order to be protected. There is no obligation to register.

The Copyright Act also provides protection for a number of ‘related rights’ (ancillary copyright – Leistungsschutzrecht) that are not copyright but are, in principle, subject to the same or similar regulations. These are the rights of performers and presenters, rights of producers of media and rights of broadcasters. Certain works, i.e., databases and photographs, can be subject to both copyright (if sufficiently original) and ancillary copyright. Finally, the Copyright Act also provides protection for technical measures intended to prevent copyright infringement (digital rights management protection).

Copyright owners have the exclusive right to exploit the work (including the right to reproduce, distribute, lend, lease, prepare derivative works, make work available, emit and publicly perform) as well as certain personal rights (such as right to be named as author).

LEGAL FRAMEWORK
Copyrights are governed by the Copyright Act, which also implements various EU directives.

Austria is also a party to a number of international treaties (including the WIPO Copyright Treaty and the TRIPS Agreement).

DURATION OF RIGHT
In general, the duration of copyright protection is 70 years after the author’s death. There are specific regulations for:

(i) Film works, where the duration of the right is 70 years after the latest death of the following persons: the main director, the author of the script, author of the dialogues and the author of musical works made specifically for the film;

(ii) Related rights of the performers and presenters, where the duration of the right is 50 years after the presentation or, if the presentation was recorded and published or publicly reproduced, within this deadline, 70 years after the publication or reproduction;

(iii) Photographs which are not subject to copyright, where the duration of the right is 50 years after the making of the photography or, if published, 50 years after publication;

(iv) Rights of the producer of audio media, where the duration of the right is 70 years after the publication or 50 years after the recording if not published within this period;
(v) Radio broadcasts, where the duration of the right is 50 years after the broadcast; and
(vi) Databases not subject to copyright, where the duration of the right is 15 years after the finalization of the database or, if published, 15 years after the publication.

Renewal of rights provided by the Copyright Act is not possible.

OWNERSHIP/LICENSES
The owner of a copyright can only be a natural person or his successor; a legal entity may only be a licensee. The right as such is not transferrable (except in case of universal succession i.e., inheritance), the author may license only one, more, or all exploitation rights (e.g., right to reproduce, right to distribute, right to make the work available, right to emit); personality rights (e.g., right to be named as author) are in principle not transferable or limitable.

Joint ownership of copyrights is recognized.

REMEDIES FOR INFRINGEMENT
Civil remedies for copyright infringement include:

(i) Cessation of infringement (preliminary or permanent injunction);
(ii) Claim for elimination of the circumstances constituting the infringement, including the destruction of infringing copies;
(iii) Rendering of account;
(iv) Publication of judgment; and
(v) Monetary relief (adequate consideration, damages and handover of profits).

Criminal remedies may include:

(i) Monetary fine; and
(ii) Imprisonment in case of professional infringement.

Preventing importation of infringing goods and cooperation of customs officers may also be invoked.

MASK WORKS

NATURE OF RIGHT
Protection is available for three-dimensional structures of micro-electric semiconductor products (topographies as well as gate arrays), which are results of its creator’s own intellectual effort and is not commonplace in the semiconductor industry.

A “semiconductor product” is the final or an intermediate form of any product (i) consisting of a body of material which includes a layer of semiconducting material; and (ii) having one or more other layers composed of conducting, insulating or semiconducting material, the layers being arranged in accordance with a predetermined three-dimensional pattern; and (iii) intended to perform, exclusively or together with other functions, an electronic function.
The “topography” of a semiconductor product is a series of related images, however fixed or encoded representing the three-dimensional pattern of the layers of which a semiconductor product is composed and in which series, each image has the pattern or part of the pattern of a surface of the semiconductor product at any stage of its manufacture.

The owner of the semiconductor protection right may exclude any person in business traffic from reproducing the topography or its separately exploitable parts, producing images of and instructions for production of topography, as well as from offering, putting into circulation or importing such images and instructions.

LEGAL FRAMEWORK
Semiconductor protection is governed by the Semiconductor Protection Act and ancillary ordinances as well as the EU Semiconductor Protection Directive and the TRIPS Agreement.

DURATION OF RIGHT
The duration of protection for semiconductors is ten years from registration (ends at end of tenth calendar year). There must be a registration within two years of first non-confidential commercial exploitation.

OWNERSHIP/LICENSES
Rights in semiconductor products and their topographies are freely transferrable. The perfection of the transfer is subject to the registration in the semiconductor’s registry.

REMEDIES FOR INFRINGEMENT
Civil remedies for infringement include:

(i) Cessation of infringement (preliminary or permanent injunction);

(ii) Claim for elimination of the circumstances constituting the infringement, including the destruction of infringing copies;

(iii) Rendering of account;

(iv) Publication of judgment; and

(v) Monetary relief (adequate consideration, damages and handover of profits).

Criminal remedies include:

(ii) Monetary fine; and

(ii) Imprisonment in case of professional infringement.

PATENTS

NATURE OF RIGHT
Patents are granted on inventions which are novel, which, having regard to the state of the art, are not obvious to the person skilled in the art, and which can be applied in the industry.

The patent owner has an exclusive right to produce, put into circulation, offer for sale and use the claimed invention.

**DURATION OF RIGHT**

Patent rights have a duration of 20 years from the filing date of an application.

**OWNERSHIP/LICENSES**

The inventor or his successor in title has a right to the granted patent. Until the contrary is proved, the first applicant shall be regarded as inventor.

Patent owners may grant licenses. The license may, but does not need to, be recorded in the patent register for the perfection of the license. However, the license is effective towards third parties only upon the registration.

Compulsory licensing is available in certain exceptional cases (such as the owner failing to use the patent).

**REMEDIES FOR INFRINGEMENT**

Civil remedies for infringement include:

(i) Cessation of infringement (preliminary or permanent injunction);

(ii) Claim for elimination of the circumstances constituting the infringement;

(iii) Rendering of account;

(iv) Publication of judgment; and

(v) Monetary relief.

Criminal remedies may include:

(i) Monetary fine; and

(ii) Imprisonment in case of professional infringement.

Based on a regulation of the European Council (EC No. 608/2013) in combination with the Austrian Product Piracy Act (PPG 2004), an application for action may be filed with the Customs Authorities in order to prevent the import of infringing goods.

**TRADEMARKS**

**NATURE OF RIGHT**

Trademarks can be any sign that can be represented graphically, in particular words, including personal names, designs, letters, numerals and the shape or style of the goods, provided that such signs are capable of distinguishing the goods or services of one enterprise from those of other enterprises. Three-dimensional marks and sound marks are also protectable. Haptic or olfactory marks and national emblems are not protectable as trademarks in Austria.
**LEGAL FRAMEWORK**

Austrian Trademark Act (*Markenschutzgesetz*) protects registered marks. Non-registered marks, in Austria termed “signs,” may have protection according to Article 9 of the Austrian Law Against Unfair Competition.

Austria became a member of the Madrid Agreement in 1909 and Madrid Protocol in 1999.

Austria signed the Trademark Law Treaty in 1994.

**DURATION OF RIGHT**

Trademark registrations are in effect for ten years and are renewable repeatedly for ten-year periods by paying a renewal fee.

**OWNERSHIP/LICENSES**

Trademark owners may grant licenses. A license may, but does not need to, be recorded in the trademark register.

**REMEDIES FOR INFRINGEMENT**

Civil remedies for infringement of trademarks include:

1. Cessation of infringement (preliminary or permanent injunction);
2. Claim for elimination of the circumstances constituting the infringement;
3. Rendering of account;
4. Publication of judgment; and
5. Monetary relief.

Criminal remedies for infringement of trademarks include:

1. Monetary fine; and
2. Imprisonment in case of professional infringement.

Registered marks can be filed with Austrian customs to prevent importation of goods that contain infringing marks.

**TRADE SECRETS**

**NATURE OF RIGHT**

Trade secrets as such are not a recognized intellectual property asset in Austria. Protection of trade secrets is, however, partly ensured by a number of more general statutory acts.

**LEGAL FRAMEWORK**

Trade secrets are addressed in a variety of legislation. In particular, Sections 122 – 124 Criminal Code penalize the discovery, publication or exploitation of trade secrets in various ways.

Unfair use of other persons’ trade secrets is also subject to the Act on Unfair Competition.
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REMEDIES FOR INFRINGEMENT
Civil remedies include:

(i) Cessation of infringement (preliminary or permanent injunction); and
(ii) Monetary relief.

Criminal remedies include:

(i) Monetary fine; and
(ii) Imprisonment in case of professional infringement.

Additional remedies are available under the Act on Unfair Competition.

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

EMPLOYEES
The Austrian Copyright Act does not recognize “works made for hire,” i.e., the original author is always the original owner of the copyright. Licensing of the exploitation rights is possible and Austrian law recognizes the implied license for an employer to use an invention of an employee who developed the invention within the scope of their employment using the employer’s resources (equipment or funding). Nevertheless, it is highly recommended that employers address the licensing of inventions developed by employees in the employment agreement. There is a statutory assumption of such license for computer programs.

Similar principles apply to patents, with the exception that there is a statutory transfer claim for inventions made by employees in public service (clerks). Otherwise, a transfer right must be agreed in the employment contract or collective contract.

In respect to semiconductors, the same principles as regarding patents apply, however, there is a statutory assumption for a license in case of works made for hire (applies to both employees and contractors). The same applies to designs and utility patents.

Trademarks are freely transferrable and can therefore also be made for hire for a legal entity.

CONSULTANTS/CONTRACTORS
Subject to the abovementioned exceptions, in the absence of an agreement, consultants and contractors will retain ownership of the intellectual property developed by them, even if contracted and paid for by another party. The agreement can, however, be oral and implied, nevertheless, written agreements are recommended for evidentiary purposes.

KEY COMMERCIAL CONTRACT CONSIDERATIONS

REGISTRATION OF COMMERCIAL AGREEMENTS
There is no general registration requirements for commercial contracts, except for agreements on transfer of patents and semiconductor rights which require a registration for perfection.

Registration of licenses for patents, utility patents, designs and trademarks is possible and necessary for the license to have erga omnes (absolute) validity, but is not required for the validity of the transfer itself.
RECOGNIZED LANGUAGE OF COMMERCIAL AGREEMENTS
There are strict requirements on the clarity of the business-to-consumer contracts, and the clarity is in principle jeopardized if the consumer is not familiar with the language of the contract. In case of Austrian consumers, unless a contract is in German, it will be likely assumed that an Austrian consumer will not understand the contract.

COUNTRY-SPECIFIC ISSUES FOR ONLINE CONTENT
The E-Commerce Act also provides limitations of liability for the providers of routing, search engine, caching, hosting and linking services under specific requirements in case of infringements.

ENFORCEABILITY OF ONLINE/CLICKWRAP/SHRINKWRAP TERMS
Online terms which are in line with the E-Commerce Act (and, if applicable, Consumer Protection Act) are recognized and fully enforceable.

The enforceability of shrinkwrap terms is severely disputed under Austrian and EU law. This is due to the provisions of the Austrian law stating that a contract should be finally concluded before it is executed, and most shrinkwrap agreements do not meet this standard. In addition, under EU law the Rome I and Brussels I regulations also affect this issue and in some cases limit the applicability of shrinkwrap licenses.

GOVERNING LAW
Governing law and venue for resolution of disputes (including arbitration) specified in a commercial contract will generally be accepted and recognized, under certain limitations. The governing law is in general subject to ordre public reservation. Additional and more severe limitations apply to business-to-consumer contracts and employment contracts. Dispute resolution and arbitration, clauses that materially disrupt the equilibrium between the parties (e.g., one-way arbitration clauses) should be carefully assessed in the specific case.

KEY COMMERCIAL CONTRACT TERMS

ENFORCEABILITY OF WARRANTY DISCLAIMERS
Limitations and exclusions of warranty claims are generally permissible, except if contra bonos mores, but to be interpreted restrictively. Such disclaimers are not permissible in business-to-consumer contracts.

ENFORCEABILITY OF EXCLUSIONS/LIMITATIONS OF LIABILITY
Exclusion or limitation of liability is permissible in principle for damages caused by slight negligence; they are not permissible for willful misconduct. Limitations or exclusions of liability for gross negligence are disputed and are not permissible in business-to-consumer contracts.

Furthermore, any limitation of liability should be assessed as to whether or not it is contra bonos mores in the specific case.

Exclusion or limitation of liability for death and injury is not permissible.

The same principles apply for caps on direct damages, i.e., a cap is considered as a limitation of liability and to be treated under the same principles.
Exclusion or limitation of liability for indirect or consequential damages is to a certain extent permissible, but these terms are not fully defined under Austrian law and a precise description of excluded damages are recommended.

**INDEMNIFICATION**

Express indemnities stated in contracts are, in general, permissible. Note, however, that the Austrian law does not possess a concept of indemnification comparable to US law, but an indemnification clause would rather be interpreted as an Austrian law construct (such as liability, warranty or guarantee). Therefore, it is likely that a court would apply the same Austrian law legal concepts to such limitations.
BELGIUM

INTELLECTUAL PROPERTY FRAMEWORK

In general, intellectual property rights in Belgium are governed by the following Federal statutory laws:


(iv) Database rights – Title 7 (Databases) and Title 5 (Copyrights and Neighboring Rights) of Book XI “Intellectual Property” of the Code of Economic Law.


In addition, certain other statutory laws may protect other manifestations of intellectual property that do not fulfill the requirements of the intellectual property types cited above, such as know-how, trade and industrial secrets, trade names, company names and domain names.

The new Commercial Code (the Code of Economic Law of 28 February 2013), which is referred to above, codifies and modernizes the present commercial and intellectual property legislation.

COMMERCIAL CONTRACT FRAMEWORK

The Belgian Civil Code, which provides the general principles of contract law, may apply to certain types of commercial contracts (such as exclusive distributorship and commercial agency) and may regulate contracts in specific sectors.

RECOGNIZED INTELLECTUAL PROPERTY RIGHTS

COPYRIGHTS

NATURE OF RIGHT
To qualify for copyright protection, a work must be original, which has been determined by case law to mean that the protected work must be the expression of the intellectual creation of its author. Even if the work consists of elements which, considered in isolation, are not an intellectual creation of the author who employs them, the author may express his creativity in an original manner and achieve a result which is an intellectual creation through the choice, sequence and combination of those elements.

The same requirement of originality applies to the copyright protection of databases, which is considered to be original when it constitutes the author’s own intellectual creation by reason of the selection or arrangement of their contents.

There is no registration process for copyright protection; the author’s right arises automatically with the creation. Mere ideas or concepts are not protectable.

LEGAL FRAMEWORK
Copyrights in Belgium are governed by Title 5 (Copyrights and Neighboring Rights) of Book XI “Intellectual Property” of the Code of Economic Law.

DURATION OF RIGHT
Generally, the duration of copyright in an author’s work is the author’s life, plus 70 years after his death. There are variations of this duration depending on the type of the protected work.

OWNERSHIP/LICENSES
Only natural persons (individuals) who have created a work may enjoy the status of an author, even where an author is an employee. However, in the latter case, there are a number of presumptions (such as those related to assignment of economic rights) that automatically favor employers.

Title 5 (Copyrights and Neighboring Rights) also includes a rebuttable presumption of authorship; the author is presumed to be the person shown as such on the work by virtue of the mention of his name or the appearance of another sign that enables his identification.

Persons collaborating directly towards the creation of a work become co-authors. Their copyright is indivisible. In these situations, the exercise of the right of co-authors is governed by agreement. Failing such agreement, no author may exercise this right in isolation, unless a court decision provides otherwise in case of a dispute. In situations in which the contributions of the authors may be individually identified, those authors may not, unless they agree otherwise, market their work in conjunction with new collaborators. However, they do share the right to exploit their contribution in isolation provided that such exploitation does not harm the joint work.

Contrary to the author’s moral rights, which are in principle non-transferable and inalienable, the economic rights are freely assignable, transferable and licensable (on an ordinary or exclusive basis), in whole or in part, in accordance with the provisions of the Civil Code.
GUIDE TO GOING GLOBAL - INTELLECTUAL PROPERTY AND TECHNOLOGY

REMEDIES FOR INFRINGEMENT
Rights holders are entitled to remedies under Title 9 (Civil aspects of the protection of intellectual property rights) and Title 10 (Aspects of procedural law of the protection of intellectual property rights) of Book XI “Intellectual Property” of the Code of Economic Law as well as under Book XVII (Specific legal procedures) of the Code of Economic Law. Reference should also be made to the saisie contrefaçon procedure, provided in Section 1369bis of the Judicial Code, which allows a rights holder to enter, without prior warning, the premises of an alleged infringer or an intermediary third party in order to find evidence of and more information regarding infringements.

Monetary relief can be sought with the damages as a lump sum. In case of a bad-faith infringement, monetary relief may also include a claim of unfair profits made, including accountability.

Finally, a number of supplementary, injunctive sanctions may be sought, such as (i) a recall or definitive removal from the channels of commerce or destruction of the infringing goods and in appropriate cases, of the materials and implements principally used in the creation or manufacture of these goods, (ii) the right of information, which orders the infringer to share precise information on the origin of the infringing goods or services, the distribution channels and the identity of any third parties involved in the infringement, and (iii) the dissemination of the decision, including the displaying and publishing of the decision in full or in part.

MASK WORKS

NATURE OF RIGHT
The topography of a semiconductor product shall be protected insofar as it satisfies the conditions that it is the result of its creator’s own intellectual effort and is not commonplace in the semiconductor industry. Where the topography of a semiconductor product consists of elements that are commonplace in the semiconductor industry, it shall be protected only to the extent that the combination of such elements, taken as a whole, fulfills the above-mentioned conditions. The protection shall apply solely to the topography to the exclusion of any concept, process, system, technique or encoded information embodied in the topography.

The rights holder shall have the exclusive and temporary right to reproduce and commercially exploit the topography. The rights holder may, however, not assert this exclusive right in respect of (i) reproduction solely for the purposes of analysis, evaluation or teaching of the topography or the concepts, processes, systems or techniques embodied in the topography, and (ii) a topography resulting from the analysis and evaluation of another topography carried out in accordance with item (i), at least insofar as the new topography is the result of its creator’s own intellectual effort and is not commonplace in the semiconductor industry.

The terms topography, semiconductor product and commercial exploitation shall be understood in the meaning defined in Council Directive 87/54/EEC of December 16, 1986 on the legal protection of topographies of semiconductor products. As a result, a ‘semiconductor product’ shall mean the final or an intermediate form of any product (i) consisting of a body of material which includes a layer of semiconducting material, and (ii) having one or more other layers composed of conducting, insulating or semiconducting material, the layers being arranged in accordance with a predetermined three-dimensional pattern, and (iii) intended to perform, exclusively or together with other functions, an electronic function. The ‘topography’ of a semiconductor product shall mean a series of related images, however fixed or encoded, (i) representing the three-dimensional
pattern of the layers of which a semiconductor product is composed, and (ii) in which series, each image has the pattern or part of the pattern of a surface of the semiconductor product at any stage of its manufacture.

LEGAL FRAMEWORK
Protection of semiconductor topographies is governed by Title 8 (Topographies of Semiconductor Products) of Book XI "Intellectual Property" of the Code of Economic Law.

DURATION OF RIGHT
The exclusive right related to the protection of topographies of semiconductor products shall come into existence when the topography is fixed for the first time and shall expire ten years from the end of the calendar year in which the topography was first commercially exploited anywhere in the world. The exclusive right shall expire where a topography has not been commercially exploited, anywhere in the world, within a period of one year from the date on which it was first fixed.

OWNERSHIP/LICENSES
The ownership of the exclusive right is granted to the creator of the topography of a semiconductor product. Where this topography is created by an employee in the course of his employment, the employer shall be deemed to be the creator, unless otherwise stipulated. Where this topography is created on commission, the person who commissioned the topography deemed to be the creator, unless otherwise stipulated.

Like a copyright and contrary to many other EU member states, the exclusive right is granted automatically, i.e. without the obligation to register, and is freely licensable and transferrable, including to successors in title of the rights holder.

REMEDIES FOR INFRINGEMENT
The remedies for infringement of rights in a semiconductor product are the same as those available for copyright infringement. See above remedies for Infringement section under Copyright.

PATENTS

NATURE OF RIGHT
A patent shall confer on its owner the right to prevent all third parties not having his consent: (i) from making, offering, putting on the market or using a product which is the subject matter of the patent, or importing or stocking the product for those purposes; (ii) from using a process which is the subject matter of the patent or, when the third party knows, or it is obvious in the circumstances, that the use of the process is prohibited without the consent of the owner of the patent, from offering the process for use in Belgian territory; and (iii) from offering, putting on the market, using, or importing or stocking for those purposes the product obtained directly by a process which is the subject matter of the patent.

An invention is eligible for patent protection if it is: (i) new; (ii) inventive; and (iii) capable of industrial application. An invention is new if it does not fall within the relevant state of the art. It is inventive if it would not be obvious to a skilled technician. Finally, the term industrial application is broadly construed and includes agriculture.
The novelty of an invention is not jeopardized if the invention was disclosed to the public in the course of six months prior to the filing of the application and it is due directly or indirectly to (i) an obvious abuse in relation to the applicant or (ii) the invention being shown at an exhibition organized by the public authorities or an official international exhibition. In the latter case, the applicant shall declare, when submitting his application, that the invention was actually disclosed during an exhibition and furnish a relevant certificate.

In order to benefit from the priority right, registrations must be carried out before the end of the 13th month following the date of the first registration (priority date). In addition, the applicant must make a “statement of priority” when applying.

Any person who, prior to the patent application or the priority date, used or possessed the patented invention in good faith on Belgian territory is entitled to continue the exploitation of the invention, notwithstanding the existence of a patent granted to a third party.

LEGAL FRAMEWORK
Patents in Belgium are governed by Title 1 (Patents) of Book XI “Intellectual Property” of the Code of Economic Law.

DURATION OF RIGHT
Patents have a duration of 20 years from the date of filing of the patent application. Renewal of the right is not possible.

Exploitation of the invention is not a prerequisite for maintaining patent protection. However, if the invention is not exploited in Belgium for a period of four years following the date of patent application or for a period of three years following granting of the patent, the competent government minister can grant a compulsory license.

OWNERSHIP/LICENSES
The Patents Act provides that the patent rights are owned by the inventor or his successor in title.

Each co-owner has a personal right to exploit the invention. Rights granted to third parties or action taken against patent infringement requires approval of all co-owners or, in case of disagreement, as determined by a court. In the event that one of the co-patentees wishes to assign his share, the other co-patentees have a pre-emption right over it for a three-month period from the moment they have been informed of the intention to assign. In addition, the “default” co-ownership regime as provided in the Belgian Civil Code (esp. with regard to succession rights) is not applicable to patent co-ownership.

If a patent application is submitted only by one owner without the involvement of the other joint owner(s), the other joint owners may initiate legal proceedings requiring the transfer of the patent or the patent application as joint owner.

REMEDIES FOR INFRINGEMENT
The remedies for patent infringement are similar to those available for copyright infringement. See above remedies for Infringement section under Copyright.
TRADEMARKS

NATURE OF RIGHT
A registered trademark provides its owner with an exclusive right to prevent any third party, without its consent, from: (i) using in business a sign that is identical to the trademark for goods or services that are identical to those for which the trademark is registered; (ii) using in business a sign that is identical or similar to the trademark and because the goods or services covered by the trademark and the sign are identical or similar, there is a risk of confusion in the mind of the public due to the association between the sign and the trademark; (iii) using in business a sign that is identical or similar to the trademark for goods or services which are not similar to those for which the trademark is registered, where the trademark enjoys a reputation in the Benelux territory and where use of the sign without due cause would take unfair advantage of or be detrimental to the distinctive character or the reputation associated with the owner of the trademark; and (iv) using a sign for purposes other than those of distinguishing the goods or services, where use of the sign without due cause would take unfair advantage of or be detrimental to the distinctive character or the reputation of the owner of the trademark.

Any signs (such as, but not limited to, names, designs, imprints, stamps, letters, numerals, shapes of goods or their packaging, colors and slogans) that are able to be represented graphically and used to distinguish the goods or services of a company are eligible to be registered as individual trademarks. However, signs solely comprising a shape that is imposed by the very nature of a product, which gives the product substantial value, or which is necessary for obtaining a technical result, may not be registered as trademarks.

In order to be registered, the sign must have a sufficient “distinctive character.” Such distinctive quality is not a constant but a variable. This means that a rather weak trademark at the time of registration may become a strong trademark through intensive advertising and surveillance, or, conversely and failing sufficient advertising and surveillance, that a strong trademark may become a weak trademark with a smaller scope of protection or even become the normal commercial description of a product or service for which it is registered as a result of the activity or inactivity of its owner, in which case the trademark shall be declared as lapsed.

LEGAL FRAMEWORK

DURATION OF RIGHT
The duration of trademark protection is ten years starting from the date of filing of the application and renewable for an unlimited number of consecutive ten-year periods.

OWNERSHIP/LICENSES
The exclusive rights conferred by a trademark are acquired by virtue of registration to the registration holder. Thus, no protection to trademark owners is guaranteed without registration, unless such unregistered trademarks are well-known. There are no specific provisions in Belgian law with respect to co-ownership of trademarks.

Independent of the transfer or all or part of a business, a trademark may be transferred with respect to all or some of the goods or services for which the trademark was filed or registered. A trademark may also be the subject of a license for all or some of the goods or services in respect of which the trademark was filed or registered.
REMEDIES FOR INFRINGEMENT
The remedies for trademark infringement are similar to those available for copyright infringement. See above remedies for Infringement section under Copyright.

TRADE SECRETS

NATURE OF RIGHT
Trade secrets are not expressly mentioned as a property right under Belgian law. Once a trade secret is known publicly, it can be freely commercially exploited.

Belgian law does not provide a uniform definition of a trade secret. For a definition, reference should be made to Section 39(2) of the TRIPS Agreement, Section 1 (i) of the Commission Regulation (EC) 772/2004 of April 27, 2004 on the application of Article 81(3) of the Treaty to categories of technology transfer agreements, Section 3.2 of the Commission notice 2005/C 325/07 and national case law.

A distinction must be made between so-called “manufacturing secrets” (or “secrets de fabrique”), of which the illegitimate disclosure by employees and former employees is sanctioned by criminal law (under Section 309 of the Criminal Code), and confidential information in general.

In order to assess whether a third party acts unlawfully, another distinction should be made between disclosure and use of the information, as well as between acts committed in good faith and acts conducted in bad faith.

LEGAL FRAMEWORK
The following statutes govern actions by an employer against (former) employees:

(i) Section 309 of the Criminal Code, which prohibits the disclosure of manufacturing secrets of the employer. Please note that this requires proving a malicious or fraudulent intent, which, as an evidentiary burden of proof, may be high bar to clear.

(ii) Section 17 of the Act of July 3, 1978 on Employment Agreements, which prohibits disclosure of trade secrets, as well as private or confidential matters, which were learned during the course of the employment.

The following legislation governs actions against other third parties:

(i) Civil liability law, namely Sections 1382 – 1383 of the Civil Code or (in case two undertakings are involved) Section VI.104 of Book VI “Market Practices and Consumer Protection” of the Code of Economic Law, in conjunction with Section 39(2) of the TRIPS Agreement and with Section 8 of the European Convention on Human Rights, if the third party illicitly obtains, misappropriates, discloses and uses a trade secret and thus causes or threatens to cause prejudice to a third party.

(ii) Contract law, if an agreement (such as a non-disclosure agreement) was concluded with the third party.

OWNERHIPS/LICENCES
As for most European jurisdictions, competition rules prevail over contractual arrangements. Licenses in respect of trade secrets are subject to Commission Regulation (EC) 772/2004 of April 27, 2004 on the application of Article 101(3) of the Treaty to categories of technology transfer agreements.
REMEDIES FOR INFRINGEMENT
Actions for misappropriation can be brought in criminal and civil proceedings, on the one hand, and in contractual liability and liability *ex delicto* on the other hand. In principle, both (interim and final) injunctive and monetary relief can be obtained.

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

EMPLOYEES
Generally, subject to some exceptions (such as software and topography protection) and in the absence of contrary, contractual or statutory, provisions, employees will retain ownership of the intellectual property developed by them.

In particular, reference can be made to the following rights:

**Copyright:** Where works are created by an author under an employment or a public servant’s contract, the economic rights may be assigned to the employer on the condition that such assignment is expressly agreed in writing and that the creation of the work falls within the scope of the contract.

The original author retains the moral rights on the work, since such rights are, in principle, non-transferable and inalienable.

**Patent:** Title 1 (Patents) provides that the right to a patent shall belong to the inventor or his successor in title. Title 1 (Patents) has not set out special rules regarding patent rights of employees, so that the status of such inventions is governed by the employment contract. Belgian case law, however, generally make a distinction between inventions performed during professional duties (pro employer), personal inventions (pro employee) and mixed inventions (depending on the circumstances of the case and the judge’s discretionary power). It is therefore accepted that the employer is entitled to the invention that is made in the framework of an employment contract, i.e. the invention that is made during an agreement and by an employee that is hired or instructed by his employer to make inventions or to carry out research in a given domain.

**Design:** If a design has been created by an employee in the course of his employment, the employer shall, unless specified otherwise, be regarded as the creator.

CONSULTANTS/CONTRACTORS
In principle, subject to some exceptions (such as topography protection) and in the absence of contrary (contractual or statutory) provisions, consultants and contractors will retain ownership of the intellectual property developed by them, even if it is commissioned and paid for by another party.
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In particular, reference can be made to the following rights:

**Copyright**: Where works are created by an author on commission, the economic rights may be assigned to the commissioning party on the condition that such assignment is expressly agreed between the parties and that the latter’s activities are in a non-cultural field or in advertising and that the work is intended for such activity.

**Patent**: The patent applicant shall generally be deemed to be entitled to exercise the rights to the patent. Where an application for the granting of a patent has been made either for an invention unlawfully taken from an inventor or his successors in title or in violation of a legal or contractual obligation, the injured party may, in his capacity as owner, claim the transfer of the application or of the granted patent, notwithstanding all other rights or proceedings.

**Design**: If a design has been created on commission, the commissioning party shall, unless specified otherwise, be regarded as the creator, provided that the commission was given with a view to commercial or industrial use of the product in which the design is incorporated.

**KEY COMMERCIAL CONTRACT CONSIDERATIONS**

**REGISTRATION OF COMMERCIAL AGREEMENTS**

There are no general registration requirements for commercial contracts. Registration of licenses for patents, designs and trademarks is possible and necessary for the license to have *erga omnes* (absolute) opposability, but is not required for the validity of the transfer itself.

**RECOGNIZED LANGUAGE OF COMMERCIAL AGREEMENTS**

Commercial contracts may be concluded in any language. From an enforceability perspective, the claimant has to prove that the counterparty consented to the terms, which includes understanding the language. For consumers, this evidentiary burden of proof will be a high bar to clear if the contract language is not the official language of the region of residence of the consumer.

**COUNTRY-SPECIFIC ISSUES FOR ONLINE CONTENT**

Book XII “Law of the Electronic Economy” of the Code of Economic Law provides several additional requirements regarding the information to be provided to conclude online agreements, including information about the service provider and the languages in which the agreement can be concluded.

**ENFORCEABILITY OF ONLINE/CLICKWRAP/SHRINKWRAP TERMS**

According to Belgian case law, two main conditions must be met to enforce general terms and conditions (including online or clickwrap terms). The party accepting the terms must have been aware and have consented to the content of the terms. In accordance with Book XII “Law of the Electronic Economy” of the Code of Economic Law for electronically concluded agreements, a written mention of the party accepting the terms can be given by any means which guarantees that the mention came from the party accepting the terms.

**GOVERNING LAW**

Subject to the case law of the European Union on the conclusion of cross border of online agreements, the Rome I and Brussels I regulations, and the limitations they impose on consumer contracts and employment contracts, the governing law and venue for resolution of disputes (including arbitration) specified in a commercial contract will generally be accepted and recognized.
KEY COMMERCIAL CONTRACT TERMS

ENFORCEABILITY OF WARRANTY DISCLAIMERS
Limitations and exclusions of warranty claims are generally permissible, including in business-to-consumer contracts, but are subject to the Act of September 1, 2004 on the protection of consumers in respect of the sale of consumer goods, which provides a two-year warranty period.

ENFORCEABILITY OF EXCLUSIONS/LIMITATIONS OF LIABILITY
Limitations of product liability for defects are severely restricted under Belgian law. Aside from product liability, liability in general may be excluded in principle, subject to certain conditions. For instance, liability may not be excluded if such would lead to a complete elimination of the main obligations of the agreement, or would lead to limiting one’s liability for fraud or willful misconduct.

INDEMNIFICATION
The concept of indemnification will, in general, be interpreted in accordance with Belgian law principles (which do not define indemnification) to provide a similar effect (such as a guarantee provided to the indemnitee).
Intellectual property rights are governed by the Federal Constitution and Federal laws.

Commercial and civil contracts are governed by general principles and provisions established in Federal Law 10,406/2002 (Brazilian Civil Code).

The Brazilian Civil Code also establishes specific provisions for certain types of contracts (e.g., purchase and sale, donation, services agreement). Some particular contracts are also governed by special laws and regulations (e.g., franchising, leasing, sales representatives, regulated contracts).

Contracts with consumers are subject to special provisions set forth in Federal Law 8,078/1990 (Consumer Defense Code).

The contracts with the Public Administration are mainly governed by Federal Law 8,666/1993 (Public Procurement Law). Certain contracts with the Public Administration are subject to specific laws and regulations (e.g., contracts in Energy and Oil and Gas areas, contracts that involve concessions, public-private partnerships, electronic options and Special System for Public Purchases – RDC).

Copyright protection is available for “creations of the spirit,” expressed by any means or fixed in any medium, tangible or intangible, now known or invented in the future. Protection by copyright does not depend on registration and the rights arise upon creation of the work.

Authors hold, over the works they create, moral rights (which include the right of having their name associated with the work and the right to modify or prevent modifications of the work) and economic rights (which include the right to use (and authorize others to use) the work by any means, enjoy any results arising from the work and make the work available (including the right to reproduce, publish, distribute, edit, adapt, translate and others)). Moral rights cannot be waived or assigned.

In Brazil, copyright protection also applies to software, defined as the “expression or an organized group of instructions in natural or encoded language, contained in a physical medium of any nature, the use of which is necessary in automated information treatment machines, devices, instruments or peripheral equipment based on digital or analogical technique for them to work in a certain way and for a certain purpose.” In case of software, moral rights are not applicable.
LEGAL FRAMEWORK

Copyrights are governed by the Federal Constitution (Article 5, XXVII), Federal Law 9,609/98 (Software Law) and Federal Law 9,610/98 (Rights of Authorship Law).

Moral rights are recognized under the Brazilian Rights of Authorship Law.

Brazil became signatory to Berne Convention in 1922.

DURATION OF RIGHT

In general, economic rights in copyrighted works remain valid for 70 years counted as from January 1 of the year following the year of the author’s death.

For software, protection of the copyrights remains valid for 50 years counted as from January 1 of the year following the year of the software’s publication or, if unpublished, of its creation.

OWNERSHIP/LICENSES

An author is, as a rule, the individual who created the work. Corporate entities may be considered authors in case of collective works and if they are editors or producers of audiovisual works. Joint authorship of works is recognized.

Assignment and licenses of rights should always be made in writing. Definitive assignments must be in writing. If not made in writing, the term of assignment/license will be reduced to five years. The assignment is valid only for the specified country; assignment and license agreements will always be interpreted restrictively and may be granted only for existing media.

Assignment of rights of authorship in and to works created in the future may be granted for a maximum of five years.

REMEDIES FOR INFRINGEMENT

Criminal remedies for copyright infringement include: imprisonment and monetary fine.

Civil remedies for copyright infringement include: seizure of infringing goods, suspension of their promotion and sale, daily penalty for continuing infringements, destruction of infringing goods and damages (including moral damages).

MASK WORKS

NATURE OF RIGHT

Brazil provides protection for original mask works (topografia de circuitos integrados), in the sense that they result from intellectual effort of their author and are not common or vulgar for technicians, specialists or manufacturers of chip products.

Mask works are defined as “a series of related images, however constructed or encoded, which represent the three-dimensional pattern of the layers that form a chip, and in which each image represents, in whole or in part, the geometrical disposition or arrangement of the surface of the chip in any stage of its conception or manufacture.”

“Chip” (circuito integrado) is defined as a product, in final or intermediate form, with elements of which at least one is active and with some or all the interconnections completely formed over one piece of material or in its interior, and which purpose is to perform an electronic function.
Mask work registration owners have the exclusive right to exploit the mask work, and any third party depends on the owners’ authorization to:

(i) Reproduce the mask work in whole or in part, by any means, including incorporating it into another chip;

(ii) Import, sell or otherwise distribute for commercial purposes a protected mask work or a chip in which a protected mask work is incorporated; or

(iii) Import, sell or otherwise distribute for commercial purposes a product that incorporates a chip in which a protected mask work is incorporated, only to the extent that such chip continues to include an illegal reproduction of a mask work.

LEGAL FRAMEWORK
Mask works are governed by Federal Law no. 11,484/07.

DURATION OF RIGHT
Mask works are protectable for ten years counted as from the date of application for registration or the date of the first exploitation, whichever occurs first.

OWNERSHIP/LICENSES
The party that applies for registration of a mask work is presumed to be its creator. Joint ownership is recognized.

Rights to mask works may be assigned, in whole or in part. In the latter case, the percentage of rights assigned must be specified. Assignment documents must be signed by both parties and two witnesses.

The owner of the mask work registration may license its exploitation. Mandatory licenses may be granted to ensure free competition or prevent abuses of right or of economic power by the owner of the right.

REMEDIES FOR INFRINGEMENT
Criminal remedies for infringement of mask works include: imprisonment and monetary fine.

Civil remedies for infringement of mask works include: prohibition of the infringing act, fine and damages.

PATENTS

NATURE OF RIGHT
Patent protection may be granted to:

(i) Inventions that present novelty, inventive activity and industrial use; and

(ii) Utility models if the objects (in whole or in part) are for practical use, have industrial use, present a new format or pattern that involves an inventive act and results in a functional upgrade in its use of manufacture.

Patents grant the right to prevent third parties to produce, use, offer for sale, sell or import with such purposes the claimed invention.
LEGISLATIVE FRAMEWORK
Patents are governed by the Federal Constitution (Article 5, XXIX) and Federal Law no. 9,279/96 (the Industrial Property Law). Brazil became party to Patent Cooperation Treaty in 1978 and Paris Convention in 1884.

DURATION OF RIGHT
For patents for inventions, the duration of protection is 20 years from the date of application, provided the term from grant is of no less than ten years.

For utility model patents, the duration of protection is 15 years from the date of application, provided the term from grant is of no less than seven years.

OWNERSHIP/LICENSES
The party that applies for registration of the patent is presumed to be its creator. Joint ownership is recognized.

Rights to patents may be assigned in whole or in part.

The owner of the patent registration or application may license its exploitation. Mandatory licenses may be granted to ensure free competition or prevent abuses of right or of economic power by the owner of the right; if the object of the patent is not being exploited; or if market needs are not being met.

REMEDIES FOR INFRINGEMENT
Criminal remedies for patent infringement include: imprisonment, monetary fine and seizure of infringing products.

Civil remedies for patent infringement include: injunction to prevent the continuation of infringements and damages.

TRADEMARKS

NATURE OF RIGHT
Distinctive signals visually perceptible, not otherwise included within the legal prohibitions, are registrable as trademarks.

LEGAL FRAMEWORK
Trademarks are governed by the Federal Constitution (Article 5, XXIX) and Federal Law no. 9,279/96 (the Industrial Property Law).

Brazil is not a signatory to the Madrid Protocol.

Brazil is not a party to the Trademark Law Treaty of 1994.

DURATION OF RIGHT
The duration of trademark protection is ten years from the date the registration is granted and renewable for successive ten-year periods.
Ownership/Licenses
Ownership of a trademark is obtained when its registration is validly granted. The owner has the exclusive right to use the trademark in Brazil, to assign the rights to the trademark or license its use.

Trademark registrations or applications may be assigned or licensed provided the assignee fulfills the legal requirements to be the owner of the registration or application.

Remedies for Infringement
Criminal remedies for trademark infringement can include: imprisonment, monetary fine, seizure of infringing products and destruction of infringing trademarks.

Civil remedies for trademark infringement can include: injunction to prevent the continuation of infringements, damages.

Trade Secrets
Nature of Right
Trade secrets are not protected as property in Brazil. However, the Brazilian Industrial Property Law, in the chapter related to Crimes of Unfair Competition, characterizes as crimes certain conduct involving the unauthorized use of trade secrets. As a result, there is legal protection against the violation of trade secrets.

Legal Framework
Trade secrets are addressed for Brazil under Federal Law no. 9,279/96 (the Industrial Property Law).

Remedies for Infringement
Remedies available for infringement of trade secrets can include criminal remedies (imprisonment and monetary fine) and civil remedies (injunction to prevent the continuation of infringements and damages).

Intellectual Property in Employment Context
Employees
Copyrights: Employees own the copyrights to works they create (except for software as mentioned below). The concept of “work for hire” is not recognized by the Brazilian Rights of Authorship Law; an assignment is required for an employer to own the economic rights to a copyrightable work.

Software: Unless otherwise agreed, the employer owns the rights to software developed during the employment agreement whose purpose is research and development or which result from the nature of the job description. Unless otherwise agreed, compensation for the employee’s work shall be limited to his salary.

Mask Works: Unless otherwise agreed, the employer owns the rights to mask works developed during the employment agreement in which the creative activity results from the nature of the job description or in which the employee uses resources, technological information, industrial or commercial secrets, materials, facilities or equipment of the employer. Unless otherwise agreed, compensation for the employee’s work shall be limited to his salary.
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**Patents:** Inventions and utility models belong to the employer when they result from an employment agreement performed in Brazil whose purpose is research or inventive activity or if the inventive activity results from the nature of the employee’s services. Unless otherwise agreed, compensation for the employee’s work shall be limited to his salary.

**Trademarks:** There is no legal provision concerning the ownership of trademarks in employment context. In the absence of such provisions, a restrictive interpretation of the law should be applied and therefore, the rule applicable to copyrights would also be applicable to trademarks.

**Consultants/Contractors**

**Copyrights:** Consultants/contractors own the copyrights to works they create (except for software as mentioned below). The concept of “work for hire” is not recognized by the Brazilian Rights of Authorship Law and a written assignment is required for an engaging party to own the economic rights to a copyrightable work.

**Software:** Unless otherwise agreed, the engaging party owns the rights to software developed during the services agreement whose purpose is research and development or which result from the nature of the service description. Unless otherwise agreed, compensation for the service shall be limited to the agreed remuneration.

**Mask Works:** Unless otherwise agreed, the engaging party owns the rights to mask works developed during the services agreement in which the creative activity results from the nature of the service description or in which the service provider uses resources, technological information, industrial or commercial secrets, materials, facilities or equipment of the engaging party. Unless otherwise agreed, compensation for the service shall be limited to the agreed remuneration.

**Patents:** Inventions and utility models belong to the engaging party when they result from a services agreement performed in Brazil whose purpose is research or inventive activity or if the inventive activity results from the nature of the services. Unless otherwise agreed, compensation for the service shall be limited to the agreed remuneration.

**Trademarks:** There is no legal provision concerning the ownership of trademarks in a service agreement context. In the absence of such provisions, a restrictive interpretation of the law should be applied and therefore, the rule applicable to copyrights would also be applicable to trademarks.

**Trade Secrets:** N/A.

**Key Commercial Contract Considerations**

**Registration of Commercial Agreements**

Generally speaking, contracts are valid and effective between the contracting parties regardless of registration.

Contracts need to be registered with the Registry of Deeds or other specific Registries in order to be effective and enforceable against third parties.
RECOGNIZED LANGUAGE OF COMMERCIAL AGREEMENTS

In general, there is no issue in having contracts executed in another language (e.g., English); however, if the contract has to be taken to any Brazilian authority, including courts, only Portuguese versions or sworn translations will be accepted.

The Consumer Defense Code requires the presentation of products and services to consumers in Brazil to be in Portuguese, including precise, clear and ostensive information related to their characteristics, qualities, composition, price and warranty, among others. The contract will not be binding on consumers if it is written in a way that may be difficult for the consumer to understand, and the fact that the contract is written in another language might suffice for it to be deemed difficult to understand by a consumer.

COUNTRY-SPECIFIC ISSUES FOR ONLINE CONTENT

Federal Decree No. 7,962/2013 establishes several rules for e-Commerce. There is certain information that must be included in the website (e.g., supplier’s name, address for contact, information on additional and ancillary costs included in the price) and the supplier shall comply with certain obligations in order to make the purchase process easier to the customer (e.g., to include a summary of the contract highlighting the clauses that may limit any right and to maintain an electronic consumer attendance service).

The discussion in Brazil on Internet issues, privacy and data protection has increased recently. There are currently proposals for new regulations relating to Internet issues, data protection and privacy being discussed in the Congress, including the Bill of Law on a Civil Rights Framework for the Internet (Marco Civil da Internet).

ENFORCEABILITY OF ONLINE/CLICKWRAP/SHRINKWRAP TERMS

Online agreements are generally considered enforceable if they are clearly available for the user’s review. There is no specific law requiring that the user needs to indicate affirmative assent (e.g., “check a box” separately) to confirm his acceptance. Considering the current lack of specific legislation, the general rules of contracts apply. For instance, if the law does not require express acceptance, such acceptance may be tacit. Therefore, the act of using the services or purchasing the goods may be deemed a tacit acceptance.

It is important to stress that the use of “adhesion contracts” (i.e., a written agreement drafted by one of the parties and which, in principle, cannot be amended by the other party) is allowed under Brazilian law. However, owing to their nature, the law and the courts tend to protect the party in the weaker position (i.e., adhering party). Brazilian Courts may disregard a contractual provision if such provision is deemed abusive (e.g., if it contains a waiver of a right by the adhering party).

GOVERNING LAW

According to the conflict of laws principles set forth in Federal Decree-Law No. 4,657/1942 (the Introductory Law to the Brazilian Law Provisions), the obligations shall be governed by the law of the place where they are created and when the parties are not at the same place when they sign a contract, the law of the place of the proposing party shall govern such contract. Most authors understand that, considering such provisions, Brazilian law implicitly rejects choice-of-law clauses that would lead to the application of a different law.

An exception to these principles is the agreements with an arbitration clause. Federal Law 9,307/1996 (Arbitration Law) expressly allows the parties to choose the laws or institutional rules governing the contract and the arbitration. The parties may also agree that the decision shall be based on equity.
Disclaimers and contractual provisions on warranty are usually enforceable, provided that they do not conflict with mandatory rules. For instance, disclaimers against consumers are likely to be deemed null.

The validity of the limitation/exclusion of liability clauses, as well as the establishing of a cap, are controversial in Brazil. The prevailing view is that such clauses are valid and enforceable, provided that they do not involve matters of public order or consumers’ rights (especially in adhesion agreements), but that they would not apply in cases where the party has acted with willful misconduct or gross fault. The clauses may also be challenged in court, for instance, when the value of the indemnification agreed is not commensurate with the actual damage suffered or when the liability was an important element arising out of the nature of the transaction.

Nevertheless, even with the risk of being challenged, it is normal (and many times recommendable) to include limitations (e.g., caps) and exclude certain liabilities, especially indirect damages (including loss of profit).

Indemnification provisions are generally recognized and enforceable. Normally they include the obligation to defend, indemnify (pay damages) and hold harmless. Indemnification is not limited to third-party claims.

Even if the parties do not establish a contractual obligation to indemnify, there may be indemnification obligations provided by law.

As a general rule, indemnification is measured by the extent of the damage (which normally includes actual losses and lost profits).
Canada

Intellectual Property Framework
As a general matter intellectual property rights are governed by Federal statutes.

Commercial Contract Framework
Contracts are a matter of provincial, not Federal, law. In the common law provinces, contracts are governed by common law contract principles, as modified by a number of statutes such as the Statute of Frauds, Sale of Goods Act and consumer protection legislation. In Québec, contracts are governed principally by the Civil Code. However, other laws such as the Charter of the French Language impose special requirements on the formalities of contracts in Québec. It is worth noting as well that Québec has a civil law system, while the balance of the Canadian provinces have a common law system.

Bankruptcy is a matter of Federal law, and under Federal bankruptcy legislation, special rules may limit the ability to effect termination of rights upon an act of insolvency or bankruptcy.

There are special rules that govern contracts with the Federal and provincial governments.

Recognized Intellectual Property Rights

Copyrights

Nature of Right
Copyright protection is granted to every original literary, dramatic, musical and artistic work in a fixed mode of expression, and to sound recordings, performer’s performances and communication signals.

Copyright arises automatically upon creation of the work, sound recording, performer’s performance or communication signal. Moral rights of attribution and integrity also arise automatically upon creation of a copyrighted work or performer’s performance and belong exclusively to the author. Moral rights may be waived by the author but cannot be assigned.

Registration is not necessary to enforce rights, but registration provides certain legal advantages.

The owner of a copyrighted work has the sole right to produce, reproduce, distribute, prepare derivative works, perform or publish a work of authorship in any material form. The owner of a sound recording, performer’s performance or communication signal has the sole right to fix it in any material form, reproduce any fixation, communicate it to the public or perform it in public.

Legal Framework
The Canadian Copyright Act protects both copyright and moral rights.

Canada became a signatory to the Berne Convention in 1928.
DURATION OF RIGHT
Copyright in works of authorship lasts for the life of the author, the remainder of the calendar year in which the author dies and a period of 50 years from that year end.

Where the author of the work is unknown, copyright extends for the shorter of (i) the remainder of the calendar year of first publication, and an additional 50 years from that year end; or (ii) the remainder of the calendar year in which the work was made plus an additional 75 years from that year end.

Where there are two or more authors, copyright protection extends until the death of the last known author, the remainder of the calendar year of the author’s death plus an additional 50-year period.

For works that are not published until after the death of the author, copyright extends until the date of publication, performance in public or communication to the public, whichever happens first, the remainder of that calendar year plus an additional 50-year period.

For photographs, amendments to the Copyright Act came into force on November 6, 2012, which amended the duration of rights. Prior to the amendments, the term of rights for photographs varied based on assessments of ownership and authorship. Before November 6, 2012, if a photograph was owned by a corporation, copyright protection extended from the year end of the making of the photograph plus an additional 50 years. Duration was treated differently where the majority of the voting shares of the corporation were owned by a natural person. In such a case, and in all cases involving ownership by a natural person, the copyright term was the remainder of the year of author’s death plus an additional 50 years. Photographs created after November 6, 2012 are treated the same as other works of authorship.

OWNERSHIP/LICENSES
Ownership of copyright can be assigned or licensed. A valid assignment of rights must be in writing and signed by the owner. Licenses may be implied.

Subject to certain exceptions, the author of a work, maker of a sound recording, performer of a performer’s performance, or broadcaster of a communication signal is the first owner of copyright. Exceptions include where the work is made in the course of employment, in which case the first owner of copyright is the person by whom the author was employed, or where the work was prepared by or under the direction of the Crown, in which case copyright belongs to the Crown.

Joint ownership is recognized where the work is jointly authored.

REMEDIES FOR INFRINGEMENT
Registration is not required to seek and enforce remedies.

An owner may seek civil remedies, including injunction, seizure of goods, delivery up, an accounting of profits or general damages.

General damages may be awarded for lost sales, reasonable royalties or intangible losses. Punitive damages may be available where the infringement is particularly egregious or appalling.

Statutory damages can also be sought, ranging from $500.00/work to $20,000/work for infringement for commercial gain, and $100.00/work to $5,000.00/work for infringement for non-commercial purposes.

It is possible to seek preventing importation of goods that are infringing.

Criminal penalties are also available.
INTEGRATED CIRCUIT TOPOGRAPHIES

NATURE OF RIGHT
Protection for integrated circuit topographies used in integrated circuit products gives exclusive right to reproduce, manufacture, import or commercially exploit the topography or any substantial part. Commercially exploit means to sell, lease, offer or exhibit for sale or lease, or otherwise distribute for a commercial purpose.

A topography means the design, however expressed, of the disposition of (i) the interconnections, if any, and the elements for the making of an integrated circuit product, or (ii) the elements, if any, and the interconnections for the making of a customization layer or layers to be added to an integrated circuit product in an intermediate form.

LEGAL FRAMEWORK
Integrated Circuit Topography Act governs the protection of integrated circuit topographies.

DURATION OF RIGHT
The duration of protection for integrated circuit topographies is ten years, commencing on the filing date of the application for registration and terminating at the end of the tenth calendar year after the earlier of the year in which the topography is first commercially exploited and the calendar year of the filing date of the application. A registration must be filed within two years of first commercial exploitation.

OWNERSHIP/LICENSES
A topography, whether registered or unregistered, is transferable or may constitute the subject-matter of a license, either as to the whole interest therein or as to any undivided portion.

REMEDIES FOR INFRINGEMENT
Remedies can include an injunction, the payment of royalties and the recovery of damages or profits, for punitive damages, and for the disposal of any infringing integrated circuit product or any article of which an infringing integrated circuit product forms a part.

A defendant is not liable for royalties, damages, profits or punitive damages in respect of any dealings with the integrated circuit product prior to the time when the defendant had actual knowledge that the product was manufactured and sold for the first time without the consent of the owner.

A defendant has the right to dispose of any inventory of the integrated circuit product or of the article that was acquired before the defendant had that knowledge, subject to the condition that the defendant pay a reasonable royalty in respect of that inventory in such amount and at such time as the court may determine.

PATENTS

NATURE OF RIGHT
Patents grant the right to exclude others from making, constructing, using and selling to others to use the claimed invention.
LEGAL FRAMEWORK
The Patent Act governs the protection of patents.

Canada became a party to the Patent Cooperation Treaty in 1990 and to the Paris Convention in 1923.

DURATION OF RIGHT
The duration of patent protection is 20 years from the filing date of the application.

OWNERSHIP/LICENSES
Joint ownership is permissible, but one party cannot dilute the rights of another party without permission. A joint owner may assign its entire interest without consent of the other joint owner. Consent of all joint owners is required to grant a license.

REMEDIES FOR INFRINGEMENT
The Patent Act permits awards for damages following the grant of a patent and reasonable compensation for infringing acts before grant, together with interest.

Equitable remedies include an accounting of profits, reasonable royalty, and interlocutory or permanent injunctions. Punitive damages awards are rare and require high-handed, egregious and oppressive conduct in carrying out the infringing acts.

INDUSTRIAL DESIGNS

NATURE OF RIGHT
Industrial designs grant the right to exclude others from making, importing for the purpose of trade or business, or selling, renting, or offering or exposing for sale or rent, any article in respect of which the design is registered or if done in relation to an article assembled from a kit.

Industrial design rights protect the features of shape, configuration, pattern or ornament and any combination of those features that, in a finished article, appeal to and are judged solely by the eye where the articles are made by hand, tool or machine.

LEGAL FRAMEWORK
The Industrial Design Act governs the protection of industrial designs.


DURATION OF RIGHT
Industrial designs have a duration of ten years from registration. Foreign priority right must be filed within six months from the earliest date on which the foreign application was filed.

OWNERSHIP/LICENSES
Designs, whether registered or unregistered, are assignable in law, either as to the whole interest or any undivided part.

Every proprietor of a design may grant and convey (i.e., license) an exclusive right to make, use and sell, and to grant to others the right to make, use and sell the design, within and throughout Canada or any part, for the unexpired term of its duration or any part.
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REMEDIES FOR INFRINGEMENT
Relief for infringement may include injunction and the recovery of damages or an accounting of profits, for punitive damages, and for the disposal of any infringing article or kit limited to a period of no more than three years before the commencement of the action for infringement.

TRADEMARKS

NATURE OF RIGHT
A trademark is any word, phrase, symbol, design or sound used to distinguish the goods or services manufactured or performed by a trader from the goods or services manufactured or performed by others. Protection is also afforded to the shape, container, wrapping or mode of packaging of goods in the form of a distinguishing guise.

Bill C-8 Combating Counterfeit Products Act is expected to do away with distinguishing guises and provide for a unified definition of a trademark as “a sign or combination of signs that is used by a person for the purpose of distinguishing their goods or services from those of others.”

LEGAL FRAMEWORK
The Canadian Trademarks Act codifies the common law tort of passing off and accords further rights to registered trademark owners. Owners of registered trademarks receive additional protection against use of their mark in a manner that is likely to depreciate the value of the goodwill attaching to the mark and against use by others of a confusing trademark or trade name.

All trademarks, whether registered or not, are protected under the common law tort of passing off. Protection under common law arises when the mark has acquired a reputation or goodwill in the marketplace.

Registration of a trademark is available at the Federal level and grants the owner of the registered mark the exclusive right to use the mark throughout Canada in association with the goods and services in the registration.

Canadian law does not explicitly require the use of symbols to denote trademark usage. However, conventionally™ is used to signify that a mark, whether registered or unregistered, is a trademark, and ® symbolizes a registered trademark.

Canada is not a signatory to the Madrid Protocol or the Trademark Law Treaty. Canada does not currently use the International Schedule of Classes of Goods and Services.

DURATION OF RIGHT
Trademark registration is valid for a 15-year period and is renewable indefinitely provided the mark remains in use.

A trademark, whether registered or unregistered, must distinguish a trader’s goods or services, failing which trademark protection may be lost.

OWNERSHIP/LICENSES
Trademarks, whether registered or unregistered, can be assigned or licensed. There is no requirement for licenses to be registered.
Owners granting licenses to trademarks must include appropriate quality control language in order to preserve the distinctiveness of the mark and avoid possible loss of the mark. If trademark use is licensed, and public notice is given of the license and of the identity of the trademark owner, the Trademarks Act provides a rebuttable presumption that the trademark owner has control over the character and quality of the goods or services to which the trademark attaches.

**REMEDIES FOR INFRINGEMENT**

The owner may seek civil remedies, including injunction, an accounting of profits, delivery up (a remedy that requires that the infringing articles must be handed over to the trademark owner), destruction, exportation or other disposition of the infringing wares or general damages.

Registered trademark owners may seek an action for trademark infringement and depreciation of goodwill under the Trademarks Act.

Owners of registered trademarks may apply to the court for an order prohibiting the importation or distribution of infringing goods.

Punitive damages may be available where the infringement is particularly egregious or appalling.

Criminal penalties are also available.

**TRADE SECRETS**

**NATURE OF RIGHT**

A trade secret, or confidential information, is any information that is not publicly available and gives the holder an advantage over others. A trade secret (or know-how) can be any type of information, whether commercial, technical or financial.

**LEGAL FRAMEWORK**

Trade secrets are protected under the common law cause of action for breach of confidence, or otherwise by contract. In Quebec, trade secrets are protected by statute by virtue of the Civil Code of Quebec.

Enforcement of rights and protection stems from the obligation of confidentiality or a fiduciary duty rather than treatment of trade secrets as property. The general rule is that a recipient of confidential information may only use it for the purpose for which it was given.

**DURATION OF RIGHT**

Courts will grant protection against unauthorized use or disclosure of trade secrets so long as the information is communicated in confidence and has the quality of confidence.

Confidential information generally remains exclusive only so long as secrecy is preserved.

**OWNERSHIP/LICENSES**

Trade secret licenses are enforceable. It is advisable to institute an agreement with parties to protect trade secrets from misuse or unauthorized disclosure.

Even in the absence of such an agreement, a person can be obligated to maintain confidentiality. If a person receives information and knows, or reasonably ought to know, that it is confidential, they are obligated to protect its confidentiality and they are disentitled from misusing or disclosing that information to third parties.

Joint ownership of trade secrets is recognized.
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REMEDIES FOR INFRINGEMENT
A party can seek breach of contract, or breach of confidence at common law. The tort of intentional interference with economic relations may also be available.

Remedies can include an injunction for actual or threatened misappropriation, delivery up or destruction of materials made as a result of using confidential information, imposition of a constructive trust over property acquired through misuse of confidential information, damages (including actual loss and unjust enrichment caused by the misappropriation) or an accounting of profits. Imposition of reasonable royalties instead of injunction is permitted under exceptional circumstances.

Punitive damages may be available where the infringement is particularly egregious or appalling.

In Canada, criminal penalties, such as theft or fraud, are not available. Trade secrets are not considered property for the purposes of criminal law.

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

EMPLOYEES
It is customary for employees to sign invention assignment and confidentiality agreements.

Regarding patents, in the absence of an agreement, an employer can show ownership by demonstrating that the work leading to the invention was part of the employee's duties and responsibilities in the employee's terms of employment.

With respect to copyright, ownership of a work created in the course of employment rests with the employee in the absence of an agreement to the contrary. However, moral rights in the work are granted exclusively to the author. Moral rights cannot be assigned, but can be waived by agreement.

CONSULTANTS/CONTRACTORS
It is customary for consultants and contractors to sign invention assignment and confidentiality agreements. In the absence of any written agreements to the contrary, the consultant or contractor retains ownership of any intellectual property rights.

KEY COMMERCIAL CONTRACT CONSIDERATIONS

REGISTRATION OF COMMERCIAL AGREEMENTS
There is no general requirement to register contracts. Transfers, and licenses for intellectual property such as patents, trademarks, registered copyright and industrial designs are generally registerable. The details of registration are set out in the applicable legislation. While registration is generally not a requirement to make the transfer or license valid, it is generally imprudent not to register because a subsequent purchaser for value without notice may acquire rights that limit or defeat the unregistered rights.

RECOGNIZED LANGUAGE OF COMMERCIAL AGREEMENTS
Contract law is a matter of provincial, not Federal, law. Generally speaking, a contract may be expressed in any language, although English and French are the only official languages in Canada. In some provinces, notably Québec, special steps are required to be taken if a contract is drafted in any language other than French.
COUNTRY-SPECIFIC ISSUES FOR ONLINE CONTENT
Generally speaking, the common law system has attempted to adapt contract principles to online transactions. However, different provinces have enacted a variety of consumer protection statutes that may modify or define the basis upon which an online transaction may be carried out. For instance, in Ontario it is necessary to consider the provisions of the Electronic Commerce Act 2000 and the Consumer Protection Act.

ENFORCEABILITY OF ONLINE/CLICKWRAP/SHRINKWRAP TERMS
Generally speaking, clickwrap/shrinkwrap terms have been enforced applying general contract principles. However, it is important to note that several provinces, including Ontario, Québec and Alberta have legislation that limit the effect of arbitration clauses in consumer contracts, and permit a consumer to bring an action, including a class action, notwithstanding an arbitration clause.

GOVERNING LAW
Choice of law and forum selection clauses are enforced based on contract principles applicable in the province in question. Courts as a rule will enforce such clauses in contracts that parties have negotiated. However, standard principles such as inequality of bargaining power (particularly in the case of consumer transactions), ambiguity, or manifest unfairness of the clause may make such a clause unenforceable in a particular case.

KEY COMMERCIAL CONTRACT TERMS

ENFORCEABILITY OF WARRANTY DISCLAIMERS
Great care must be taken in drafting warranty disclaimers. The Sale of Goods Acts in most of the common law provinces distinguish between conditions (the breach of which entitles the party to reject the goods) and warranties that only entitle the party to claim damages. Fitness for purpose and merchantability are implied conditions, and many cases can be found where clauses purporting to disclaim warranties of fitness for purpose and merchantability have been ignored because the provision is a condition not a warranty. In consumer transactions, some provinces have legislation that limits the ability to disclaim certain statutory or otherwise common implied terms.

ENFORCEABILITY OF EXCLUSIONS/LIMITATIONS OF LIABILITY
Exclusion or limitation of liability clauses are enforced based on contract principles applicable in the province in question. Courts as a rule will enforce such clauses in contracts that parties have negotiated, although they are frequently strictly construed. However, standard principles such as inequality of bargaining power (particularly in the case of consumer transactions), ambiguity or manifest unfairness of the clause may make such a clause unenforceable in a particular case. In some provinces consumer protection legislation limit the ability to effectively limit liability.

INDEMNIFICATION
Indemnity clauses, like other contractual clauses, will be enforced if negotiated between the parties. However, standard principles such as inequality of bargaining power (particularly in the case of consumer transactions), ambiguity, or manifest unfairness of the clause may make such a clause unenforceable in a particular case.
CHINA

INTELLECTUAL PROPERTY FRAMEWORK

In China, intellectual property rights are primarily protected under three major intellectual property laws, the Patent Law, the Trademark Law and the Copyright Law, and their Implementing Regulations. In addition, there are a large number of regulations, rules, measures, policies and opinions issued by the Standing Committee of National People’s Congress, the State Council and various administrative authorities which further address issues concerning application of the intellectual property laws. The judicial interpretations made by the Supreme People’s Court also form a part of the legal framework.

COMMERCIAL CONTRACT FRAMEWORK

The Contract Law of the People’s Republic of China (PRC) came into effect on October 1, 1999. The PRC Supreme People’s Court promulgated the judicial interpretations regarding the application of the Contract Law during the years. These interpretations are binding and shall be complied with as laws. The interpretations are about the application of the Contract Law, the application of the Contract Law in real estate deals, the application of the Contract Law with respect to construction contracts and the application of the Contract Law with respect to technology contracts.

With respect to technology import and export, the Regulations of the People’s Republic of China on Administration of Import and Export of Technologies shall be applicable (Regulations of Import and Export of Technologies). Pursuant to the Regulation of Import and Export of Technologies, technologies are divided into three categories: free import/export, restricted import/export and prohibited import/export.

RECOGNIZED INTELLECTUAL PROPERTY RIGHTS

COPYRIGHTS

NATURE OF RIGHT

Works of literature, art, natural science, social science and engineering technology that are created in the form of written works, oral works, musical works, dramatic works, works of fine arts and architectural works, photographic works, cinematographic works, graphic works such as drawings of engineering designs and computer software, can enjoy protection under the PRC copyright laws.

Registration of copyright is not required and the rights arise automatically at the time the creation of the work is completed.

Copyright owners have the exclusive right to reproduce, distribute, prepare derivative works, publicly perform, and broadcast their works or disseminate the works via an information network.
LEGAL FRAMEWORK
The PRC Copyright Law and its Implementing Regulations are primary legislations in China concerning copyright protection. In addition, there are Regulations on Protection of Computer Software, and judicial interpretations issued by the Supreme People’s Court also provide detailed rules in respect of application of the Copyright Law.

China became a signatory to the Berne Convention and Universal Copyright Convention in 1992.

DURATION OF RIGHT
The duration of copyright protection differs according to different types of rights.

For moral rights, such as the right of authorship, the right of revision and the right of integrity shall continue in perpetuity.

For other types of rights, such as the right of publication, right of reproduction and right of performance shall be protected for 50 years, expiring on December 31 of the 50th year after the death of the author; or, if the author is not a natural person, the right expires on December 31 of the 50th year after first publication of the work. However, the work will no longer be protected if it is not published within 50 years after its completion.

OWNERSHIP/LICENSES
As a general principle, the author who creates the work owns the copyright in the work. In the absence of evidence to the contrary, the citizen, legal person or other organization that put their name to a work is the author of the work.

Joint ownership of copyrights is recognized.

The copyright in a commissioned work shall be vested in the commissioned party unless it is agreed otherwise in writing.

REMEDIES FOR INFRINGEMENT
When a copyright or its related rights are infringed, the rights owner can either file a complaint with copyright administrative authorities or bring a lawsuit to the People’s Court.

The infringer shall, according to the circumstances of the case, undertake to cease the infringement, take remedial action, offer an apology or pay damages. Where the infringers’ conduct also prejudices the public interest, the infringer may be ordered by the copyright administrative authority to cease the infringement, and the authority may confiscate the illegal proceeds, confiscate and destroy the infringing reproductions and impose a fine on the infringer. Where the circumstances are serious, the copyright administrative authority may also confiscate the main materials, tools and equipment used in the manufacture of the infringing reproductions. Where the circumstances constitute a criminal offense, criminal liability shall be imposed in accordance with the law.

The infringer shall pay damages based on the actual loss of the right holder. Where the actual loss is difficult to calculate, the damages paid may be based on the amount of the illegal proceeds. The amount of damages shall also include the reasonable expenses incurred by the right holder in stopping the infringement. If neither the actual loss of the right holder nor the illegal proceeds earned by the infringer can be determined, a statutory damage up to ¥500,000 shall be awarded according to the circumstances of the case.
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Mask Works

Nature of Right
In China, mask works are called “layout-design of integrated circuits.”

Any layout-design of integrated circuits that is to be protected shall be original in the sense that the layout-design is the result of the creator’s own intellectual effort, and it is not commonplace among creators of layout-designs and manufacturers of integrated circuits at the time of its creation.

The right of layout-design should be registered with the State Intellectual Property Office. Any unregistered layout-design shall not be protected under relevant regulations.

The owner of the right of layout-design has the exclusive right to reproduce the whole or a part of a protected layout-design and commercially exploit a protected layout-design, an integrated circuit incorporating a protected layout-design or an article incorporating such an integrated circuit.

Legal Framework
Regulations on Protection of Layout-Designs of Integrated Circuits and its Implementing Rules and Enforcement Rules are the main domestic legislations.

A layout-design of integrated circuits can also be protected under the Patent Law and the Regulations on Protection of Computer Software, where applicable.


Duration of Right
The term of protection of the exclusive right of layout-design shall be ten years from the date of filing an application for registration or from the date on which it was first commercially exploited anywhere in the world, whichever expires earlier.

However, regardless of whether it has been registered or commercially exploited, a layout-design shall not be protected for more than 15 years after the date of the completion of its creation.

Ownership/Licenses
As a general principle, the exclusive right of layout-design shall belong to its creator unless provided otherwise in the Regulations on Protection of Layout-Designs of Integrated Circuits.

Joint ownership is recognized.

The exclusive right of layout-design in a commissioned work shall be vested in the commissioned party unless it is agreed otherwise in writing.

Remedies for Infringement
The holder of the right for a layout-design or any interested party (such as a licensee) may bring a law suit before the People’s Court, or request the intellectual property administration department of the State Council to handle the matter. When the Intellectual Property Administration Department of the State Council handling the matter considers that the infringement is established, it may order the infringer to stop the infringing act immediately and confiscate or destroy the infringing products or articles.
Injunctive relief is available. Where any holder of the right of layout-design or interested party has evidence to prove that another person is infringing or will soon infringe the owner’s exclusive right and if such infringing act is not stopped or prevented from occurring, it is likely to cause irreparable harm to the owner’s legitimate rights. The owner may, before any legal proceedings are instituted, request the People’s Court to adopt measures for ordering the suspension of relevant acts and the preservation of property.

The amount of compensation for the damage caused by an infringement of the exclusive right of layout-design shall be the profits that the infringer has earned through the infringement or the losses suffered by the person whose right was infringed, including the reasonable expenses paid by the infringed person for the purposes of stopping the infringement.

**PATENTS**

**NATURE OF RIGHT**

Patents are a statutory right granted for protection of invention-creations include three categories: inventions, utility models and designs.

Patents grant the rights to exclude others, for commercial purposes, from: (i) manufacturing, using, offering to sell, selling or importing the patented goods, (ii) using the patented method, or using, offering to sell, selling or importing products made directly through use of the patented method, or (iii) manufacturing, offering to sell, selling or importing the goods covered by a design patent.

**LEGAL FRAMEWORK**


**DURATION OF RIGHT**

Invention patents are protectable for 20 years from the filing date. Utility models and design patents are protectable for ten years from the filing date.

**OWNERSHIP/LICENSES**

Joint ownership is permissible. Unless otherwise agreed by contract, each party can use the patent on its own or grant a non-exclusive license to a third party on condition that the royalty is to be distributed among all the co-owners. However, mutual consent by all the co-owners shall be required for assignment, abandonment or enforcement of the patent.¹

**REMEDIES FOR INFRINGEMENT**

Damages can be calculated based on (i) lost profits; (ii) illegal gains by the infringer; or (iii) up to three times of reasonable royalty. Should it be difficult to determine the damages based on any of these mechanisms, the court has the discretion to grant statutory damages the maximum of which is ¥1 million under the current Patent Law.

Injunctive relief is also a possible remedy.

¹ Certain judges hold the view that mutual consent by all the co-owners may not be required for enforcement of a jointly owned patent in China, stating that each owner shall have the right to initiate an infringement lawsuit and that the court shall have the authority to add in the other co-owners as a “party of interest.”
TRADEMARKS

NATURE OF RIGHT
A trademark is defined as “any sign that distinguishes the goods of a natural person, legal person, or other organization from those of others, including any word, device, letter, number, three-dimensional sign, and color combination, sound, or the combination thereof.”

China uses the “first to file” system. In general, only a registered trademark enjoys protection under the Trademark Law. An unregistered trademark with prior use is protected in very limited situations.

LEGAL FRAMEWORK
China recently amended the Trademark Law, which became effective as of May 1, 2014.

The PRC Trademark Law and its Implementing Regulations are primary legislations. Judicial interpretations issued by the Supreme People’s Court also provide detailed rules in respect of application of the Trademark Law.


DURATION OF RIGHT
The term of validity of a trademark registration is ten years, which can be renewed for another ten years upon each expiration.

OWNERSHIP/LICENSES
A trademark license agreement should be recorded with the Chinese Trademark Office. There are some clauses that must be included in trademark licenses, such as those in respect of quality control and indication of licensee’s name and the place of origin.

REMEDIES FOR INFRINGEMENT
In case of trademark infringement, the trademark owner can either file a complaint with the local administrative authority or bring a lawsuit to the People’s Court.

The local administrative authority may order the infringer to cease the infringing activity immediately, confiscate and destroy the infringing goods and any instruments specifically used to manufacture the infringing goods and counterfeit the registered trademark, and may even impose a fine; where the circumstances constitute a criminal offense, criminal liability shall be imposed in accordance with the law.

The amount of damages for trademark infringement shall be the profit that the infringer has earned as a result of the infringement or the losses that the party infringed has suffered as a result of the infringement, including any reasonable expenses the infringed party has incurred for its efforts to stop the infringement. If neither the illegal profit nor the losses suffered can be determined, a statutory damage up to ¥3 million shall be awarded according to the circumstances of the case.

Injunctive relief is available.
TRADE SECRETS

NATURE OF RIGHT
The PRC Anti-Unfair Competition Law defines “trade secrets” as technical information and operational information that are not known to the public, are capable of bringing economic benefits to the right holders, and have practical applicability and for which the right holders have taken measures to ensure confidentiality.

It constitutes an infringement of trade secrets to obtain the trade secrets by illegal means and disclose them, use or permit others to use the trade secrets obtained by illegal means or in violation of confidentiality obligations.

LEGAL FRAMEWORK
Trade secrets are mainly protected under the PRC Anti-Unfair Competition Law. The State Administration for Industry and Commerce also issued Certain Regulations on Prohibiting Infringements upon Trade Secrets.

DURATION OF RIGHT
Trade secret protection is theoretically perpetual until the trade secret goes into the public domain.

OWNERSHIP/LICENSES
License of trade secrets is usually supported by non-disclosure clauses, which are enforceable.

REMEDIES FOR INFRINGEMENT
In case of infringement of trade secrets, the rights owner can either file a complaint with the local administrative authority or bring a lawsuit to the People's Court.

The local administrative authority may order the infringer to cease the infringing activity immediately and impose a fine up to ¥200,000. In respect of the infringing products, the infringer shall return the materials containing trade secrets or destroy the products manufactured based on the trade secrets unless the rights owner agrees to repurchase the products or dispose of them by other means.

Injunctive relief is available.

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

EMPLOYEES
For copyright, a work shall be deemed a “work for hire” if it is created by an individual in order to fulfill a task assigned by its employer. The copyright in that work shall vest in the author, except that the employer shall have priority to use the work within its business scope. Within two years of the work’s completion, the author may not authorize a third person to use the work in the same manner in which his employer uses it without the employer’s consent.

With respect to engineering design drawings, product design drawings, maps and computer software created mainly by using the material and technical conditions of, and under the responsibility of, the employer, the work’s author shall enjoy the right of authorship, and the employer shall enjoy the other copyright rights, in which case the employer shall reward the author.
For patent, if an invention is created in the course of performing the duties of an employee, or mainly by using the material and technical conditions of an employer, this invention shall be deemed a service invention. For a service invention, the employer has the right to apply for a patent. After such an application is approved, the employer shall be the patentee. The employer shall give an award to the employee who creates the patent, and a reasonable remuneration shall also be given to the employee based on the scope of application of the patent and the amount of the proceeds derived from such application.

For a non-service invention, the inventor or designer has the right to apply for a patent. After such an application is approved, the said inventor or designer shall be the patentee.

If inventions are made by an employee using the materials and technical conditions of an employer, and if the employer has concluded a contract with the inventor or designer stipulating agreements concerning the right to apply for the patent or the ownership of the patent right concerned, such agreements shall prevail.

CONSULTANTS/CONTRACTORS
Intellectual property ownership can be decided by the written contracts between the hiring party and the consultants and contractors. In the absence of a written clause regarding the assignment of developments, consultants and contractors will retain ownership of the intellectual property developed by them, even if contracted and paid for by another party.

KEY COMMERCIAL CONTRACT CONSIDERATIONS

REGISTRATION OF COMMERCIAL AGREEMENTS
Technology transfer agreements shall be registered or filed with the applicable competent authority, depending on the nature of the technology. Trademark and patent license agreements shall be registered with the Trademark Office and the Patent Office respectively. Material contracts of publicly-traded companies may require disclosure.

RECOGNIZED LANGUAGE OF COMMERCIAL AGREEMENTS
Generally, contracts signed in other languages are acceptable, but a Chinese translation should be provided for reference if the contracts are submitted to the relevant Chinese authorities or courts.

COUNTRY-SPECIFIC ISSUES FOR ONLINE CONTENT
N/A.

ENFORCEABILITY OF ONLINE/CLICKWRAP/SHRINKWRAP TERMS
Online/clickwrap/shrinkwrap agreements are generally enforceable.

GOVERNING LAW
Generally, governing law can be foreign law if a contract involves foreign related issues. But, if a party seeks intellectual property protection in China, the Chinese law must apply in respect of ownership and content of the intellectual property as well as the liability for infringement.
The dispute resolution can be resolved by foreign arbitration if the contract has foreign related issues. However, as it is almost impossible to enforce a judgment rendered by a foreign court in China, it is advisable not to choose a foreign court for dispute resolution if one of the contracting parties is a Chinese party.

**KEY COMMERCIAL CONTRACT TERMS**

**ENFORCEABILITY OF WARRANTY DISCLAIMERS**
A disclaimer for the following is not valid and not enforceable:

(i) Disclaimers for actions that caused personal injury;

(ii) Disclaimers for intentional actions that caused serious property damage or that caused by gross negligence; or

(iii) Disclaimers in violation of mandatory clauses in the law.

**ENFORCEABILITY OF EXCLUSIONS/LIMITATIONS OF LIABILITY**
Limitation of liability is common in contracts. However, pursuant to the PRC Contract Law, if the gap between the actual loss and such limitation is too big, the court or arbitration institution is entitled to adjust the amount of compensation in its judgment or award.

**INDEMNIFICATION**
Express indemnities stated in contracts are recognized and generally respected. Courts will not usually imply an indemnity obligation in a contract.
FRANCE

INTELLECTUAL PROPERTY FRAMEWORK

France is a civil law country.

Most of the rules and requirements applicable to intellectual property rights derive either from French law or European Union law and are codified in the French Intellectual Property Code.

COMMERCIAL CONTRACT FRAMEWORK

French law does not provide a unitary set of rules only applicable to commercial contracts. The following legal provisions may be applicable to commercial contracts:

(i) French Civil Code, which contains most contract law provisions (contract formation, contract validity, statutory warranties, contract and tort liability provisions);

(ii) French Commercial Code, which contains some specific rules applicable in business to business agreements (payment terms, interest for late payment, general terms and conditions, commercial agent provisions);

(iii) French Intellectual Property Code, for contract terms relating to intellectual property rights;

(iv) French Consumer Code, which contains important rules by which professionals must abide when dealing with consumers but which may also need to be taken into account when contracting with another business when the end-user is a consumer.

This list is not exhaustive and specific provisions may be implicated by certain types of commercial contracts (Law on Subcontracting; Data Protection Law; Law on Confidence in the Digital Economy).

RECOGNIZED INTELLECTUAL PROPERTY RIGHTS

COPYRIGHTS

NATURE OF RIGHT
Copyrights include economic rights and moral rights. French law grants copyright protection to “the rights of authors in all works of the mind, whatever their kind, form of expression, merit or purpose.”

There are two main conditions for copyright protection:

(i) The work must be fixed in a material form (i.e., on paper, in a computer program or in an electronic document);

(ii) The work must be original (i.e., it must be endowed with the personality of its author).
LEGAL FRAMEWORK

DURATION OF RIGHT
The economic rights of the author last for 70 years after his death. The author is deemed to have died on December 31 of the year of death. The date of death of the last contributor serves as the reference point for the 70-year post mortem auctoris period for collaborative works.

Moral rights are perpetual, inalienable and not subject to statutes of limitations.

OWNERSHIP/LICENSES
There are no formal requirements for copyright protection, but a work can be filed (in an enveloppe soleau) at the French Intellectual Property Office (INPI) to secure the date of the creation (and to a lesser extent, proof of existence and authorship).

Under French law, copyright is, by principle, vested in the author upon creation of the work. Only economic rights are assignable. Moral rights are inalienable and belong to the author perpetually.

Assignment of copyright must comply with the stringent requirements of Article L. 131-3 of the French Intellectual Property Code, which provides that the assignment agreement must expressly mention all and any rights assigned (e.g., right of reproduction, right of representation and communication, adaptation or translation) together with their associated scope and span.

REMEDIES FOR INFRINGEMENT
Copyright infringement actions may be brought before specialized courts, usually after having gathered evidence via an infringement seizure (saisie-contrefaçon), by way of an action on the merits and a summary action, in order to obtain an interlocutory injunction.

An injunction against the further manufacture, import, offer, sale, use or storage of the work can be ordered with immediate enforceability and impose penalties.

In determining the amount of damages to be awarded (compensatory – not punitive), French courts take into account distinctively:

(i) The negative or detrimental economic consequences of infringement, including lost gains and losses suffered by the rights holder;

(ii) The moral harm suffered by the rights holder; and

(iii) The profits earned by the infringer, including intellectual, tangible and promotional investments saved or not incurred by the infringer.

As an alternative and upon request of the rights holder, French courts may set the damages as a lump sum. This sum must be greater than the royalties that would have been owed if the infringer had sought a license. This amount is not exclusive of compensation for moral harm caused to the rights holder.

Remedies also include, notably, the recall, destruction or confiscation of the infringing products and the publication of the judgment.
MASK WORKS

NATURE OF RIGHT
Mask works are protectable as an industrial property title relating to a final or intermediary semiconductor product topography and grants to its owner an exclusive right of exploitation/reproduction.

There are two main conditions for the protection of a semiconductor product’s final or intermediary topography: (i) it must result from its creator’s own intellectual effort and (ii) it must not be commonplace in the semiconductor industry.

The exclusive rights shall not come into existence or shall no longer apply to the topography of a semiconductor product if an application for registration in due form has not been filed with the INPI within two years of the first commercial exploitation.

The exclusive rights on the semiconductor product topography shall include the rights to authorize or prohibit the reproduction, commercial exploitation or importation of a topography or of a semiconductor product manufactured by using the topography.

These exclusive rights shall not apply to reproduction for the purpose of analyzing, evaluating or teaching and shall not extend to the creation of a semiconductor product topography on the basis of an analysis and evaluation of another topography.

LEGAL FRAMEWORK
Semiconductor topographies are protected pursuant to Part VI of the French Intellectual Property Code (Articles L. 622-1 et seq. and R. 622-1 et seq.), which implements the European Directive of December 16, 1986 on the legal protection of topographies of semiconductor products.

DURATION OF RIGHT
Protection is granted as from the earlier of the following dates: (i) the filing of the application or (ii) the first act of commercial exploitation. Protection is granted until the end of the tenth calendar year following this event.

Where a topography has not been commercially exploited within a period of 15 years from its first fixation or encoding, any exclusive right in existence shall come to an end.

OWNERSHIP/LICENSES
Ownership lies with the persons who are the creators of the topographies of semiconductor products and the successors in title of these persons.

Mandatory licenses may apply in certain situations.

The licensee bears the obligation to exploit.

REMEDIES FOR INFRINGEMENT
A person who acquires a semiconductor product in good faith is not considered as infringing the rights in the semiconductor product topography. However, if such person wants to continue to exploit commercially such semiconductor product, this person must pay a fair indemnity.

An injunction to stop infringing acts can be ordered with immediate enforceability and impose penalties.
In determining the amount of damages to be awarded (compensatory – not punitive), French courts take into account distinctively:

(i) The negative or detrimental economic consequences of infringement, including lost gains and losses suffered by the rights holder;

(ii) The moral harm suffered by the rights holder; and

(iii) The profits earned by the infringer, including intellectual, tangible and promotional investments saved or not incurred by the infringer.

As an alternative and upon request of the rights holder, French courts may set the damages as a lump sum. This sum must be greater than the royalties that would have been owed if the infringer had sought a license. This amount is not exclusive of compensation for moral harm caused to the rights holder.

Remedies also include, notably, the recall, destruction or confiscation of the infringing products and the publication of the judgment.

PATENTS

NATURE OF RIGHT
Patents are an industrial property title relating to an invention and granting to its owner an exclusive right of exploitation/use.

The patent owner may, at any time, waive the patent or file a request for limitation of said patent.

LEGAL FRAMEWORK
Patents are governed by Part VI of the French Intellectual Property Code (Articles L. 611-1 et seq. and R. 611-1 et seq.), the European Patent Convention (also referred to as the Munich Convention) and EU regulations Nos. 1257/2012 and 1260/2012 of December 17, 2012 regarding the unitary patent (not yet effective).

DURATION OF RIGHT
Patent protection is granted for 20 years from the filing of the patent application.

Duration of protection can be extended, for medicinal products, via supplementary protection certificates and pediatric extensions.

Patents can be invalidated by Paris courts in case of lack of novelty, lack of inventive step, insufficiency of description, or added matter.

OWNERSHIP/LICENSES
The “first to file” system is defeated in case of fraud and mitigated in case of prior personal possession.

Co-ownership is possible. In the absence of a co-ownership agreement, the relevant provisions of the French Intellectual Property Code will automatically apply.
Assignments and licenses must be recorded at the INPI for opposability purposes.

Right of preemption by the French Government and mandatory licenses may apply in certain situations.

The licensee bears the obligation to exploit/work the patent in full.

**REMEDIES FOR INFRINGEMENT**
French law prohibits both direct infringement and contributory infringement.

Patent infringement actions may be brought before Paris courts (which have exclusive jurisdiction), usually after having gathered evidence via an infringement seizure (saisie-contrefaçon), by way of an action on the merits and a summary action in order to obtain an interlocutory injunction.

Manufacturers and importers are regarded as automatic infringers (i.e., need not be aware of the patent at stake to qualify as infringers).

An injunction against the further manufacture, import, offer, sale, use or storage of the work can be ordered with immediate enforceability and subject to penalties.

In determining the amount of damages to be awarded (compensatory – not punitive), French courts take into account distinctively:

(i) The negative or detrimental economic consequences of infringement, including lost gains and losses suffered by the rights holder;

(ii) The moral harm suffered by the rights holder; and

(iii) The profits earned by the infringer, including intellectual, tangible and promotional investments saved or not incurred by the infringer.

As an alternative and upon request of the rights holder, French courts may set the damages as a lump sum. This sum must be greater than the royalties that would have been owed if the infringer had sought a license. This amount is not exclusive of compensation for moral harm caused to the rights holder.

Remedies also include, notably, the recall, destruction or confiscation of the infringing products and the publication of the judgment.

**TRADEMARKS**

**NATURE OF RIGHT**
Trademarks are any sign capable of graphic representation that serves to distinguish the goods or services of a natural or legal person. A word, a sound or a picture may be protected as a trademark. Trademarks serve as an indication for the consumers of the commercial origin of the marked products or services.

**LEGAL FRAMEWORK**
Trademarks are governed by Part VII of the French Intellectual Property Code including notably:

(i) EC Directive 2008/95 to approximate the laws of the Member States relating to trademarks, dated October 22, 2008;
France became a member of the Madrid Agreement in 1892.

France became a member of the Madrid Protocol in 1997.

France became party to the Trademark Law Treaty in 1995.

DURATION OF RIGHT
Protection is through registration only. Registration remains in effect for ten years and is renewable indefinitely so long as the mark is used and remains distinctive.

OWNERSHIP/LICENSES
A trademark owner is free to transfer or license any and all of its rights under the trademark to a third party.

Joint ownership is possible.

A trademark may be used as a security (e.g., mortgage).

REMEDIES FOR INFRINGEMENT
Remedies are available regardless of whether the infringement is willful. No punitive damages will be awarded, even if the infringement is willful.

French law prohibits both direct infringement and contributory infringement.

Trademark infringement actions may be brought before specialized courts (Paris courts having exclusive jurisdiction for CTMs), usually after having gathered evidence via an infringement seizure (saisie-contrefaçon), by way of an action on the merits and a summary action, in order to obtain an interlocutory injunction.

An injunction against the further manufacture, import, offer, sale, use or storage of the work can be ordered with immediate enforceability and subject to penalties.

In determining the amount of damages to be awarded (compensatory – not punitive), French courts take into account distinctively:

(i) The negative or detrimental economic consequences of infringement, including lost gains and losses suffered by the rights holder;

(ii) The moral harm suffered by the rights holder; and

(iii) The profits earned by the infringer, including intellectual, tangible and promotional investments saved or not incurred by the infringer.
As an alternative and upon request of the rights holder, French courts may set the damages as a lump sum. This sum must be greater than the royalties that would have been owed if the infringer had sought a license. This amount is not exclusive of compensation for moral harm caused to the rights holder.

Remedies also include, notably, the recall, destruction or confiscation of the infringing products and the publication of the judgment.

Legal costs and attorneys’ fees can be recovered (at the discretion of the judge).

Trademarks can be filed with French Customs to prevent importation of infringing goods, provided those goods originate from outside the European free market.

**TRADE SECRETS**

**NATURE OF RIGHT**
A protectable trade secret is information that:

(i) Is secret in the sense that it is not, as a body or in the precise configuration and assembly of its components, generally known among or readily accessible to persons within the circles that normally deal with the kind of information in question;

(ii) Has commercial value because it is secret; and

(iii) Has been subject to reasonable steps under the circumstances, by the person lawfully in control of the information, to keep it secret.

Know-how (technical secrets) is better protected than commercial secrets.

**LEGAL FRAMEWORK**

Article 39 of the TRIPS Agreement.

Article 1 of EC Regulation No. 772/2004.

**DURATION OF RIGHT**
As long as secrecy is preserved.

**OWNERSHIP/LICENSES**
Ownership and licenses require appropriate identification of the trade secrets at stake.

**REMEDIES FOR INFRINGEMENT**
There are no specific legal provisions regarding remedies in case of unlawful reproduction or use of trade secrets.

The methods of assessing damages as well as the possibility and scope of court injunctions are controversial and not clearly or consistently set by French case law.
INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

EMPLOYEES
There is no work for hire under French law, except for:

(i) Copyright on software and related documentation; and

(ii) Patents to a certain extent and provided that certain conditions be met.

For a work made by an employee within the course of his employment, the rights in the work belong to the employee (although some case law has admitted implicit transfer to employer). Rights are vested in the employer only if the work is collective, or (in certain circumstances) if the work is software or related documentation.

CONSULTANTS/CONTRACTORS
There is no “work for hire” applicable to consultants and contractors under French law and, generally, intellectual property rights must be specifically assigned or licensed to the engaging entity or remain vested in the consultant/contractor.

KEY COMMERCIAL CONTRACT CONSIDERATIONS

REGISTRATION OF COMMERCIAL AGREEMENTS
There is no general registration requirement for commercial contracts under French law.

RECOGNIZED LANGUAGE OF COMMERCIAL AGREEMENTS
There is no requirement under French law that business-to-business contracts must be in French.

However, if documentation is provided to French consumers, the contract should at a minimum specify which party is responsible for producing French labeling or users’ guides. Pursuant to the French Language Law of August 4, 1994 (Loi Toubon), most any documentation or communication made to French consumers must be in French (any French translation must be as legible as the original version).

Also, under the French Language Law, a French or translated version of the agreement is required when concluding a contract with a public entity in France.

COUNTRY-SPECIFIC ISSUES FOR ONLINE CONTENT
Specific rules apply when consumers are concerned, such as the requirement to put in place a double-click system when a consumer makes a purchase online, or the obligation to provide consumers with certain mandatory information via a durable medium (i.e., in a pdf document or in the content of an email). In any event, the French Consumer Act (Loi Hamon) of March 17, 2014 has implemented European Directive 2011/83/EU dated October 25, 2011 on consumer rights. Thus, the rules applicable to agreements with consumers concluded online are to a certain extent similar in all European Union countries, save any local specificity.
ENFORCEABILITY OF ONLINE/CLICKWRAP/SHRINKWRAP TERMS
Online terms are generally viewed as enforceable if conspicuous, and users have an opportunity to review and indicate affirmative assent (e.g., check a box).

GOVERNING LAW
Governing law and venue for resolution of disputes specified in a commercial contract will generally be accepted. However, a consumer in France will be entitled to the protection of French law, if French law is more favorable to the consumer than the stipulated governing law. In all cases, French law that is considered by French courts to rise to the level of public policy will be applied by a French court. In respect of international contracts (e.g., where a party is not French) there is little case law holding which types of French law are public policy in international matters.

KEY COMMERCIAL CONTRACT TERMS

ENFORCEABILITY OF WARRANTY DISCLAIMERS
Certain statutory warranties such as the warranty of conformity (conformité), warranty against latent defects (vices cachés) or quiet title warranty cannot be excluded except under specific circumstances.

Consumers are entitled to specific additional warranties, and warranty disclaimers are generally unenforceable toward consumers.

ENFORCEABILITY OF EXCLUSIONS/LIMITATIONS OF LIABILITY
Exclusions or limitations of liability between businesses for breach of contract are both enforceable and common. Liability for gross negligence or willful misconduct cannot however be excluded. It is not uncommon to contractually cap one’s liability, for example, to the total aggregate amount paid during a certain period in application of a given contract.

French law only makes a distinction between direct and indirect losses. Direct losses are those that are direct, foreseeable and caused by the act or breach concerned. Indirect losses are those that are not foreseeable but are linked to the act that has generated the loss (such as loss of data, revenue and goodwill). On occasion, courts will consider that lost revenues were foreseeable and therefore constitute direct losses.

Tort liability cannot be limited or excluded under French law.

Exclusions or limitations of liability towards consumers are generally unenforceable under French law.

INDEMNIFICATION
Indemnification clauses are commonly used in French contracts, in particular where intellectual property rights are involved.

Generally, these clauses have three distinct obligations: defend, indemnify (pay damages) and hold harmless (indemnifying party responsible for any other liability arising out of the claim). Indemnification is not limited to third-party claims.

Caps on liability under indemnification provisions can be enforceable.

Indemnification clauses are generally unenforceable against consumers.
GUIDE TO GOING GLOBAL - INTELLECTUAL PROPERTY AND TECHNOLOGY

GERMANY

INTELLECTUAL PROPERTY FRAMEWORK

The German Constitution (Grundgesetz) refers protection of copyright and industrial property rights to exclusive legislation. In cases of exclusive legislation, only the Federal government has the legislative power.

COMMERCIAL CONTRACT FRAMEWORK

The German Civil Code (Bürgerliches Gesetzbuch) and Commercial Code (Handelsgesetzbuch) contain the general provisions relating to contracts.

The specific laws relating to certain intellectual property rights (e.g., Copyright Act, Patent Act, Utility Model Act) contain further provisions on licensing agreements.

RECOGNIZED INTELLECTUAL PROPERTY RIGHTS

COPYRIGHTS

NATURE OF RIGHT

Authors of literary, scientific and artistic works can own copyrights in their works. Only natural persons can be authors. Copyright protection arises upon creation of the work. Registration is neither necessary nor possible.

The author is granted moral rights which are, the right to decide whether and how the work will be published, and the right to recognition of authorship, and exploitation rights, which include the right to reproduction, distribution, exhibition, broadcasting, recitation, performance and presentation, and a resale royalty right.

LEGAL FRAMEWORK

Germany became signatory to the Berne Convention in 1887 as well as to the WIPO Copyright Treaty in 1996, amongst other international treaties relating to copyright matters.

Germany has implemented Directive 92/100/EEC on rental rights and lending rights and on certain rights related to copyright in the field of intellectual property and Directive 2001/29/EC on the harmonization of certain aspects of copyright and related rights in the information society.

Copyright issues are governed by the German Copyright Act (Urheberrechtsgesetz) (Copyright Act).

DURATION OF RIGHT

Copyright protection lasts for 70 years after the author’s death.

If copyright is owned by joint authors, it shall expire 70 years after the death of the last surviving author.
In the case of anonymous and pseudonymous works, copyright shall expire 70 years after publication. However, it shall expire 70 years after creation of the work if the work has not been published within that time limit.

The time limits specified above shall begin with the end of the calendar year in which the event that determines the beginning of the time limit has occurred.

Different protection periods apply to performers and producers of video recordings or films.

**OWNERSHIP/LICENSES**

Joint ownership of copyrights is recognized.

As a general rule, copyright is not transferable, unless in execution of a testamentary disposition or to co-heirs as part of the partition of an estate. However, the author may grant a right to use the work in a particular manner or in any manner. An exploitation right may be granted as a non-exclusive right or as an exclusive right.

An exploitation right may be transferred only with the author’s consent. The author may not unreasonably refuse his consent.

**REMEDIES FOR INFRINGEMENT**

As against any person who infringes a copyright or any other right protected by the Copyright Act, the injured party may seek to enjoin the infringement. The injured party is also entitled to demand destruction, recall or handover of the illegally prepared or distributed reproductions.

If the infringement was intentional or the result of negligence, compensation can be claimed. The compensation might include the profit realized as a result of the infringement. The compensation can also be calculated on the basis of the remuneration that the injured party would have received if the infringing party had been granted the necessary exploitation right.

If the infringement was neither intentional nor a result of negligence, the infringing party has the right to provide pecuniary compensation for the injured party instead of fulfilling the other claims the injured party has (i.e., claim to cease the infringement, claim to destruction, recall or handover), provided that fulfilling such claims would cause disproportionate damage to the infringing party. The amount of compensation should be an amount that would be reasonable if the use of the copyright was granted to the infringing party by contract.

The injured party is obliged to request the infringing party to cease its infringing activity before initiating a lawsuit and give the chance to the infringing party to settle the dispute by means of a reasonable contractual penalty.

Any person who, other than in a manner allowed by law and without the right holder’s consent, reproduces, distributes or publicly communicates a work or an adaptation or transformation of a work shall be liable to imprisonment for up to three years or a fine. The attempt to commit such an offense is also punishable.
Three-dimensional structures of semiconductors (topographies) can enjoy protection if they are considered distinctive. Distinctiveness is given if the topography is new and not trivial. Protection is also available for individual parts of topographies and illustrations for the production of topographies.

The protection of a topography must be applied for with the German Patent and Trademark Office. The Patent Office will register the right without examining the topography itself, so the validity of this right can be challenged by third parties (comparable to a German utility model).

Rights owners have the exclusive right to reproduce the topography and to commercialize either the topography or the semiconductor containing the topography, meaning to offer, put on the German market, distribute or import such topographies or semiconductor chips.

Semiconductor topographies are protected pursuant to the German Act on the Protection of Topographies of Microelectronic Semiconductors (Halbleiterschutzgesetz).

Protection of semiconductor topographies have a duration of ten years from application with the Patent Office or commercial use of the topography (two years grace period after such disclosure to the public). Protection ends at the end of the tenth calendar year.

Ownership can be transferred by contractual agreement. Joint ownership is possible. A transfer of ownership does not affect licenses that were granted before the transfer.

Licenses may be granted on an exclusive or a non-exclusive basis, also to multiple parties. In joint ownership, licenses may be granted only with the consent of other rights holders.

Different remedies for infringement are possible with the most commonly sought remedies being injunction and damages claims. Damages may be calculated as adequate license fees, infringer’s profits or lost profits of the rights holder. In order to calculate damages, an infringer has to render accounts. No punitive damages are available.

In addition, a rights holder may make a claim for call-back and destruction of infringing products. Customs seizure to stop the import of infringing semiconductors is also available.

Statutory costs for legal prosecution (court costs and attorney fees) are recoverable up to a cap established by German law.
PATENTS

NATURE OF RIGHT
Patent rights in Germany are available for technical inventions in two different aspects: (i) as a patent which is examined by the German Patent and Trademark Office before grant or (ii) as a utility model that is not specifically examined before registration.

The scope of protection is basically the same for both rights, with the exception that a patent can cover an apparatus and a method whereas a utility model only covers apparatus claims but not methods. Further, differences between patents and utility models lie mainly in their duration and in the ways to attack their validity.

In regards to products, the patent and the utility models both grant the right to exclude third parties from making, offering for sale, putting on the market, using, importing or possessing products that include the claimed invention. In regards to methods, the patent grants the right to exclude third parties from applying or offering a protected method, but also to offer and market products directly resulting from such protected methods (e.g., a product manufactured in an infringing production process).

LEGAL FRAMEWORK
The German Patent Act (Patentgesetz) and German Act for Utility Models (Gebrauchsmustergesetz) govern patents.

Germany became party to the Patent Cooperation Treaty in 1978 and the Paris Convention in 1903.

DURATION OF RIGHT
Patents are protectable for a maximum of 20 years after the filing date of the application. For certain products (pharmaceuticals and pesticides), extensions to 25 years are possible via Supplementary Protection Certificate (SPC).

Utility models are protectable for a maximum of ten years after the filing date of application. There is a grace period of six months after first commercial use.

OWNERSHIP/LICENSES
Ownership can be transferred by contractual agreement. Joint ownership is possible. A transfer of ownership does not affect licenses that were granted before the transfer.

Licenses may be granted on an exclusive or a non-exclusive basis and to multiple parties. In joint ownership, licenses may be granted only with the consent of other rights holders.

REMEDIES FOR INFRINGEMENT
Different remedies are possible, with the most commonly sought remedies being injunction and damages. Also, an exclusive licensee may enforce patent or utility models against infringers. Damages may be calculated as adequate license fees, infringer’s profits or lost profits of the rights holder. In order to calculate damages, an infringer has to render accounts. No punitive damages are available.

Rights holders or exclusive licensees may make a claim for call-back and destruction of infringing products. Customs seizure to stop the import of infringing products is also available.

Statutory costs for legal prosecution (court costs and attorney fees) are recoverable up to a cap established by German law.
TRADEMARKS

NATURE OF RIGHT
Trademarks protect signs that distinguish products or services of the rights holder from those of others. Signs may include words, logos, graphics, acoustic signs, three dimensional shapes or colors.

Trademarks can be registered with the German Patent and Trademark Office or enjoy an automatic protection through use if known in trade.

National trademarks (granting protection in Germany) and EU-wide Community Trademarks exist in parallel. Community Trademarks must be registered with the Office for Harmonization in the Internal Market (OHIM).

A trademark holder has the right to exclude third parties from labeling their products with identical or similar trademarks and from offering, marketing, using, importing or exporting such products. Identical or similar trademarks may also not be used in commercials or business documents of third parties.

LEGAL FRAMEWORK
The German Trademark Act (Markengesetz) for national trademarks and Community Trademark Regulation governs Community Trademarks. The national laws of the EU member states are harmonized to a high degree.

Germany became party to the Paris Convention in 1903, to the Madrid Agreement in 1922 and to the Madrid Protocol in 1996.

Germany became party to the Trademark Law Treaty in 2004.

DURATION OF RIGHT
Registration expires automatically after ten years but can be renewed for an additional ten years (by paying the renewal fee) indefinitely.

OWNERSHIP/LICENSES
Ownership can be transferred by contractual agreement. Joint ownership is possible. A transfer of ownership does not affect licenses that were granted before the transfer.

Licenses may be granted on an exclusive or a non-exclusive basis, also to multiple parties. In joint ownership, licenses may only be granted with the consent of other rights holders. Licenses may be granted for a certain part of the registered goods or services or parts of the protected territory only. Licenses do not have to be registered.

REMEDIES FOR INFRINGEMENT
Different remedies are possible but the most commonly sought remedies are injunction and damages claims. Damages may be calculated as adequate license fees, infringer’s profits or lost profits of the rights holder. In order to calculate damages, infringer has to render accounts. No punitive damages available.

Besides that, rights holder or exclusive licensee may make a claim for call-back and destruction of infringing products. Customs seizure is available to stop import in German or European territory (based on type of trademark).

Statutory costs for legal prosecution (court costs and attorney fees) are recoverable up to a cap established by the German law.
TRADE SECRETS

NATURE OF RIGHT
The concept of trade secrets is not defined by law, but the judicial practice worked out a definition as follows:

Information relating to a certain business that is not generally known or readily ascertainable but only known by a restricted number of persons, and which – based on the manifested will of the person in control of the information and the legal economic interests of the business – needs to be kept confidential. Disclosure of the trade secret must be suitable to cause economic damage to the business.

Trade secrets can include, for example, business plans, price calculations, investment plans and customer lists.

LEGAL FRAMEWORK
The general obligation to observe trade secrets results from the principle of the Civil Code to act in good faith.

Infringement of trade secrets is governed by the Unfair Competition Act (Gesetz gegen den unlauteren Wettbewerb) and the Criminal Code (Strafgesetzbuch). Infringement of trade secrets might constitute unfair commercial practice under the Unfair Competition Act.

DURATION OF RIGHT
Information is protectable as a trade secret as long as the information qualifies as trade secret.

OWNERSHIP/LICENSES
Joint ownership is possible.

Trade secrets are usually disclosed under a confidentiality agreement. Licenses relating to know-how are enforceable.

REMEDIES FOR INFRINGEMENT
In connection with infringement of trade secrets, the general compensation provisions of the Civil Code apply. Accordingly, a person who intentionally or negligently, unlawfully injures the property or another right of another person, is liable to make compensation to the other party for the damage arising from this. The compensation must restore the position that would exist if the circumstance obliging the infringing party to pay damages had not occurred.

If the infringing behavior constitutes unfair commercial practice under the Unfair Competition Act, the remedies set out in the Unfair Competition Act apply (e.g., the injured party is entitled to claim ceasing of the injuring activity or compensation).

The Unfair Competition Act prescribes that disclosing or acquiring a trade secret for personal gain, for the benefit of a third party or with the intent of causing damage to the owner of the business or for the purposes of competition might incur criminal liability.
INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

EMPLOYEES
As regards copyright, the Copyright Act prescribes that the general provisions of the Copyright Act shall also apply if the author has created the work in execution of his duties under a contract of employment. Accordingly, German copyright law does not feature a work for hire doctrine, and thus as a general rule, copyright is owned by the author (employee). However, jurisdiction and literature acknowledge that by virtue of the employment contract, the employer is granted sufficient and exclusive exploitation (i.e., an obligation to transfer the exploitation rights exists). Nevertheless, it is advisable to regulate the transfer of the exploitation rights to the employer in written form (typically in the employment contract).

As regards computer programs, the Copyright Act explicitly prescribes that if the employee creates a computer program in the execution of his duties or following the instructions given by the employer, the employer has exclusive rights to exercise all the economic rights in the program, unless agreed otherwise.

The Act on Inventions of Employees (Arbeitnehmererfindungsgesetz) regulates patentable inventions and inventions eligible for utility patent made by employees. Employees shall notify their employer of such inventions and the employer is entitled to acquire the related intellectual property right from the employees. As a result of a reform in 2009, the Act on Inventions of Employees governs the relating procedure as follows:

Employees are required to immediately inform their employers of any inventions in writing. The employer is entitled to claim and exploit employee inventions. The employer can claim ownership of the invention within four months of the notification date. Until the recent amendments of 2009, the employer had to actively claim the invention. However, as a result of the reform, the employer is now deemed to claim the invention, unless it specifically releases the invention to the employee in writing within four months of the notification. If the employer claims ownership of a service invention, it must pay “reasonable compensation” to the employee and ensure the invention is properly protected in Germany. The amount of “reasonable compensation” must reflect the economic value of the invention, the position of the employee within the company, and the share of the company in the development of the invention.

CONSULTANTS/CONTRACTORS
Consultants and contractors will retain ownership of the intellectual property developed by them, unless otherwise agreed by the parties.

KEY COMMERCIAL CONTRACT CONSIDERATIONS

REGISTRATION OF COMMERCIAL AGREEMENTS
There is no registration requirement.

RECOGNIZED LANGUAGE OF COMMERCIAL AGREEMENTS
Commercial contracts can be in any language that both parties understand is sufficient.
COUNTRY-SPECIFIC ISSUES FOR ONLINE CONTENT
As a general rule, a host service provider is not liable for copyright infringing content provided by others, provided that it does not have actual knowledge of the illegal content or, if it gained knowledge of the illegal content, has immediately removed or blocked the illegal content.

ENFORCEABILITY OF ONLINE/CLICKWRAP/SHRINKWRAP TERMS
Online and click-wrap general terms and conditions are enforceable. The enforceability of shrink-wrap terms is less clear.

GOVERNING LAW
The interpretation and enforceability of commercial contracts is a matter of governing law. The governing law is the law of the country chosen by the parties or, for lack of a valid choice of law provision, the law applicable on the basis of the relating legal provisions. Regulation 593/2008/EC on the law applicable to contractual obligations (Rome I Regulation) sets out the principles relating to law applicable in the absence of choice of law of the parties.

The choice of law of the parties is generally accepted, provided that the choice is made expressly or is clearly demonstrated by the terms of the contract or the circumstances of the case.

Where all other elements relevant to the situation at the time of the choice of law are located in a country other than the country whose law has been chosen, the choice of the parties shall not prejudice the application of provisions of the law of that other country which cannot be derogated from by agreement.

KEY COMMERCIAL CONTRACT TERMS

ENFORCEABILITY OF WARRANTY DISCLAIMERS
As a general rule, warranty disclaimers are enforceable. However, the Civil Code contains restrictions on enforceability in some circumstances. In general, in terms and conditions, as well as in contracts involving consumers, the enforceability of disclaimers is even more limited.

The warranties usually disclaimed are the warranties of merchantability and fitness for a particular purpose.

ENFORCEABILITY OF EXCLUSIONS/LIMITATIONS OF LIABILITY
As a general rule, exclusions of liability for negligent conduct are enforceable.

It is common to apply a cap on damages resulting from negligent conduct and to exclude indirect damages resulting from negligent conduct. It is also common to stipulate liability only for gross negligence or damages resulting from a breach of a material contractual obligation.

Exclusions of liability for willful conduct are not enforceable.

Please note that different provisions apply to exclusion or limitation of liability in general terms and conditions or consumer contracts. For example, exclusion or limitation of liability for gross negligence in general terms and conditions is not enforceable.

Courts interpret the limitations of liability narrowly.

Possible claims based on the specific Product Liability Act (Produkthaftungsgesetz) cannot be excluded from liability. The Product Liability Act might be applicable to software.
INDEMNIFICATION

Indemnification clauses of contracts are generally enforceable. If the indemnification provision is provided in general terms and conditions, it might be subject to restrictions provided for in the Civil Code.

It is common to stipulate in contracts that the indemnifying party will indemnify and hold harmless the other party with respect to claims of third parties relating to the subject matter of the contract, except for claims resulting from willful or negligent conduct of the other party.
HONG KONG

INTELLECTUAL PROPERTY FRAMEWORK

Hong Kong has an established legal framework for the protection of intellectual property rights in patents, trademarks, copyright and registered designs under various ordinances.

COMMERCIAL CONTRACT FRAMEWORK

Contract law in Hong Kong is largely based on the English common law model. There are no ordinances that govern commercial contracts generally, though, there may be ordinances that are relevant to certain commercial arrangements (such as the sale of goods) and contracts in particular industries.

RECOGNIZED INTELLECTUAL PROPERTY RIGHTS

COPYRIGHTS

NATURE OF RIGHT

The Copyright Ordinance defines copyright as a property right, comprising economic rights and moral rights. Registration is not required for copyright protection. The rights arise automatically upon creation of the relevant copyright work.

Copyright owners have the exclusive right to reproduce, distribute, prepare derivative works, publicly perform and publicly display their works of authorship.

LEGAL FRAMEWORK

Copyrights are mainly governed under the Copyright Ordinance (Cap.528). Hong Kong became signatory to Berne Convention in 1997.

DURATION OF RIGHT

In general, the duration of copyright in literary, dramatic, musical or artistic works is the life of the author plus 50 years. If the author of the work is anonymous, the duration is 50 years from the end of the calendar year in which the work was first made, or if during that period the work is made available to the public, 50 years from the end of the calendar year in which it was first made available.

OWNERHIPS/LICENSES

Joint ownership of copyrights is recognized. A license of copyright is a contractual right or permission from the copyright owner to do certain acts otherwise prohibited under the Copyright Ordinance. The license can be exclusive or non-exclusive and does not have to be in writing.
REMEDIES FOR INFRINGEMENT
Available civil remedies include damages, covering both economic loss and non-economic loss, order for delivery up, an account of profits and injunctive relief. The court may award additional damages having regard to all of the circumstances of the case including the flagrancy of the infringement and any benefit accruing to the defendant by reason of the infringement.

Relief for groundless threats of infringement is available. Relief may be in the form of a declaration that the threats are unjustifiable, an injunction against the continuance of the threats or damages for any loss that has been sustained by the threats.

Criminal sanctions including fines and imprisonment are possible.

MASK WORKS

NATURE OF RIGHT
An ‘integrated circuit’ is defined as a product, in its intermediate or final form, in which the elements, at least one of which is an active element, and some or all of the interconnections are integrally formed in or on, a piece of material and which is intended to perform an electronic function.

The ordinance protects a lay-out design (topography) that is owned by a qualified owner and is original. A qualified owner has the exclusive right to reproduce all or part of or to commercially exploit his protected layout-design (topography).

Subject to certain exceptions, the owner is able to take civil action to prohibit others from reproducing or distributing his layout-design (topography) without his consent or without payment of royalties. There is no need to register the layout-design right and protection will be automatic.

LEGAL FRAMEWORK
Mask works are protected under the Layout-Design (Topography) of Integrated Circuits Ordinance (Cap.445).

The underlying concepts of rights granted under Layout-Design (Topography) of Integrated Circuits Ordinance are broadly the same as those under the Copyright Ordinance.

DURATION OF RIGHT
The duration of protection is ten years after the end of the year in which it was first commercially exploited or 15 years following the end of the year in which it was created if not commercially exploited.

OWNERSHIP/LICENSES
Rights in layout-design (topography) can be freely assigned, licensed or inherited. Assignment and transmission may be in total or partial. Assignment has to be in writing and signed by or on behalf of the assignor.
REMEDIES FOR INFRINGEMENT
Available civil remedies include damages, order for delivery up, order for disposal, an account of profits and injunctive relief. The court may award additional damages having regard to all of the circumstances of the case including the flagrancy of the infringement and any benefit accruing to the defendant by reason of the infringement.

Relief for groundless threats of infringement is available. Relief may be in the form of a declaration that the threats are unjustifiable, an injunction against the continuance of the threats or damages for any loss that has been sustained by the threats.

PATENTS

NATURE OF RIGHT
A patent gives the inventor an exclusive right to use his invention. A patent protects the invention by giving the inventor a legal right to prevent others from manufacturing, using, selling or importing the patented invention.

LEGAL FRAMEWORK

There are two types of patents, standard and short-term. The grant of a standard patent in Hong Kong is based on the registration of a patent granted by one of three designated patent offices including the United Kingdom Patent Office, the European Patent Office and the State Intellectual Property Office of China. The Hong Kong Intellectual Property Department does not conduct substantive examination of patent applications. The short-term patent application involves formality examination only.

DURATION OF RIGHT
The duration of protection is 20 years for a standard patent; and eight years for a short-term patent.

OWNERSHIP/LICENSES
Joint ownership is permissible. Subject to agreement to the contrary, each of the co-owners is entitled to an equal, undivided share in the patent and is entitled to exploit the invention for his own benefit. A license can only be granted with the written consent of all co-owners unless they have agreed otherwise.

REMEDIES FOR INFRINGEMENT
The remedies for infringement include order for delivery up or destruction of the infringed article, damages, an account of profits, declaration of infringement and injunctive relief.

Relief for groundless threats of infringement is available. Relief may be in the form of a declaration that the threats are unjustifiable, an injunction against the continuance of the threats or damages for any loss that has been sustained by the threats.
TRADEMARKS

NATURE OF RIGHT
A trademark is a sign that distinguishes the goods and services of one trader from those of others. Typically a trademark can be words, indications, designs, letters, characters, numerals, figurative elements, colors, sounds, smells, the shape of the goods or their packaging, or any combination of these. Such sign must be capable of being represented graphically in order to be registered as a trademark.

A registered trademark is personal property.

LEGAL FRAMEWORK
The Trade Marks Ordinance (Cap.559) governs trademarks. Hong Kong is not a member of the Madrid Protocol.

DURATION OF RIGHT
The duration of protection is ten years from the date of registration and renewable for an additional ten-year period.

OWNERSHIP/LICENSES
Joint ownership is permissible. Subject to agreement in the contrary, each of the co-owners is entitled to an equal, undivided share in the trademark and is entitled to exploit the invention for his own benefit. A license can only be granted with the written consent of all co-owners unless they have agreed otherwise. A license, which may be general or limited, is not effective unless it is in writing and is signed by or on behalf of the grantor.

REMEDIES FOR INFRINGEMENT
The remedies for infringement include damages, an account of profits and injunctive relief, order for delivery up of infringing goods, material or articles and order for such goods, materials or articles to be forfeited, destroyed or disposed of outside the channels of commerce.

Relief for groundless threats of infringement is available, as an implementation of the TRIPS Agreement. Relief may be in the form of a declaration that the threats are unjustifiable, an injunction against the continuance of the threats or damages for any loss that has been sustained by the threats.

Criminal sanctions for trademark counterfeiting under Trade Descriptions Ordinance (Cap.362) is also available as a possible remedy.

TRADE SECRETS

NATURE OF RIGHT
Trade secrets and undisclosed commercial information are protected by the common law of confidence. An obligation of confidence will arise whenever the information is communicated to or acquired by a person who knows or ought, as a reasonable person, to know that the other person wishes to keep that information confidential. An industry or trade custom or practice may also impose an obligation of confidence.
**LEGAL FRAMEWORK**
Common law of confidence is the legal basis for trade secrets protection.

**DURATION OF RIGHT**
Trade secrets can be protected as long as it is confidential, potentially perpetual.

**REMEDIES FOR INFRINGEMENT**
The remedies available for breach of confidence include injunctions, damages, an account of profits and delivery up of materials containing confidential information.

**INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT**

**EMPLOYEES**
The default position in Hong Kong is that an employer owns any intellectual property created during the course of employment. It is also customary to include suitable contract clauses with respect to assignment and confidentiality in the employment contract.

The Patents Ordinance provides that the employer owns the invention if the invention is created in the course of the employee’s normal duties or duties specifically assigned to him or the invention might reasonably be expected to result from the carrying out of the employees’ duties, or the employee has a special obligation to further the interests of the employer’s undertaking and the invention was made in the course of the employee’s duties. Notwithstanding the employer’s ownership of such inventions, the employee may be entitled to monetary compensation, being a fair share of the benefits derived, if the patent resulting from the invention is of outstanding benefit to the employer.

The Copyright Ordinance provides that, subject to contrary written agreement, the employer is the first owner of the copyright of literary, dramatic, musical or artistic work or film made by employee in the course of employment. A further award shall be made to the employee if the use of the employee’s work is beyond the employee’s reasonable contemplation at the time of making the work in the course of employment.

**CONSULTANTS/CONTRACTORS**
It is customary for consultants and contractors to sign written agreements. The ownership of the work is determined by the express terms of the agreement. Absent an express term of written assignment of developments, consultants and contractors will generally retain ownership of the intellectual property developed by them, even if it is contracted and paid for by another party.

**KEY COMMERCIAL CONTRACT CONSIDERATIONS**

**REGISTRATION OF COMMERCIAL AGREEMENTS**
There is no general registration requirement for commercial contracts. Material contracts entered into by listed companies may require disclosure.

Certain commercial transactions affecting rights in registered designs, patents and trademarks, including assignment, mortgage and license, are registrable. Failure to register may render the transactions unenforceable against potential subsequent buyers of the rights without notice.
RECOGNIZED LANGUAGE OF COMMERCIAL AGREEMENTS
English, and preferably “plain English” that is consumer-friendly, is the preferred language for contracts, particularly in consumer-facing commercial agreements and terms.

COUNTRY-SPECIFIC ISSUES FOR ONLINE CONTENT
There is currently no “safe-harbor” for online service providers in respect of copyright infringement occurring on their service platforms. An amendment bill will introduce a set of “safe-harbor” provisions that will shield online service providers from liability provided that certain conditions, including appointment of designated copyright agents, are met. This has not yet been introduced. There will be a voluntary code of practice for online service providers to follow so as to comply with the notification and reporting system as set out in the ‘safe-harbor’ provisions.

ENFORCEABILITY OF ONLINE/CLICKWRAP/SHRINKWRAP TERMS
Online terms are generally viewed as enforceable if conspicuous, users have an opportunity to review and indicate affirmative assent (e.g., check a box).

GOVERNING LAW
Governing law and venue for resolution of disputes specified in a commercial contract will generally be accepted and recognized by Hong Kong Courts.

The parties are free to opt for litigation or alternative dispute resolution such as arbitration and mediation.

KEY COMMERCIAL CONTRACT TERMS

ENFORCEABILITY OF WARRANTY DISCLAIMERS
Disclaimers of warranty are subject to a test of reasonableness under the Control of Exemption Clauses Ordinance (Cap.71). The disclaimers are enforceable if they are reasonable.

In a business contract for the sale of goods, a seller usually disclaims or excludes implied warranties that are provided in the Sale of Goods Ordinance (Cap.26), including implied warranties of merchantable quality and fitness for a particular purpose.

With respect to consumer contracts for the sale of goods, the liability for breach of the implied terms and conditions under the Sale of Goods Ordinance cannot be excluded or restricted by reference to disclaimers.

ENFORCEABILITY OF EXCLUSIONS/LIMITATIONS OF LIABILITY
It is customary for sellers to exclude indirect damages (including consequential, incidental and special damages), but the exclusions/limitations of liability for death or personal injury resulting from negligence are not enforceable in either business or consumer contracts.

A cap on direct damages or aggregate liability is also common.

The enforceability of exclusions and limitations on liability is subject to the test of reasonableness. The court will enforce such clauses if it is fair and reasonable in the circumstances. The relevant considerations include: the strength of the bargaining positions of the parties, whether the buyer received an inducement to agree to the term, or if it had an opportunity of entering into a similar
contract without such similar term with others, whether the buyer knew or ought to have known of the existence and extent of the term, and whether it was reasonable at the time of contract to expect that compliance with the condition would be practicable.

Exclusions and limitations of liability for breach of the implied terms and conditions under the Sale of Goods Ordinance are not enforceable against consumers.

**INDEMNIFICATION**

Express indemnities stated in contracts are recognized and generally respected.

Implied indemnities may arise when one person does an act at a second person’s request as well as out of the relationship of principal and agent or employer and employee. Courts will not usually imply an indemnity obligation in a contract where an express indemnity is already stated.

An indemnification provision generally provides for indemnifying (pay damages) the other party and holding the other party harmless (indemnifying party responsible for any other liability arising out of the claim). Indemnification can cover claims between parties as well as third-party claims.

Caps on liability under indemnification provisions can generally be enforceable.
INDIA

INTELLECTUAL PROPERTY FRAMEWORK
As a general matter intellectual property rights are governed by Federal statutes. However, trade secrets are not specifically protected by any legislation though they may be protected as contractual obligations, subject to the Indian Contract Act 1872 (Contract Act).

COMMERCIAL CONTRACT FRAMEWORK
The Contract Act governs formation, implementation and enforcement of commercial contracts. It also lists contracts that may be void, voidable or unlawful. Apart from the general obligations under the Contract Act, there may be industry specific legislations at the Federal and state levels that may be applicable to contracts in particular industries, or particular types of contracts.

The Specific Relief Act 1963 (SRA) grants specific relief in cases relating to enforcement of individual civil rights. Some of the relief that courts may grant under the SRA include specific performance of a contract, and permanent injunctions.

Apart from the Contract Act, transactions in goods are governed by the Sale of Goods Act 1930 (SOGA), and transactions in immovable property are governed by the Transfer of Property Act 1872.

Electronic contracts are recognized under the Information Technology Act 2000 (IT Act).

RECOGNIZED INTELLECTUAL PROPERTY RIGHTS

COPYRIGHTS

NATURE OF RIGHT
Copyright protection is available for original works of authorship expressed in a tangible form. Registration not required for a valid copyright and the rights arise at the time the original work is captured on a tangible medium.

Copyright owners have the exclusive right to reproduce, distribute, prepare derivative works, publicly perform and publicly display their works of authorship.

LEGAL FRAMEWORK
Copyright in India is enforced under the Copyright Act 1957, as amended by the Copyright Act (Amendment) Act 2012 (Copyright Act). Like the Berne Convention, which has been adopted by India, Section 57 of the Copyright Act also expressly protects the moral rights of authors. It permits an author or their legal representative to (i) claim authorship of the work and (ii) restrain or claim damages in respect of any distortion, mutilation, modification or other act in relation to the said work, if such distortion, mutilation, modification or other act would be prejudicial to his honor or reputation.
DURATION OF RIGHT
Copyright in any literary, dramatic, musical or artistic work published within the lifetime of the author, subsists for a period of 60 years from the year following the year in which the author dies. Copyright in works published anonymously or pseudonymously, subsists for 60 years from the year following the year in which it was first published, provided that if the identity of the author is established before this period, copyright will subsist until 60 years from the beginning of the calendar year following the year in which the author dies.

Copyright subsists in works of international organizations, public undertakings, government works, cinematographs, sound recordings and photographs for a period of 60 years from the beginning of the calendar year following the year in which the particular work was published.

OWNERSHIP/LICENSES
Joint ownership of copyrights is recognized where a work has been produced by the collaboration of two or more authors and where the contribution of one author is not distinct from the contribution of the other author(s).

Implied licenses are usually not recognized in India, since the Copyright Act clearly requires that a license be granted in writing, by the owner of the copyrighted work or his duly authorized agent. Further, where the term and geographical extent of the license is not clearly specified, the Copyright Act creates an assumption that the license has a term of five years and is applicable only within the territory of India.

REMEDIES FOR INFRINGEMENT
The owner of a copyright is entitled to civil, as well as criminal, remedies for infringement. Civil remedies consist of injunction, civil damages or account of profits. Statutory damages are not available under the Copyright Act.

Criminal penalties range from imprisonment for a term of six months to three years, and with fine not less than ₹50,000 and can be up to ₹200,000. The Copyright Act also provides for enhanced penalties in case of second or subsequent convictions. It states that where a person is convicted of an offense for the second, or for every subsequent time, he will be punishable with imprisonment for a term not less than one year, extendable to three years, and with a fine of not less than ₹100,000, extendable up to ₹200,000.

MASK WORKS

NATURE OF RIGHT
The Semiconductor Integrated Circuits Layout-Design Act 2000 (SICLD) protects the intellectual property of the author in an original “layout-design.” “Layout-Design” is defined under the SICLD as a layout of transistors and other circuitry elements and includes lead wires connecting such elements and expressed in any manner in a semiconductor integrated circuit. A validly registered layout-design will give to the registered proprietor the exclusive right to the use of the layout-design and to obtain relief in respect of infringement.

LEGAL FRAMEWORK
“Mask Works” are protected under Indian law under the SICLD, as ‘layout-design’.
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**DURATION OF RIGHT**
The registration of a layout-design continues for a period of ten years beginning from the date of filing an application for registration or from the date of first commercial exploitation anywhere in India or in any country, whichever is earlier.

**OWNERSHIP/LICENSES**
Joint ownership of a layout-design is recognized in India. An assignment of a registered layout-design may be made in connection with, or independently of, the good will of a business. Such assignment must be in writing and registered with the Registrar and advertised in such manner, form and within such period as may be prescribed by the Registrar.

The SICLD also recognizes the registration of third parties as registered users of any registered layout-design.

**REMEDIES FOR INFRINGEMENT**
Criminal penalties for infringement of layout-design include imprisonment for a term of up to three years or a fine not less than ₹50,000 and up to ₹10 million or both. Further, where a person is convicted of an offense of infringement, the court convicting him may direct the forfeiture to the government of all goods and things by means of, or in relation to, which the offense has been committed.

Criminal Penalty for companies: If the person committing an offense is a company, the company as well as every person in charge of, and responsible to the company for the conduct of its business, at the time of the commission of the offense, will be deemed to be guilty of the offense, and liable to be proceeded against and punished accordingly.

Civil Remedies: Costs for the prosecution of an offense are also recoverable, apart from civil damages and injunctive relief. Statutory damages are not prescribed.

**PATENTS**

**NATURE OF RIGHT**
Patents are a statutory right granted under the Patents Act 1970 (Patents Act), to an “invention.”

A patent granted under the Patents Act confers upon the patentee, the following rights:

(i) Product Patents – the exclusive right to prevent third parties from the act of making, using, offering for sale, selling or importing for those purposes that product in India, without the consent of the patentee; and

(ii) Process Patents – the exclusive right to prevent third parties from the act of using that process, and from the act of using, offering for sale, selling or importing for those purposes the product obtained directly by that process in India.

**LEGAL FRAMEWORK**
India is a party to the Patent Cooperation Treaty and Paris Convention. The Federal legislation in India that grants statutory right to patents is the Patents Act.

**DURATION OF RIGHT**
Patents have a duration of twenty years from the date of filing a patent application either in India or internationally under the PCT. India follows a “first-to-file” system.
Joint ownership of patents is possible and the joint owners have an equal, undivided share in the patent, unless otherwise agreed between the parties. Unless an agreement to the contrary is in force, each person registered as an owner of a patent will be entitled, by himself, to the rights conferred on an individual patent owner for his own benefit, without accounting to the other person or persons. A license or share in a patent cannot be granted or assigned by a joint owner individually except with the written consent of the other joint owners.

Assignment of patents is valid if made in writing and duly executed. Any person who becomes entitled by assignment, transmission, license or operation of law, to a patent, is required to apply for registration of his title to it, to the Controller.

The relief, which a court may grant in any suit, for infringement includes an injunction and at the option of the plaintiff, either damages or an account of profits. The court may also order goods which are found to be infringing and materials and implements, the predominant use of which is the creation of infringing goods, to be seized, forfeited or destroyed.

If the person committing an offense is a company, then the company, as well as every person in charge of and responsible to the company for the conduct of its business at the time of the commission of the offense would be deemed to be guilty of the offense and be liable to be proceeded against and punished accordingly.

No criminal penalties are awarded under the Patents Act.

A mark includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of hues or any combination.

A trademark is a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of hues. A trademark indicates a connection in the course of trade between the goods or services, as the case may be, and some person having the right as proprietor to use the mark.

A collective mark means a trademark distinguishing the goods or services of members of an association of persons which is the proprietor of the mark from those of others.

India is a signatory to the Madrid Protocol and the law governing trademarks in India is The Trade Marks Act 1999.

Trademark protection is effective for ten years from registration and thereafter renewable on payment of fees (in effect, perpetual, subject to payment of renewal fees).
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OWNERSHIP/LICENSES
A registered trademark may be assigned or transferred, with or without the goodwill of the business concerned, and in respect either of some or all the goods or services with regard to which the trademark is registered. Associated trademarks may only be assigned or transmitted as a whole.

REMEDIES FOR INFRINGEMENT
Civil remedies include injunctive relief, civil damages, an account of profits, delivery of infringing goods for destructions and cost of legal proceedings.

Criminal remedies can include imprisonment for a term not less than six months and up to three years, and fine not less than ₹50,000, and up to ₹200,000.

TRADE SECRETS

NATURE OF RIGHT
Protection is provided to trade secrets in the form of formulae, patterns, plans, designs, physical devices, processes and know-how.

LEGAL FRAMEWORK
There is no specific legislation that protects trade secrets in India. However, it is common for parties to contractually protect their respective trade secrets in compliance with the general provisions of the Contract Act.

DURATION OF RIGHT
Trade secrets can be protected as long as contractually agreed between the concerned parties. However, any trade secret that is (i) known by a receiving party prior to receiving the trade secret from the disclosing party; (ii) becomes rightfully known to the receiving party from a third-party source, through no fault of the receiving party; (iii) or becomes publicly available through no fault of or failure to act by the receiving party in breach of this Agreement; (iv) required to be disclosed in a judicial or administrative proceeding, or is otherwise requested or required to be disclosed by law or regulation; or (v) or has been independently developed by employees, consultants or agents of a receiving party without violation of the terms of the contract cannot be protected under contract as a trade secret.

No person can be restrained from seeking employment with a competitor on the grounds of disclosure of trade secrets. Indian courts do not enforce non-compete clauses beyond the duration of employment under the contract. However, Indian courts may enjoin an ex-employee from disclosing trade secrets of a former employer to a future employer.

OWNERSHIP/LICENSES
The ownership of trade secrets vests with an owner as long as they are secret and do not fall under the exceptions described above.

Trade secrets may be licensed under contract.

REMEDIES FOR INFRINGEMENT
Infringement of trade secrets would amount to breach of contractual obligations. A party may obtain an injunction, compensation and return or destruction of all confidential and proprietary information.
INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

EMPLOYEES
It is customary for employees to sign invention assignment and confidentiality agreements. Failing to include the required text in the form of an assignment clause in employment agreements may raise enforceability issues, especially for work product that is patentable.

A concept similar to ‘work for hire’ finds its way under Section 17 of the Copyright Act, wherein, the employer is deemed to be the first owner of copyright in a work made by an employee, during the course of his employment.

Apart from copyright ownership, all other intellectual property rights created by employees require specific assignment and registration. In view of this, it is customary for employment agreements to contain general assignment provisions in favor of the employer, and enabling provisions, allowing the employer to seek specific assignment of identifiable work product.

CONSULTANTS/CONTRACTORS
In case of a commissioned work product created by a consultant/contractor, Section 17 of the Copyright Act may be applicable, making it a ‘work for hire’. However, in all other cases, it is common to execute a general assignment, along with enabling provisions for a specific assignment of intellectual property.

KEY COMMERCIAL CONTRACT CONSIDERATIONS

REGISTRATION OF COMMERCIAL AGREEMENTS
The Registration Act 1908 lists contracts for which compulsory registration is required. This generally includes instruments relating to transfer of immovable property, including gift, leases and other non-testamentary instruments transferring or assigning or extinguishing any right, title or interest, to or in immovable property.

Also, stamp duty is required to be paid under Federal as well as State Stamp Acts, in order to validate or authenticate certain documents, such as intellectual property assignment agreements.

RECOGNIZED LANGUAGE OF COMMERCIAL AGREEMENTS
English is the most commonly used language for contracts in India.

COUNTRY-SPECIFIC ISSUES FOR ONLINE CONTENT
While intermediaries (websites, Internet service providers) can shield themselves from liability arising due to third-party content, by taking certain statutory actions as required under the IT Act, this exemption from liability does not apply to copyright and patent infringement claims.

ENFORCEABILITY OF ONLINE/CLICKWRAP/SHRINKWRAP TERMS
Online terms are generally viewed as enforceable subject to compliance with Indian contract law, and the IT Act. Users must have an opportunity to review and indicate affirmative assent (e.g., check a box) to contractual terms.
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GOVERNING LAW

Governing Law – Contracting parties have the right to choose the governing law of a contract. However, where the governing law is not mentioned in the contract, courts in India follow the ‘closest connection’ test, to determine governing law, meaning that the court would identify the legal system with which the transaction has its closest and most real connection. Various factors that the courts would look into are: the place where the contract was made, place of performance, place of domicile, residence or business of parties, subject matter of contract.

It may be relevant to note that foreign law is not recognized by Indian courts, and is required to be pleaded as facts, with expert evidence, under the Indian Evidence Act 1872.

Jurisdiction/Venue – Jurisdiction of Indian Courts is attained from the Code of Civil Procedure, 1908 (CPC). The jurisdiction of civil courts is subject to territorial and pecuniary limitations. In cases of international commercial contracts, parties may choose the jurisdiction/venue of disputes. However, even in such cases, Indian Courts may assume jurisdiction, after analyzing the balance of convenience in cases where a party claims that the choice of foreign jurisdiction would result in undue disadvantage to that party.

Alternate Dispute Resolution – Parties may specify an alternative dispute resolution mechanism, such as arbitration, conciliation or mediation. Indian Courts recognize and enforce decisions of recognized foreign arbitral tribunals, subject to limitations prescribed under the Indian Arbitration and Conciliation Act 1996.

KEY COMMERCIAL CONTRACT TERMS

ENFORCEABILITY OF WARRANTY DISCLAIMERS

Where any right, duty or liability arises under a contract of sale by implication of law, it may be negative (overridden) or varied by express agreement or by the course of dealing between the parties or by usage, if the usage is such as to bind both parties to the contract.

Sellers, in their contracts for the sale of goods, customarily disclaim or exclude implied warranties and terms under the SOGA. The implied warranties that are disclaimed are usually the implied warranties of merchantability, fitness for a particular purpose and sometimes, non-infringement, warranties arising from usage of trade and course of performance.

Disclaimers of warranty are usually enforceable unless they are unconscionable, unclear or not conspicuous, or relate to fraud, personal injury or death.

ENFORCEABILITY OF EXCLUSIONS/LIMITATIONS OF LIABILITY

The law relating to damages in contracts is contained under Sections 73, 74 and 75 of the Contract Act. Theory of damages in India rests on the concept of ‘restitution’, that is, the sum of money awarded as compensation should be such as to put the injured party in the same position as he would have been, if he had not sustained the loss or damage for which he is getting damages.

Section 73 of the Contract Act prescribes that damages for breach of contract should either be such: (i) as may fairly and reasonably be considered as arising naturally, according to the usual course of things, from such breach itself or (ii) as may reasonably be supposed to have been in the contemplation of the parties at the time they made the contract, as the probable result of the breach.

Therefore, damages are not awarded for remote, indirect and consequential losses.
The concept of liquidated damages also finds its way into the Contract Act. It permits parties to determine, in advance, the amount of compensation to be paid on account of loss or damage caused by breach of contract. However, in this case as well, the discretion would lie with the court to determine the reasonable compensation that may be awarded for the breach, and if the amount mentioned in the contract is either unconscionable or disproportionate to the value of the performance promised, or consideration paid, the sum fixed would be deemed to be a penalty, which is not enforceable under Indian law. Also, the sum prescribed under contract, acts as a cap on the amount of damages that may be awarded, such that even where the reasonable damages is in fact greater than the sum prescribed under the contract, the court would only limit the damages to the amount mentioned in the contract.

**INDEMNIFICATION**

The Contract Act recognizes indemnity as a contract by which one party promises to save the other from loss caused to him by the conduct of the promisor himself, or by the conduct of any other person.

However, the Indian Courts have held that an express indemnity clause may not be necessary in face of implied rights to indemnity already existing under Indian laws.

The promisee in a contract of indemnity, acting within the scope of his authority, is entitled to recover from the promisor:

(i) all damages which he may be compelled to pay in any suit in respect of any matter to which the promise to indemnify applies;

(ii) all costs which he may be compelled to pay in any such suit; and

(iii) all sums which he may have paid under the terms of any compromise of any such suit.
INDONESIA

INTELLECTUAL PROPERTY FRAMEWORK

The intellectual property framework consists of the following key laws: Law Number 19 of 2002 on Copyright; Law Number 14 of 2001 on Patents; Law Number 15 of 2001 on Trademarks; Law Number 30 of 2000 on Trade Secret; Law Number 31 of 2000 on Industrial Design; Law Number 32 of 2000 on Layout-Design of Integrated Circuits; and Law Number 29 of 2000 on Plant Variety Protection. The government body responsible for the administration and registration of intellectual property rights in Indonesia is the Directorate General of Intellectual Property Rights under the Ministry of Law and Human Rights of the Republic of Indonesia.

COMMERCIAL CONTRACT FRAMEWORK

Most of the law on contracts is contained in Book III of the Indonesian Civil Code.

RECOGNIZED INTELLECTUAL PROPERTY RIGHTS

COPYRIGHTS

NATURE OF RIGHT
The creator or a copyright owner has the exclusive right to publish or reproduce the work subject to the copyright, and to grant permission for third parties to publish or reproduce that work.

LEGAL FRAMEWORK
Copyrights are governed by Law Number 19 of 2002 on Copyright. Indonesia became signatory to the Berne Convention in 1997.

DURATION OF RIGHT
The copyright on written works, choreographic works, forms of art, music and architecture, spoken addresses, educational and scientific visual aids, maps and translations are valid for the life of the author plus 50 years after the author’s death.

The copyright on computer programs, cinematic and photographic works, databases and adaptations are valid for 50 years after the date of first publication.

The copyright on performances are valid for 50 years after the work is performed or fixed in audio or audiovisual media.

The copyright on broadcasts is valid for 20 years after the work is first broadcast.

The copyright on sound recordings is valid for 50 years after the sound is recorded.
OWNERSHIP/LICENSES
A copyright owner has the right to give a license to a third party based on a licensing agreement to publish or reproduce the work subject to the copyright, and to grant permission for third parties to publish or reproduce that work.

REMEDIES FOR INFRINGEMENT
Compensation, injunction or a combination of the two may be ordered by the Commercial Court as remedies for infringement. Criminal sanctions may also apply for intentional breach of copyright.

MASK WORKS
Indonesian law does not recognize mask works. Similar protection may be found in Law Number 32 of 2000 on Layout-Designs of Integrated Circuits.

PATENTS

NATURE OF RIGHT
A patent is a government license that confers on an inventor the sole right to exclude others from exploiting an invention. Patents may be granted for inventions that are new, involve inventive steps and can be applied to industry. An inventor may be conferred either a patent (Paten) or a simple patent (Paten Sederhana) depending on the nature of the invention.

LEGAL FRAMEWORK
Law Number 14 of 2001 on Patents is the governing statute for patents. Indonesia became party to the Patent Cooperation Treaty in 1997 and became party to the Paris Convention in 1950.

DURATION OF RIGHT
A patent is granted for 20 years from the date of filing and cannot be extended. A simple patent is granted for ten years from the date of filing and cannot be extended.

OWNERSHIP/LICENSES
A patent holder may grant a license to a third party to use the owner’s patent under a license agreement. To date, the implementing government regulation concerning patent license recordation has not yet been issued.

REMEDIES FOR INFRINGEMENT
Compensation, injunction or a combination of the two may be ordered by the Commercial Court as remedies for infringement.

TRADEMARKS

NATURE OF RIGHT
A trademark is a government license that confers on the owner the exclusive right to use a certain registered sign that distinguishes traded goods or services from other goods or services. Indonesia adopts the “first to file” system.
LEGAL FRAMEWORK
Law Number 15 of 2001 on Trademarks is the governing statute on trademarks. Indonesia became a signatory to the Trademark Law Treaty in 1997.

DURATION OF RIGHT
Trademark registrations remain in effect for ten years and can be renewed every ten years for another ten-year term.

OWNERSHIP/LICENSES
The owner of the trademark may grant a license permitting a third party to use the mark under a license agreement. While the law stipulates that all licenses granted by the owner of the trademark must be recorded in the General Register of Marks and published in the Official Gazette of Marks, the implementing presidential decree concerning the recordation of a trademark license agreement has not yet been issued.

REMEDIES FOR INFRINGEMENT
Compensation, injunction or a combination of the two may be ordered by the Commercial Court as remedies for infringement.

TRADE SECRET

NATURE OF RIGHT
The owner of a trade secret is entitled to the exclusive use of the trade secret and may prohibit third parties from using or disclosing the trade secret for commercial purposes. A trade secret is information that is (i) unknown to the public; (ii) is in the field of technology or business; (iii) has economic value due to its role in commerce; and (iv) is kept confidential by the owner.

LEGAL FRAMEWORK
Law Number 30 of 2000 on Trade Secret is the governing statute for trade secrets in Indonesia.

DURATION OF RIGHT
Information qualifies as a trade secret as long as (i) the information remains confidential; (ii) the information has economic value; and (iii) the owner takes necessary and appropriate efforts to maintain the information’s confidentiality.

OWNERSHIP/LICENSES
The owner of the trade secret may grant a license permitting another to use the trade secret and prohibit third parties from using or disclosing the trade secret for commercial purposes under a license agreement. To date, the implementing presidential decree concerning trade secret license agreement recordation has not yet been issued.

REMEDIES FOR INFRINGEMENT
Compensation, injunction or a combination of the two may be ordered by the Commercial Court as remedies for infringement.
INDUSTRIAL DESIGN

NATURE OF RIGHT
The owner of an industrial design has the exclusive right to exploit the industrial design and to grant permission for third parties to exploit the industrial design.

LEGAL FRAMEWORK
Law Number 31 of 2000 on Industrial Design is the governing statute.

DURATION OF RIGHT
A right to an industrial design is valid for ten years from the date of filing.

OWNERSHIP/LICENSES
The owner of an industrial design may grant a license permitting a third party to exploit the industrial design, and to grant permission for third parties to exploit the industrial design under a license agreement. To date, the implementing presidential decree concerning industrial design license agreement recordation has not yet been issued.

REMEDIES FOR INFRINGEMENT
Compensation, injunction or a combination of the two may be ordered by the Commercial Court as remedies for infringement.

LAYOUT DESIGN OF INTEGRATED CIRCUITS

NATURE OF RIGHT
A right to layout-design of integrated circuits is a government license that confers on a designer the sole right to exploit, and exclude others from exploiting, a layout-design integrated circuit.

LEGAL FRAMEWORK
Law Number 32 of 2000 on Layout-Design of Integrated Circuits is the governing statute.

DURATION OF RIGHT
A right to layout-design of integrated circuits is valid for ten years from the first commercial exploitation or the date of filing.

OWNERSHIP/LICENSES
The owner of a layout-design of integrated circuits has the right to give a license to a third party based on a licensing agreement to exploit, and exclude others from exploiting, a layout-design integrated circuit under a license agreement. To date, the implementing presidential decree concerning layout-design of integrated circuits license agreement recordation has not yet been issued.

REMEDIES FOR INFRINGEMENT
Compensation, injunction, or a combination of the two may be ordered by the Commercial Court as remedies for infringement.
INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

EMPLOYEES

Law No 19 of 2002 on Copyright provides that the creator of a creation shall be the creator and copyright holder, for creations created under a employment relationship or based on an order.

Law No 14 of 2001 on Patents provide a different approach in that the party who is entitled to the patent of an invention being created in an employment relationship is the party who has given the work, unless agreed otherwise.

Therefore, in order to overcome this situation it is common practice in Indonesia to incorporate an intellectual property assignment clause in the employment contract or even a separate declaration to be signed by the employee as an attachment to the employment contract where the employee agrees to assign all intellectual property that he has created during the tenure of his employment to the employer.

CONSULTANTS/CONTRACTORS

Law No 19 of 2002 on Copyright provides that if a creation is created based on an order, then the party that created such creation shall be deemed as the creator and copyright holder unless agreed otherwise between the parties.

Law No 14 of 2001 on Patents provides that the party entitled to a patent is the inventor or a party who has received further rights from the relevant inventor.

Therefore, in a consultancy or contractor relationship, if the creator of a copyrighted work or patented invention is the consultant or the contractor, then the consultant or contractor is entitled to the copyright or patent unless agreed otherwise.

It then becomes a commercial negotiation point between the parties as to whether or not the copyright/patent/other intellectual property rights created by the consultant or contractor arising out of the relationship will vest with the consultant or contractor or whether it will vest with the client (i.e. the party instructing the work).

If the copyright or patent or other intellectual property right is intended to pass to the party instructing the work then consultancy or contractor agreement must include an assignment clause or a separate declaration to be signed by the consultant or contractor as an attachment to the agreement where the contractor or consultant agrees to assign all intellectual property that was created as a result of the consultancy or contractor agreement to the party instructing the work.

KEY COMMERCIAL CONTRACT CONSIDERATIONS

REGISTRATION OF COMMERCIAL AGREEMENTS

Generally, commercial agreements do not require registration.
**RECOGNIZED LANGUAGE OF COMMERCIAL AGREEMENTS**

Under Law Number 24 of 2009 regarding Flag, Language, State Emblem and National Anthem, any contract entered with an Indonesian government institution, Indonesian private entity or Indonesian citizen must be drafted in Indonesian language in addition to any other foreign language versions.

**COUNTRY-SPECIFIC ISSUES FOR ONLINE CONTENT**

A comprehensive cyber law is yet to be developed in Indonesia.

**ENFORCEABILITY OF ONLINE/CLICKWRAP/SHRINKWRAP TERMS**

Online transactions via an electronic contract are generally binding upon the parties. The online offeror must make available complete and true information about the terms, producer and products offered in the online transaction.

**GOVERNING LAW**

The governing law and venue for dispute resolution, as specified in a commercial contract, will generally be accepted and recognized by the Indonesian Courts under the principles of “freedom of contract.”

However, foreign court judgments are not recognized by Indonesian Courts as Indonesia is not a party to any treaty on the reciprocal enforcement of court judgments. This means that a lawsuit must be filed in Indonesia for a court judgment to be enforced in Indonesia.

If the parties intend to apply foreign law as the governing law of the contract, then the alternative is to use such foreign law but then elect foreign arbitration as the dispute resolution mechanism. Indonesia has ratified the New York Convention of 1958 and foreign arbitration may be enforced in Indonesia subject to certain conditions and for its enforcement in Indonesia, an execution order from the Central Jakarta District Court must be obtained.

District Court decisions may be appealed to the High Court and then finally to the Supreme Court, which results in litigation proceedings in Indonesia being costly and time consuming. Alternative dispute resolution procedures, such as mediation or arbitration, that are expressly agreed to in the contract are accepted and recognized by the Indonesian Courts.

**KEY COMMERCIAL CONTRACT TERMS**

**ENFORCEABILITY OF WARRANTY DISCLAIMERS**

Express warranty disclaimers are recognized and generally respected.

**ENFORCEABILITY OF EXCLUSIONS/LIMITATIONS OF LIABILITY**

Express exclusion/limitation of liability is recognized and generally respected.

**INDEMNIFICATION**

Express indemnities stated in contracts are recognized and generally respected.
IRELAND

INTELLECTUAL PROPERTY FRAMEWORK
For the most part, intellectual property rights are governed by statutes, with the exception of the protection of trade secrets (referred to as confidential information in Ireland), which is governed by contract and common law.

COMMERCIAL CONTRACT FRAMEWORK
There is no statute in Ireland that governs commercial contracts generally, although there may be statutes that are relevant to certain commercial arrangements. There may also be industry-specific regulations which may be applicable to contracts in particular industries.

The interpretation and enforceability of commercial contracts is governed by the laws of the state.

RECOGNIZED INTELLECTUAL PROPERTY RIGHTS

COPYRIGHTS

NATURE OF RIGHT
Copyright protects original works of authorship fixed in a tangible medium of expression. There are no registration requirements or formalities in Ireland in order to obtain copyright protection. The rights arise at the time that the original work of authorship is fixed in a tangible medium of expression.

Copyright owners have an exclusive right to reproduce, distribute, prepare derivative works, publically perform and publically display their works of authorship.

In order for a work to be protected under the Copyright and Related Rights Act 2000, it must be literary, dramatic, musical or artistic, an original database, a sound recording, film, broadcast, or cable program, or the typographical arrangement of a published edition.

Ireland’s copyright law, like those of many other EU countries, also protect performer’s rights, rental and lending rights, database rights and moral rights. Irish law also specifically protects copyright in computer software as a literary work.

The concept of moral rights in copyright works was introduced into Irish law by the Copyright and Related Rights Act 2000. These moral rights are: the paternity right (the right to be identified as the author of the work); the integrity right (the right to prevent mutilation, distortion or other derogatory alteration of the work); the right of protection against false attribution (the right not to have a work falsely attributed to you); and the right to privacy in photographs and film.

LEGAL FRAMEWORK
The Copyright and Related Rights Act 2000 (as amended) governs copyrights. Ireland became signatory to the Berne Convention in 1927.
DURATION OF RIGHT
Generally, the statutory period of protection for copyrighted work lasts until the expiration of 70 years after death of the author. However, the period of protection varies according to the category of work in question.

Copyright in a literary, dramatic, musical and artistic work or an original database expires 70 years after the death of the author (or in the case of a film, 70 years after the last of the following people dies: the director, author of the screenplay or dialogue, or author of the music specifically composed for use in the film).

Copyright in a sound recording expires 50 years after it is made or is made available to the public.

Copyright in a work that is computer generated expires 70 years after the work is first lawfully made available to the public.

OWNERSHIP/LICENSES
Joint ownership of copyrights is recognized. Licenses, including implied licenses, are also permitted and recognized.

REMEDIES FOR INFRINGEMENT
The following civil remedies are available for copyright infringement: (i) injunctive relief; (ii) damages; (iii) an account of profits; and (iv) order for delivery up (a remedy that requires that the infringing articles must be handed over to the intellectual property owner).

Criminal penalties may also be available for copyright infringement, which include: (i) fine and imprisonment; (ii) seizure of the infringing material; and (iii) order for destruction of the infringing copy, article or device.

There is also a provision under Irish law for the prevention of importation of the infringing copies.

MASK WORKS

NATURE OF RIGHT
Mask works protect the physical mask of semiconductor chip products along with the information that goes into creating the circuit by means of digital plot. The European Communities (Protection of Topographies of Semiconductor Products) Regulations 1988 affords protection to the design and the layout of the elements composing a semiconductor product.

LEGAL FRAMEWORK

DURATION OF RIGHT
The right commences at the time of creation and comes to an end ten years from the end of the calendar year in which it was first commercially exploited or, where it has not been commercially exploited anywhere in the world, 15 years after its first fixation or encoding.

OWNERSHIP/LICENSES
Licenses are permitted. Joint ownership is recognized.
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REMEDIES FOR INFRINGEMENT
Remedies for infringement include damages, an account of profits and injunction.

PATENTS

NATURE OF RIGHT

A patent grants the right to exclude others from making, using, selling, offering for sale or importing the claimed invention.

LEGAL FRAMEWORK

DURATION OF RIGHT
Patent protection in Ireland will (i) in the case of a full-term patent, last for a period of 20 years from date of filing; and (ii) in the case of a short-term patent, last for a period of ten years from date of filing. This is subject to the payment of renewal fees.

OWNERSHIP/LICENSES
Joint ownership is permissible. Licenses are permitted and recognized.

REMEDIES FOR INFRINGEMENT
Remedies for patent infringement can include injunctive relief, an order requiring the defendant to deliver up and destroy any product related to the alleged infringement, damages, an account of profits, a declaration that the patent is valid and has been infringed by the defendant, and a declaration of non-infringement.

TRADEMARKS

NATURE OF RIGHT
Trademarks can be a word, phrase, symbol, design, numeral, shape or a combination, which identifies and distinguishes the origin of the goods or services of one party from the goods or services of another.

LEGAL FRAMEWORK
The Trade Marks Act 1996 governs trademarks. Ireland ratified the Madrid protocol in 2001 and became a signatory to the Trademark Law Treaty in 1999. The goodwill in unregistered marks and logos can also be protected by way of the common law tort of passing off.

DURATION OF RIGHT
Registration of a trademark lasts for a period ten years. It can be renewed for further ten-year periods provided that the renewal fee is paid.

OWNERSHIP/LICENSES
Joint ownership is permitted. Licenses are permitted, both exclusive and non-exclusive.
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REMEDIES FOR INFRINGEMENT
Remedies for trademark infringement can include injunctive relief, damages, an account of profits, an order for the erasure, removal or obliteration of the offending sign from the infringing goods, materials or articles in question and an order for the delivery up of the infringing goods, materials or articles.

TRADE SECRETS

NATURE OF RIGHT
The protection of trade secrets is not governed by statute, but rather trade secrets (or confidential information, as it is referred to in Ireland) are effectively protected by the common law duty of confidence and contract law.

LEGAL FRAMEWORK
Except for the indirect protection afforded by data protection legislation, there is no statutory regulation regarding the disclosure of confidential information in Ireland.

DURATION OF RIGHT
As previously stated, there is no statute dealing with trade secrets. As such, the limitation period for suing under contract law is six years. In the case of equitable relief, cases should be brought as soon as possible and without delay as the court may exercise its discretion not to grant equitable injunctive relief in circumstances where it perceives an undue delay on the part of the plaintiff.

OWNERSHIP/LICENSES
Licenses, express or implied, are also permitted and recognized.

Joint ownership of confidential information is possible and may be recognized.

REMEDIES FOR INFRINGEMENT
Remedies for trade secret misappropriation can include an action for breach of contract, as well as an action for breach of confidence (common law).

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

EMPLOYEES
When an employee makes a discovery or creates something of value in the course of his employment, the fruits of that employment will generally be the property of the employer and not the employee unless it can be said that the discovery or product did not involve the use of the employer’s time, information (confidential or otherwise), and did not overlap with the contractual obligations or job description of the employed person.

An employer, in an effort to avoid confusion in relation to ownership, will usually seek to bolster rights contractually by seeking intellectual property assignments and waivers as appropriate.

CONSULTANTS/CONTRACTORS
Intellectual property created by a contractor/consultant does not vest automatically in the entity that commissioned the work. As such, express provisions concerning ownership and assignment and waiver of rights, as necessary, should be set out in the contract for services.
KEY COMMERCIAL CONTRACT CONSIDERATIONS

REGISTRATION OF COMMERCIAL AGREEMENTS
There is no registration requirement in Ireland.

RECOGNIZED LANGUAGE OF COMMERCIAL AGREEMENTS
Commercial contracts are typically in English, and preferably “plain English” that is consumer-friendly. This is particularly important in consumer-facing commercial agreements and terms.

COUNTRY-SPECIFIC ISSUES FOR ONLINE CONTENT
Internet service providers are afforded some degree of protection in relation to copyright infringement under Directive 2001/29/EC on the harmonization of certain aspects of copyright and related rights in the information society.

ENFORCEABILITY OF ONLINE/CLICKWRAP/SHRINKWRAP TERMS
Online terms are generally viewed as enforceable and will be upheld provided that they comply with normal principles of contract law and are placed in a reasonably conspicuous place on the website.

GOVERNING LAW
Governing law and venue for resolution of disputes specified in a commercial contract will generally be accepted and recognized by the Irish Courts.

KEY COMMERCIAL CONTRACT TERMS

ENFORCEABILITY OF WARRANTY DISCLAIMERS
Disclaimers of warranty are usually enforced unless they are unconscionable, unclear or not conspicuous. Enforceability of disclaimers against consumers may differ from jurisdiction to jurisdiction. In Ireland, a seller is not permitted to contract out of the provisions of the Sale of Goods and Supply of Services Act 1980 when dealing with consumers.

ENFORCEABILITY OF EXCLUSIONS/LIMITATIONS OF LIABILITY
Liability can be limited by contract. Those entering a contract often include a clause in the contract which seeks to exclude indirect or consequential loss. It is however important to note that these types of clauses are not a guarantee that such damage will not be included. It is for the court to decide whether something is a direct or indirect loss. As such, it is advisable that the parties, to the greatest extent possible, agree upon and expressly list the liabilities to be included or excluded. This should be inserted into the contract.

Exclusions of liability for death or personal injury are not enforceable.

Ireland, like most jurisdictions, precludes recovery of punitive (exemplary) damages for contract breaches without a separate and independent tort claim.
INDEMNIFICATION

Express indemnities stated in contracts are generally respected and recognized. In certain circumstances, implied indemnities may also be incorporated into a contract by the courts.

Indemnification provisions are generally enforceable unless they require indemnification of behavior that statutes or the courts have held to be unenforceable (such as fraud, willful injury to persons or property and any other future unlawful acts). Indemnification for past unlawful acts is enforceable.

Indemnification provisions generally have three distinct obligations: defense, indemnify (pay damages) and hold harmless (indemnifying party responsible for any other liability arising out of the claim). Indemnification is not limited to third-party claims.

Indemnity clauses in contracts fall into two categories:

(i) clauses where one party agrees to indemnify the other against liability which that other may have towards him; and

(ii) clauses in which one party to the contract agrees to indemnify the other party against liability that the other party may incur towards third parties. (In order for (ii) to be enforced, clear and unambiguous language must be used.)

A limitation on liability under indemnification provisions can be enforceable.
ISRAEL

INTELLECTUAL PROPERTY FRAMEWORK

As a general matter, intellectual property rights are statutory rights with the exception of trade secrets, which are protected under Israel’s Commercial Tort Law as a civil tort.

COMMERCIAL CONTRACT FRAMEWORK

In general, contractual engagements are regulated under the Contracts Law (General Part), 5733-1973 (the Contracts Law). The Contracts Law regulates, among other matters, the creation of a contract, the form and substance of the contract, the fulfillment of the contract and the rescission of the contract as a result of a fault arising from its creation.

Alongside the contract laws, there are several statutes that regulate specific contracts such as, those with respect to sale (including international sale of goods), agency (including with respect to a commercial agent), insurance, guarantees, assignment of rights and obligations and standard contracts.

RECOGNIZED INTELLECTUAL PROPERTY RIGHTS

COPYRIGHTS

NATURE OF RIGHT
Copyright protects authors’ economic and moral rights. According to Section 4(a) of the Copyright Act 2007 (the Copyright Act), copyright subsists in any original literary, dramatic, musical or artistic work if it is fixed in any form. Protection of moral rights is comprised of the authors’ rights for attribution and for the work not to be distorted in any unauthorized manner.

LEGAL FRAMEWORK
The Copyright Act 2007 is the governing statute for copyrights.

DURATION OF RIGHT
Section 38 of the Copyright Act sets the term at the life of the author plus 70 years after his death, subject to certain exceptions. In the case of a joint work, copyright subsists throughout the life of its longest surviving joint author plus 70 years after his death.

OWNERSHIP/LICENSES
The author of a literary, dramatic, musical or artistic work, or the producer of a sound recording, is the first owner of copyright in the work or sound recording, respectively.

Licenses can be granted by the copyright owners and by licensees authorized to grant sub-licenses. There is no need to record such licenses with any authority. An exclusive license or a transfer of copyright must be in writing but this does not apply to non-exclusive licenses.

As for moral rights, these are personal and cannot be transferred (although it is generally accepted that they can be inherited), nor do they belong to the employer in an employer/employee relationship. There is no moral right in software.
REMEDIES FOR INFRINGEMENT
An infringement of copyright or a violation of moral rights is a civil wrong. In principle, in actions regarding such rights, remedies under the law of torts apply. Remedies include injunctions, monetary awards, statutory damages and the seizure and disposal of infringing materials.

With respect to monetary awards, two main routes are available: (i) actual damages and recovery of profits gained by the infringer and (ii) statutory damages (at the claimant’s request, the court may award damages without proof of injury for each infringement, in an amount not to exceed ₪100,000 (approximately $25,000)).

In a copyright infringement action, the claimant is presumptively entitled to injunctive relief, unless the court finds grounds that justify not ordering such relief.

The remedy of declaratory judgment is available. Under the statutory provision, courts have an independent and unlimited discretion in granting declaratory relief.

MASK WORKS

NATURE OF RIGHT
The right protects designs of integrated circuits used in semiconductor chips and related electronic applications.

An integrated circuit is a product in its final or intermediate form, in which both of the following exist: (i) its elements, at least one of which is an active element, and some or all of the interconnections are integrally formed in or on a layer or layers of material and (ii) the product is intended to perform an electronic function.

The provisions of the Integrated Circuits (Protection) Law 1999, apply to an original layout-design (topography) in respect of which one of the following applies: (i) its creator, on the date of creation, is a citizen or a resident of Israel; or (ii) its creator is a person or corporation with an active factory for the creation of layout-designs (topographies) or for the manufacture of integrated circuits in Israel on the date of creation. A layout-design (topography) is defined as the three-dimensional disposition of an integrated circuit or such three-dimensional disposition prepared for the manufacture of an integrated circuit, however expressed.

LEGAL FRAMEWORK
The Integrated Circuits (Protection) Law 1999 is the governing statute.

DURATION OF RIGHT
The right has a term equal to the earlier of: (i) the end of ten years from the date on which the layout-design or an integrated circuit in which the layout-design is incorporated were first lawfully sold or distributed commercially in Israel or outside of Israel; or (ii) at the end of 15 years from the date of creation of the layout-design.
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OWNERSHIP/LICENSES
As a basic rule, the creator of the layout-design shall be the first owner of the layout-design. However, where a layout-design is created by an employee as a result of and during the term of his employment by his employer, the employer shall be the owner of the layout-design unless otherwise provided in the contract between them.

With respect to licenses, an agreement for the transfer of rights in a layout-design (topography) or for the grant of a license to use exclusive rights in a layout-design (topography) must be documented in writing.

REMEDIES FOR INFRINGEMENT
The infringement of the rights in a layout-design constitutes a tort and the Civil Wrongs Ordinance (New Version) shall apply to it, subject to the provisions of this law.

PATENTS

NATURE OF RIGHT
Protection of patents owners for the duration of the right including the following rights:

(i) in respect of an invention that is a product – any act that is one of the following: production, use, offer for sale, sale, or import for purposes of one of the aforesaid acts; and

(ii) in respect of an invention that is a process – use of the process.

A patent holder is entitled to prevent any third party from exploiting the invention for which the patent has been granted without his permission, either in the manner defined in the claims or in a similar manner.

LEGAL FRAMEWORK

DURATION OF RIGHT
Patents have a term of 20 years from application, subject to certain exceptions.

OWNERSHIP/LICENSES
As with copyright, the basic rule is that the inventor is the owner of the rights. Subject to any agreement to the contrary, where an inventor is the employee of some other person, the employer is the owner of the invention created by the employee in the course of and during the period of his service (Service Invention), although the employee may be entitled to royalties from the commercialization of any such Service Invention.

In order for a license to be binding upon third parties, it must be recorded with the Israeli Patent Office.

REMEDIES FOR INFRINGEMENT
As with copyrights, injunctive and monetary relief are available, although the likelihood of possible double recovery is low. It should be noted that no statutory damages are available for patent infringement.
TRADEMARKS

NATURE OF RIGHT
There is protection for registered trademarks and unregistered well-known trademarks. A trademark may be comprised of letters, numerals, words, devices or other signs, or combinations thereof, whether two-dimensional or three-dimensional, and is used to identify and distinguish the source of the goods or services of one party from those of others.

LEGAL FRAMEWORK
Trade Marks Ordinance (New Version) 1972 is the governing statute.

DURATION OF RIGHT
A trademark has an unlimited term of protection as long as the trademark registration is maintained or an unregistered well-known mark remains well-known.

OWNERSHIP/LICENSES
The ownership is determined by the identity of the registrant with the Israeli Trademarks Office.

For a license to be binding, it must be recorded with the Israeli Trademarks Office. Sub-licenses are not recognized by the Trade Marks Ordinance (New Version) 1972, but the Israeli Trademarks Office has indicated that sub-licenses can also be registered.

REMEDIES FOR INFRINGEMENT
Injunctive and monetary relief are available for trademark infringement. In addition, statutory damages for passing off under the Commercial Torts Law 1999 can serve as a complementary claim to trademark infringement.

TRADE SECRETS

NATURE OF RIGHT
Trade secrets are defined as any business information, which is not publicly known and which cannot readily and legally be discovered by the public, the secrecy of which grants its owner an advantage over his competitors, provided that its owner takes reasonable steps to protect its confidentiality.

LEGAL FRAMEWORK

DURATION OF RIGHT
Information can remain protected as a trade secret as long as the information remains confidential and does not enter the public domain.

OWNERSHIP/LICENSES
Usually, the owner of the information owns the trade secret; licenses can be granted and there is no need to record grant.

REMEDIES FOR INFRINGEMENT
Misappropriation of one’s trade secret is a civil tort that may entitle the plaintiff to several types of remedies, for example: injunction and monetary compensation, including statutory damages of up to ₪100,000 (approximately $25,000) without having to prove that damages were caused.
INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

EMPLOYEES
As set out above, in an employer/employee relationship, the employer is usually the owner of the right created in the course of such relationship. This holds true for Service Inventions under the Patent Law, works under the Copyright Act and layout-designs under the Integrated Circuits (Protection) Law. There are no legal provisions regarding this issue in connection with trademarks and trade secrets. Notwithstanding the foregoing, case law recognizes an obligation on the part of an employee to preserve the employer’s trade secrets as a result of the employee’s duties of good faith towards the employer.

With respect to the employee’s entitlement to royalties for “Service Inventions” (inventions created during an employee’s employment with the employer), the Patent Law provides that “if there is no agreement that prescribes whether, to what extent, and on what conditions, the employee is entitled to remuneration for a service invention, then the matter shall be decided by the Compensation and Royalties Committee established under Chapter Six.”

Despite the provisions in various laws, as detailed above, it is customary to include a general covenant in employment agreements in which the employee assigns all intellectual property rights that he may have, to the employer (expressly including any Service Inventions).

It should also be noted that in a recent interim decision, the Committee for Compensation and Royalties established under Chapter Six of the Patents Law, stated that in order for an employer to claim that an employee is not entitled to royalties for Service Inventions, it is necessary for the employee’s employment agreement to include a provision stating that the employee waives his rights to royalties under the Patent Law.

CONSULTANTS/CONTRACTORS
When a work is created pursuant to a commission, the author is the first owner of the copyright in the work, in whole or in part, unless the parties agree to the contrary, either expressly or implicitly.

The state is the first owner of a work made by or commissioned for the state, or by an employee of the state in the course of and during the period of his service.

Therefore, in agreements with consultants/contractors, one should include a covenant in which the consultant/contractor assigns all intellectual property rights that he may have to the company, as otherwise, such rights will vest with the consultant/contractor.

KEY COMMERCIAL CONTRACT CONSIDERATIONS

REGISTRATION OF COMMERCIAL AGREEMENTS
There is no general registration requirement under Israeli law in connection with commercial agreements. Nevertheless, some agreements (for example, real estate, security documents) may require filing in order to be perfected or binding vis-à-vis the relevant authorities or third parties. In addition, publicly-traded companies may be required to disclose certain material contracts.
In general, there is no requirement under Israeli law that a commercial agreement will be drafted in any specific language, to the extent that the chosen language will be understood by all parties to the agreement.

In consumer-type agreements, there is a prohibition for entering into a transaction with a consumer by exploiting the consumer’s lack of knowledge of the specific language of the transaction. Such a claim would have to be proved by the consumer according to the specific circumstances of the matter. There is a general presumption that if an individual has decided to enter into a transaction he understands its contents; however, such presumption, of course, can be rebutted.

There are no specific requirements under Israeli law for online terms, which are considered to be a contract with all its implications (conditional upon the fulfillment of all elements under law required for the creation of a contract between two or more parties).

However, online terms may be deemed to be a standard contract under Israeli law (i.e., a contract, the terms of which have been pre-determined by one party in order for them to be used in several agreements between that party and an undetermined and unspecified number of other parties). The consequence of an agreement being determined to be a standard contract by the court is that the court might strike out unfairly prejudicial terms contained within the contract.

Examples for such prejudicial terms include: (i) a condition denying or limiting a right or remedy available to the consumer under law; (ii) a condition imposing the burden of proof on a person who would not have to bear it but for that condition; (iii) a condition which, except as part of a customary arbitration agreement, denies or limits the consumer’s right to make certain pleas before judicial authorities or to take any other legal proceedings; or (iv) a provision which relieves the supplier, fully or partially, of a liability which the supplier would have to bear under law if such condition was not included in the contract.

Online terms are generally viewed as enforceable under Israeli law, subject to aspects involving there being a standard contract, as further discussed above.

Nevertheless, when entering into an agreement that is reviewed and signed online, companies should ensure that the signer has the opportunity to review the terms of the agreement beforehand and that the signer provides his consent to the agreement (such consent should be retrievable for evidentiary purposes).

In general, governing law provisions, including foreign governing law provision, specified in a commercial contract will be accepted and recognized by Israeli Courts. However, in certain circumstances, the Israeli Courts might be prepared to apply Israeli law such as, when immediate temporary relief is required, with regard to civil legal procedures or where the agreement is deemed to be a Standard Contract (as further discussed above).
KEY COMMERCIAL CONTRACT TERMS

ENFORCEABILITY OF WARRANTY DISCLAIMERS
In general, under Israeli law, parties are free to enter into an agreement which sets out exclusion of warranties or implied terms, subject to such exclusion not being an unfairly prejudicial term contained within a Standard Contract. With respect to certain specific goods, Israeli law sets out a mandatory warranty to be granted to a consumer, such warranty cannot be stipulated except where such stipulation was made for the benefit of the consumer.

ENFORCEABILITY OF EXCLUSIONS/LIMITATIONS OF LIABILITY
Under Israeli law, parties are free to enter into an agreement which sets out limitation of liability of one party (such exemption from liability will only bind the parties which agreed to it), except with respect to bodily injury or death which cannot be contractually stipulated or in exceptional cases where the court might intervene and cancel such a provision if it contravenes public policy or if it is considered to be morally or socially undesirable. It should be noted that in practice, parties usually limit liability to direct damages only or restrict the maximum amount of liability.

INDEMNIFICATION
Under Israeli law, parties are free to enter into an agreement where one party will indemnify the other party for any losses or damages suffered by the indemnitee arising out of or as a result of specified events. In practice, indemnity agreements usually include indemnity carve-outs and exclusions (such as, limited duration and scope of liabilities triggering the obligation to indemnify, limitation in indemnity amount).

Indemnification for criminal fines are not enforceable in Israel as they are usually regarded as contravening public policy.
ITALY

INTELLECTUAL PROPERTY FRAMEWORK

As a general matter, intellectual property rights are governed by the Italian Civil Code, the Legislative Decree No. 30/2005 (the Industrial Property Code) and ad hoc legislation.

COMMERCIAL CONTRACT FRAMEWORK

There are a number of laws that may apply to commercial contracts, depending on the type of contract and the industry involved. However, general contract laws are contained in the Italian Civil Code.

With regard to agreements between businesses and consumers, the Legislative Decree No. 205/2006 (the Consumer Code) is also applicable.

With regard to E-Commerce, Legislative Decree No. 70/2003 (implementing the EU Directive 2000/31/EU) should also be taken into account.

RECOGNIZED INTELLECTUAL PROPERTY RIGHTS

COPYRIGHTS

NATURE OF RIGHT
Copyright protection is available to works having a creative character and pertaining to literature, music, graphic arts, architecture, theatre and cinematography, whatever their mode or form of expression.

Copyright owners have the exclusive right to reproduce, perform publicly by any distance medium, distribute, transform and lease and loan the work.

In addition to the above, the copyright owner also has moral rights such as the right to claim authorship of his work and in case of an anonymous work, the right to reveal his identity, to object to any distortion, mutilation or any other modification of his work that could be prejudicial to his honor or reputation and to withdraw the literary work from commerce for serious moral reasons.

LEGAL FRAMEWORK
Law No. 633/1941 (the Italian Copyright Law) is the statute governing copyrights.

Also applicable is the AGCOM (Autorità per le garanzie nelle comunicazioni, the Italian Communication Authority) Regulation on Copyright Protection on Electronic Communication Networks.

Italy is also party to various international copyright treaties and conventions such as the Universal Copyright Convention, Convention for the Protection of Producers of Phonograms Against Unauthorized Duplication of their Phonograms, the Berne Convention, the TRIPS Agreement, WIPO Performances and Phonograms Treaty, and WIPO Copyright Treaty.
DURATION OF RIGHT
Copyright protection lasts for the life of the author plus an additional 70 years, starting from the first calendar year after the death of the author.

In case of joint works and in case of dramatic-musical and choreographic works and pantomimes, the duration of the economic rights is determined in relation to the life of the last-surviving co-author. In case of cinematographic works, the term is calculated taking into consideration the last-surviving person among the director, the screenplay writers and the author of the music if it is specifically created for the film. In case of anonymous or pseudonymous works, the duration is 70 years from publication, unless the author reveals his identity prior to expiration of such term.

In case of collective works, where the various parts of the work are published at different times, the duration of economic rights for each part occurs from the time of its publication.

Unless differently specified, with regard to neighboring rights, the period of protection is 50 years and occurs:

(i) from the date of fixation for phonographic producers and for producers of cinematographic or other audiovisual works;

(ii) from the date of first broadcast for broadcasting entities; and

(iii) from the date of the first public performance for artists and performers.

This protection has been extended to 70 years by Directive 2011/77/EU of September 27, 2011, but as of this printing, this directive has not yet been implemented in Italy.

Performers’ rights last for 50 years from the time of performance or, if a fixation of the performance is published or communicated to the public during that time, from the first publication or communication to the public, whichever is earlier.

Moral rights never expire. Upon the death of the author, the rights may be enforced by the author’s heir(s). Furthermore, moral rights cannot be waived.

OWNERSHIP/LICENSES
Joint ownership of copyright is recognized with regards to joint works and collective works.

Transfer of the ownership is allowed and must be in writing. In general, the transfer of one or more copies of a copyrighted work does not imply the transfer of the copyright, unless differently agreed. It is considered, however, that the transfer of a mold or of any other means capable of reproducing the work implies the transfer of the copyright over the work, unless differently agreed.

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2 Pursuant to Section 10 of the Italian Copyright Law a “joint work” is a work created as a result of the indistinguishable and non-severable contribution of different persons.

3 Pursuant to Section 3 of the Italian Copyright Law a collective work is a work created with the contribution of different authors when each contribution can easily be distinguished and severed (by way of example encyclopedias, dictionaries, anthologies, newspapers and magazines).
REMEDIES FOR INFRINGEMENT
Any person having reason to fear for the infringement of rights belonging to him under the Italian Copyright Law, or who seeks to prevent the continuation or repetition of an infringement which has already occurred, may commence legal proceedings to ensure that his right is recognized and the infringement is put to an end. In such circumstances, the right holder will be entitled to remedies, such as injunction and damages.

A popular means of protection is the so-called “search order,” which allows copyright owner to collect evidence of the infringement through a raid in the presence of a bailiff and, where necessary, of an expert appointed by the court. In order to stop the infringement, the court may also order the seizure of the works or the products and of all matters constituting an infringement of the copyright.

Criminal penalties may also apply under certain circumstances.

MASK WORKS

NATURE OF RIGHT
The topography of a semiconductor product is a series of fixed or encoded correlated designs, representing the three-dimensional pattern of the layers that a semiconductor product is made up of and in which series each image, entirely or partly, reproduces a surface of the semiconductor product at any stage of the manufacture thereof.

A semiconductor product is a finished or intermediate product containing one or more layers of conductor, insulating or semiconductor material arranged in a particular three-dimensional pattern and intended to perform, whether exclusively or not, electronic circuitry functions.

Mask work owners have the exclusive right to totally or partly reproduce the topography in any method or shape and commercially exploit the mask work, in particular, keeping or distributing for commercial purposes or import a topography or a semiconductor product in which the topography is fixed.

LEGAL FRAMEWORK
Sections 87 to 96 of the Industrial Property Code govern semiconductor topography protection.

DURATION OF RIGHT
The protection is granted for ten years starting either from the filing date of the application or from the date when the semiconductor containing the topography is put on sale for the first time in any part of the world.

OWNERSHIP/LICENSES
The owner of the mask work is the author that has expressed a creative intellectual effort resulting in a topography that is not common or familiar in the industry of semiconductor products, therefore constituting an object of exclusive rights.

REMEDIES FOR INFRINGEMENT
Any person having reason to fear for the infringement of rights belonging to him, or who seeks to prevent the continuation or repetition of an infringement which has already occurred, may commence legal proceedings to ensure that his right is recognized and the infringement is put to an end. In such circumstances, the right holder will be entitled to remedies, such as injunction and damages.
PATENTS

NATURE OF RIGHT
Patent protection is available to inventions that are deemed to be new, not obvious and suitable for application in the industrial field.

From the issuance date of the patent, the patent owner has the exclusive right to forbid third parties from producing, using, trading in, selling or importing the product (should the invention be a product) or applying the method, or using, trading in, selling or importing the product that is directly obtained from the method (should the invention be a method).

LEGAL FRAMEWORK
The Industrial Property Code is the statute governing patents in Italy.

Italy is also party to the main international patent treaties and conventions.

DURATION OF RIGHT
Patent protection lasts for 20 years from filing the application, based on a “first to file” principle.

OWNERSHIP/LICENSES
Ownership of a patent may be transferred to third parties, as well as assigned by means of a license, authorizing the exploitation of the patent within the limits determined by the parties (such as exclusivity and sublicensing).

REMEDIES FOR INFRINGEMENT
Any person having reason to fear for the infringement of rights belonging to him under the Italian Patent Law, or who seeks to prevent the continuation or repetition of an infringement which has already occurred, may commence legal proceedings to ensure that his right is recognized and the infringement is put to an end. In such circumstances, the right holder will be entitled to remedies, such as injunction and damages.

A popular means of protection is the so-called “search order,” which allows patent owner to collect evidence of the infringement through a raid in the presence of a bailiff and, where necessary, of an expert appointed by the court. In order to stop the infringement, the court may also order the seizure of the works or the products and of all matters constituting an infringement of the patent.

Criminal penalties may also apply under certain circumstances.

TRADEMARKS

NATURE OF RIGHT
Trademark protection is available to signs that can be represented graphically, provided that they are capable of distinguishing the goods or services of a company from those of other companies. In particular, it is possible to register words (including personal names), drawings, letters, numbers, sounds, forms of the product or its packaging, the combinations or shades of color.

The trademark owner has the right to forbid third parties from: (i) using a sign identical to the trademark filed for products or services identical to those for which the mark was registered, (ii) using a sign identical or similar to the registered trademark for identical or similar products or services if the identity or similarity between the signs, and the identity or similarity between the
products or services may lead to a risk of confusion for the public, which may consist in a risk of association between the signs, and (iii) using a sign identical or similar to the registered trademark for different products or services if the use of the sign without justified reason allows the user to obtain an undue advantage from the distinctive character or fame of the trademark or causes prejudice thereof.

The unregistered trademark enjoys a lesser juridical protection. In fact, in order to get protection on a national basis, the trademark shall be used in a way which creates the notoriety of the same on a general basis. If the mark is known only locally, he will enjoy local protection, and may co-exist with a following registration.

**LEGAL FRAMEWORK**
Sections 2569 to 2574 of the Italian Civil Code and the Industrial Property Code govern the protection of trademarks.

Italy is also party of the main community and international trademark treaties and conventions, such as the Paris Convention, Madrid Agreement and Protocol, Nice Agreement, the TRIPS Agreement and Regulation No. 40/94/UE.

**DURATION OF RIGHT**
Trademark registration lasts ten years from the filing date (unless waived by the owner) and it can be renewed, within the date of expiration, an unlimited number of times.

**OWNERSHIP/LICENSES**
Anyone, being a natural person or a legal entity, who uses or proposes to use a trademark for products and services, can obtain the registration of a trademark (non-use of the trademark within five years from the date of registration can cause the trademark to be invalidated, however the lapse of time must be proven by the interested party).

The trademark can be transferred without the company or without a branch thereof, provided that no deception is caused to the consumer or the object of a license (including non-exclusive licenses) for all or part of the products or services for which it was registered.

**REMEDIES FOR INFRINGEMENT**
Any person having reason to fear for the infringement of rights belonging to him, or who seeks to prevent the continuation or repetition of an infringement which has already occurred, may commence legal proceedings to ensure that his right is recognized and the infringement is put to an end. In such circumstances, the right holder will be entitled to remedies, such as injunction and damages.

Criminal penalties may also apply under certain circumstances.

**TRADE SECRETS**

**NATURE OF RIGHT**
Trade secrets are defined as company information and technical-industrial experiences subject to the legitimate control of the owner if said information:

(i) is secret (in the sense that it is not, in its entirety or in the precise configuration and combination of the elements thereof, generally known or easily accessible to those skilled in the arts);
(ii) has an economic value due to its secrecy; and

(iii) is subject to reasonable measures to maintain its secrecy.

In addition to the above data relating to experiments or other secret data may also be protected if processing them would entail a considerable work and the disclosure of the data is subject to an authorization for marketing chemical, pharmaceutical or agricultural products with new chemical substances.

The disclosure or unlawful use of trade secrets or confidential information is a breach of the principles of professional correctness.

LEGAL FRAMEWORK
Section 2598 of the Italian Civil Code and Sections 98 and 99 of the Industrial Property Code govern the protection of trade secrets.

DURATION OF RIGHT
The duration of protection is potentially perpetual if the owner is able to keep the information secret.

OWNERSHIP/LICENSES
The holder of the trade secret is the owner of such secret (joint ownership is possible).

REMEDIES FOR INFRINGEMENT
Any person having reason to fear for the infringement of rights belonging to him, or who seeks to prevent the continuation or repetition of an infringement which has already occurred, may commence legal proceedings to ensure that his right is recognized and the infringement is put to an end. In such circumstances, the right holder will be entitled to remedies, such as injunction and compensation for damages.

Criminal penalties may also apply under certain circumstances.

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

EMPLOYEES
Copyright: In case of a work commissioned by third parties or works created by an employee in the performance of his tasks or upon instructions given by the employer, the employer or the commissioner is to be considered the assignee of the economic rights in a copyrighted work unless the parties have expressly agreed otherwise in writing. However, the author retains moral rights on the work of art, as said rights are non-transferable and inalienable.

Patent: When an industrial invention is made during the performance or fulfillment of a contract, whereby the inventive activity is deemed to be the objective and the employee is paid to invent, the employer retains the patent rights arising from the invention, and the inventor (which is not entitled to any bonus or compensation with regard to the invention) retains the right to be recognized as such.

When an industrial invention is made during the performance or fulfillment of a contract, which is not subject to compensation for inventive activity, the employer holds the patent rights arising from the invention and the inventor is entitled to a fair bonus and holds the right to be recognized as inventor.
If none of the above applies, but the invention is made in the field of activities of the entity where the inventor is employed, the employer retains the right of pre-emption with regard to the use or purchase of the invention (to be exercised within three months from the granting of the patent).

**CONSULTANTS/CONTRACTORS**
Please see the “Employees” section above.

**KEY COMMERCIAL CONTRACT CONSIDERATIONS**

**REGISTRATION OF COMMERCIAL AGREEMENTS**
There is no general registration requirement with regard to commercial agreements, though some kind of contracts or the use of certain contracts, for instance, in a court proceeding, may require a prior registration.

**RECOGNIZED LANGUAGE OF COMMERCIAL AGREEMENTS**
In particular, with regard to business-to-consumer agreements for the sale of goods and standard terms and conditions, Italian language is mandatory.

**ITALY-SPECIFIC ISSUES FOR ONLINE TERMS**
Pursuant to AGCOM Regulation, the rights owner of digital works published on web pages and programs aired (via linear or non-linear services) without consent can file a complaint with the Authority. Further to the procedure in front of the Authority, if the website is hosted on a server located in Italy, AGCOM can order the publisher and the hosting service provider to remove the work published illegally or, in case of massive violations, disable access to the website. If the website is hosted on a server located outside of Italy, AGCOM can order the mere conduit service provider to disable access to the website.

**ENFORCEABILITY OF ONLINE/CHECKWRAP/SHRINKWRAP TERMS**
When a contract is drafted by one party and the other party can merely accept it (i.e. the contract is not negotiated as in the case of T and Cs), some provisions must be specifically approved in writing by the other party in order to be enforceable against the party that has not drafted the agreement (i.e. the user). Such provisions are those relating to limitation of liability, time limits, exclusivity, withdrawal rights and choice of venue.

For contracts approved online, it is a common practice to contemplate a second check box to specifically approve the relevant clauses. However, such second tick is not deemed sufficient and consequently there is the risk that users challenge the enforceability of the provisions mentioned above while the other terms of the contract will remain valid.

T and Cs should be made available to the user in a downloadable/printable format. Pursuant to a recent decision of the European Court of Justice (Case C-49/11), at the completion of a registration process in a website, the service provider should attach a copy of the T and Cs in .pdf in the welcome email sent to the user (if any).

**GOVERNING LAW**
With regard to B2B contracts, governing law can be freely specified by the parties.

With regard to B2C contracts some of the Italian provisions with regard to consumers shall be implemented irrespective of the governing law of the agreement.
KEY COMMERCIAL CONTRACT TERMS

ENFORCEABILITY OF WARRANTY DISCLAIMERS

In B2B agreements for the sale of goods, a “legal guarantee” shall be provided by the vendor in case of defective products (Section 1490 of the Italian Civil Code). In particular, the company shall warrant that the sold product is free of defects which make the product not fit for its purpose or which greatly diminish its value. Such provision may be contractually disregarded by the parties (or by the vendor) unless in the event of willful misconduct or gross negligence of the vendor.

In B2C agreements for the sale of goods, a “legal guarantee” shall be provided and this provision may not be contractually disregarded.

ENFORCEABILITY OF EXCLUSIONS/LIMITATIONS OF LIABILITY

Pursuant to Section 1229 of the Italian Civil Code no limitation of liability can be made to the effect of excluding liability for gross negligence or fraud. Any contrary provision is void (although the rest of the agreement remains valid).

In B2C agreements for the sale of goods, any limitation or exclusion of liability regarding the responsibility of the seller with regard to defective products is void.

INDEMNIFICATION

Under the general provisions of the Italian Civil Code, only the damages that are the immediate and direct result of the non-performance or delay in the performance of the contractual obligation (Section 1223 of the Italian Civil Code) can be claimed by the parties.
JAPAN

INTELLECTUAL PROPERTY FRAMEWORK

Intellectual property rights including patent right, utility model right, design right, copyright, trademark right and trade secrets are specified and protected under each relevant intellectual property law.

COMMERCIAL CONTRACT FRAMEWORK

Contracts including commercial contracts are interpreted and enforced in accordance with the Civil Code (Act No. 89 of 1896), any other related laws, specified rules and regulations such as the Commercial Code (Act No. 48 of 1899) and court precedents.

RECOGNIZED INTELLECTUAL PROPERTY RIGHTS

COPYRIGHTS

NATURE OF RIGHT
Works created by an author are protected subject to certain exceptions specified in the Copyright Act, such as private use, citations and school text book use. “Works” means a production in which thoughts or sentiments are creatively expressed and which falls within the literary, academic, artistic or musical domain.

No fixation to a tangible medium or registration is required.

The copyright arises and is protected from the moment of creation.

Copyright owners have the exclusive right to reproduce, publicly perform, screen, transmit, recite, exhibit or distribute, transfer, lend reproductions, translate or adapt the work.

Moral rights of an author and neighboring rights are recognized under the Copyright Act.

LEGAL FRAMEWORK

The Copyright Act (Act No. 48 of 1970) (the Copyright Act) governs copyrights.

Japan became signatory to Berne Convention in 1899.

DURATION OF RIGHT
Copyright protection lasts for the life of the author plus an additional 50 years. Some special calculations are applicable for copyrightable works made during the Second World War.

For an anonymous work or a pseudonymous work, the copyright lasts for a term of 50 years from its first publication, or a term of 50 years from the death of the author if the author is known, whichever expires first.
For a work owned by an entity (e.g., work made for hire), the copyright lasts for a term of 50 years from the work’s first publication. If it is not made public within the 50 year term, the copyright lasts for 50 years after the creation.

If a work is a movie, its copyright endures for a term of 70 years from its first publication. If the movie is not made public, the copyright lasts for 70 years after the creation of the movie.

**OWNERSHIP/LICENSES**

Exercise of a jointly owned copyright requires consent from the other joint owner(s) of the copyright. However, each joint owner cannot withhold consent without reasonable grounds.

Exclusive and non-exclusive licenses, as well as transfer of copyright are recognized. Moral rights are not transferrable.

**REMEDIES FOR INFRINGEMENT**

No registration is required to seek remedies for infringement.

Monetary damages can be compensated. No statutory damages are provided under the Copyright Act and punitive damages are not available under Japanese law.

Injunctive relief, including seeking/preventing importation of infringing goods, is available as a remedy.

For moral rights, measures to correct and restore the honor and reputation of the author or performer are available (e.g., publishing an apology in a newspaper).

Each joint owner can seek a remedy without the other owner’s consent.

Criminal penalties are possible for infringement of copyright.

**MASK WORKS**

**NATURE OF RIGHT**

The layout-design of semiconductor integrated circuits is protected.

A semiconductor integrated circuit means a product having transistors or other circuitry elements inseparably formed on the surface of a semiconductor material or an insulating material, or within a semiconductor material and designed to perform electronic circuitry functions.

Layout-design means a layout of circuitry elements in semiconductor integrated circuits and the lead wires connecting such elements.

Registration with the Software Information Center is required.

Owners have the exclusive right to manufacture, transfer, lease, display or import a semiconductor in which mask work is embodied for business.

Owners cannot assert its right against the same mask work that was independently developed.

**LEGAL FRAMEWORK**

The Act on the Circuit Layout of a Semiconductor Integrated Circuits (Act No. 43 of 1985) governs the protection of layout-designs of semiconductors.
DURATION OF RIGHT
The duration of protection is ten years from registration and no renewal or extension of duration is provided. The layout-design must be registered within two years of first commercial exploitation.

OWNERSHIP/LICENSES
If two or more persons jointly develop a mask work, all of them must jointly apply for registration.

Exclusive and non-exclusive licenses and transfers of mask works are recognized.

Joint ownership is permissible. Exclusive or non-exclusive licensing of the mask work, transferring or establishing pledge on the share of the mask work requires consent from all joint owners of the right.

REMEDIES FOR INFRINGEMENT
Monetary damages can be compensated. No statutory damages are provided and punitive damages are not available under Japanese law.

Injunctive relief, including seeking/preventing importation of infringing goods, is available as a remedy.

Each joint owner can seek a remedy without the other owner’s consent.

Criminal penalties are possible for infringement of mask works.

PATENTS

NATURE OF RIGHT
Japanese law protects inventions (the highly advanced technical ideas utilizing the laws of nature), utility models (devices relating to the shape or structure of an article or combination of articles), and designs (shapes, patterns or colors, or any combination of these of an article), and plant varieties.

A patent holder has the exclusive right to produce, use, sell, lease, offer for sale or lease, or import the patented invention for business.

For utility and design patents and utility model rights, registration with the Japan Patent Office is required.

LEGAL FRAMEWORK


Utility models are protected by the Utility Model Act (Act No. 123 of 1959).

Designs are protected by the Design Act (Act No. 125 of 1959).

DURATION OF RIGHT
For invention patents, the duration of protection is 20 years from filing date of application and up to five years extension, subject to certain requirements.

For utility model patents, the duration of protection is ten years from application. No extension is available.

For design patents, the duration of protection is 20 years from registration. No extension is available.
OWNERSHIP/LICENSES
Exclusive and non-exclusive licenses and transfers of patent rights are recognized.

Joint ownership is permissible. Exclusive or non-exclusive licensing of the patent right, transferring or establishing pledge on the share of the patent right requires consent from all joint owners of the patent right.

REMEDIES FOR INFRINGEMENT
Monetary damages can be levied. No statutory damages are provided and punitive damages are not available under Japanese law.

Injunctive relief, including seeking/preventing importation of infringing goods, is available as a remedy.

Measures are available to restore the business reputation of the patent holder and exclusive licensee (e.g., publishing an apology in a newspaper).

Each joint owner can seek a remedy for infringement without the other owner’s consent.

Criminal penalties are possible for patent infringement.

TRADEMARKS

NATURE OF RIGHT
A trademark means any letter(s), figure(s), sign(s) or three-dimensional shape(s), or any combination of these, or any combination of these with colors which identifies and distinguishes the source of the goods or services from those of others.

A trademark holder has the exclusive right to use the trademark for the product or service.

Registration with the Japan Patent Office is required.

LEGAL FRAMEWORK
The Trademark Act (Act No. 127 of 1959) governs trademarks.


Japan joined the Trademark Law Treaty in 1997.

DURATION OF RIGHT
The duration of protection is ten years from registration and renewable every ten years.

OWNERSHIP/LICENSES
Exclusive and non-exclusive licenses and transfers of trademark are recognized.

Joint ownership is permissible. Exclusive or non-exclusive licensing of the trademark, transferring or establishing pledge on the share of the trademark requires consent from all joint owners of the trademark.
GUIDE TO GOING GLOBAL · INTELLECTUAL PROPERTY AND TECHNOLOGY

REMEDIES FOR INFRINGEMENT
Monetary damages can be levied. No statutory damages are provided and punitive damages are not available under Japanese law.

Injunctive relief, including seeking/preventing importation of infringing goods, is available as a remedy.

Measures are available to restore the business reputation of the trademark holder and exclusive licensee (e.g., publishing an apology in a newspaper).

Each joint owner can seek a remedy for infringement without the other owner’s consent.

Criminal penalties are possible for trademark infringement.

TRADE SECRETS

NATURE OF RIGHT
Illicit obtainment of trade secrets and use and disclosure of trade secrets for unjustified purposes are regulated under the Unfair Competition Prevention Act (UCPA)(Act No. 47 of 1993).

The UCPA defines trade secrets under a three-prong test:

(i) Information is “technical or business information useful for business activities such as manufacturing or marketing methods;”

(ii) Information is “managed as a secret;” and

(iii) Information is “not publicly known.”

LEGAL FRAMEWORK
The UCPA is the main governing law regarding trade secrets. The UCPA does not require any registration or filing of trade secrets to protect them.

DURATION OF RIGHT
There is no specific duration of right or protection period of time under the UCPA. As long as a trade secret falls under a trade secret defined under the UCPA, it will be protected as such by the UCPA.

OWNERSHIP/LICENSES
Joint ownership is possible. Trade secret licenses are enforceable. The UCPA is silent on joint ownership of and licensing of trade secrets.

REMEDIES FOR INFRINGEMENT
Monetary damages are presumed as profit earned by an infringer or as a reasonable licensing fee. If it is difficult to establish the damage amount, the court is allowed to award reasonable compensatory damages. No statutory damages are provided.

Injunctive relief, including seeking/preventing importation of infringing goods, is available as a remedy.

Each joint owner can seek a remedy without the other owner’s consent.

Criminal penalties are available for theft and use of trade secrets.
INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

EMPLOYEES
Most employment contracts provide language for intellectual property assignment from the employee to the employer. For patent assignments, employees must be reasonably compensated statutorily by an employer for the assignment and grant of an exclusive license. The law does not provide the compensation figures but some factors to be taken into consideration are provided and the amount must be reasonable.

Even if an employer did not provide assignment of intellectual property in the work rules or employment agreement, statutes give an employer a right that is similar to a shop right within the scope of a non-exclusive license. This only applies to patents.

The “work for hire” doctrine is applicable to copyrights and mask works. For copyrights, a work must be made public under the name of an employer except for computer program related copyrights.

CONSULTANTS/CONTRACTORS
In practice, consultants and contractors are often required to sign written agreements to assign all intellectual property related to his work for the company. Some courts have applied the concepts mentioned in “Employees” section above to consultants and contractors given the fact that relationship was an employment relationship due to misclassification (i.e., disguised service/independent contractor agreement). It is recommended that written contracts expressly assign all intellectual property to the company retaining the consultant/contractor.

KEY COMMERCIAL CONTRACT CONSIDERATIONS

REGISTRATION OF COMMERCIAL AGREEMENTS
There is no general registration requirement for commercial contracts. Material contracts of publicly-traded companies may require limited disclosure.

Patent license or trademark license for statutory exclusivity requires registration to be enforceable. Registration of licenses for trademarks is possible in order to put potential buyers of the trademarks on notice of the license. Such registration is, however, not required.

Registration of copyright licenses is not available in Japan, although transfer or assignment of copyrights can be registered to assert such assigned rights against third parties.

RECOGNIZED LANGUAGE OF COMMERCIAL AGREEMENTS
Japanese language is used for consumer-facing commercial agreements though it is not mandatory for a contract to be enforceable. In business transactions, English agreements are not common but they are enforceable.

ENFORCEABILITY OF ONLINE/CLICKWRAP/SHRINKWRAP TERMS
Online terms are generally considered enforceable if conspicuous and users have an opportunity to review terms in advance.

Under guidelines on E-Commerce promulgated by the Ministry of Economy, Trade and Industry, changes of terms of service or use should be appropriately disclosed in a way that users can easily be aware of the changes.
The Electronic Contract Act (Act No. 95 of 2001) allows a consumer who had erroneous operation of a computer (e.g., accidental click) to cancel the contract if the company does not take appropriate measures (e.g., easily understandable order confirmation display) for the consumer to reconfirm the details of the order before the final click.

**GOVERNING LAW**
Choice of governing law and venue for resolution of disputes specified in a contract is generally accepted and recognized by courts in Japan.

It should be noted that under Japanese conflict law, in consumer contracts, a consumer may require additional application of the law of the consumer’s residence in addition to agreed governing law.

**KEY COMMERCIAL CONTRACT TERMS**

**ENFORCEABILITY OF WARRANTY DISCLAIMERS**
Warranty disclaimers are generally enforceable unless sellers are aware of a defect in the product(s) at the time of sale.

For disclaimers against consumers, even if the seller is not aware of a defect in the product(s) at the time of sale, comprehensive disclaimers are not enforceable under the Consumer Contract Act (CCA) (Act No. 61 of 2000).

**ENFORCEABILITY OF EXCLUSIONS/LIMITATIONS OF LIABILITY**
Exclusions and limitations of liability are usually enforceable unless they are grossly unfair. In consumer contracts, full exclusions or partial exclusions in case of gross negligence or willful misconduct are unenforceable under the CCA.

**INDEMNIFICATION**
The concept of indemnification does not exist under Japanese law. Instead, a contract party will be entitled to certain remedies upon breach of contract, such as damage claims and specific performance. Separately, damage claims are also available in tort cases.

Either in contract or in tort, if a party seeking compensation for monetary damages was also negligent, a Japanese Court may consider reducing damages under the concept of comparative negligence.
LUXEMBOURG

INTELLECTUAL PROPERTY FRAMEWORK

In general, the intellectual property rights in Luxembourg are governed by the following Federal statutory laws:

(i) Copyright – Law of April 18, 2001 on Copyright, Neighboring Rights and Databases, as amended by the Law of April 18, 2004 and lastly by the Law of May 22, 2009 (the Copyright Law).

(ii) Database Rights (sui generis right, distinct from copyright) – Law of April 18, 2001, as amended by the Law of April 18, 2004 and lastly by the Law of May 22, 2009 (the Copyright Law).


(vii) Professor’s Privilege/Ownership of publicly funded research – Special laws on the public funding of research results.

COMMERCIAL CONTRACT FRAMEWORK

There are a number of laws that may apply to commercial contracts, depending on the type of contract and the industry involved. However, generally commercial contracts are governed by provisions contained in the Luxembourg Civil Code.


RECOGNIZED INTELLECTUAL PROPERTY RIGHTS

COPYRIGHTS

NATURE OF RIGHT

To qualify for copyright protection, a work must be original.

The same requirement of originality applies to the copyright protection of databases, which are considered to be original when they constitute the author’s own intellectual creation by reason of the selection or arrangement of their contents.
There is no registration process for copyright protection; the author’s right arises automatically with the creation. Mere ideas or concepts are not protected.

**LEGAL FRAMEWORK**

Copyrights are governed by the Law of April 18, 2001 on Copyright, Neighboring Rights and Databases, as amended by the Law of April 18, 2004 and lastly by the Law of May 22, 2009.

**DURATION OF RIGHT**

The duration of an author’s right is the author’s life, plus 70 years after his death.

**OWNERSHIP/LICENSES**

Only natural persons (individuals) who have created works may enjoy the status of an author, even where an author is an employee. However, there are some presumptions, such as those regarding the assignment of economic rights in computer programs, that automatically favor employers.

The Copyright Act includes a rebuttable presumption of authorship; the author is presumed to be the person under whose name the work is being distributed.

Persons collaborating directly to the creation of a work become co-authors. Their copyright is indivisible. In these situations, the exercise of the right of co-authors is governed by agreement. Failing such agreement, no author may exercise this right in isolation, unless a court decision provides otherwise in case of a dispute. In situations in which the contributions of the authors may be individually identified, those authors may not, unless they agree otherwise, market their work in conjunction with new collaborators. However, they do share the right to exploit their contribution in isolation provided that such exploitation does not harm the joint work.

The economic rights of the author shall be freely assignable and transferable, in whole or in part, in accordance with the provisions of the Civil Code. In particular, they may be the subject of alienation or of an ordinary or exclusive license.

A specificity of Luxembourg copyright law is that it also allows the author to assign or transfer, in whole or in part, his moral rights to the extent that it does not wound his honor or reputation.

**REMEDIES FOR INFRINGEMENT**

Given the implementation of the Directive 2004/48/EC of the European Parliament and of the Council of April 29, 2004 on the enforcement of intellectual property rights, right holders are entitled to similar remedies under most intellectual property laws in the European Union, which differ only slightly and which warrant both (interim and final) injunctive and monetary relief.

The possible civil and criminal remedies for copyright infringement are set out under Sections 8 and 9 of the Copyright Act.

Civil Remedies are:

(i) Cessation of infringement;

(ii) Publication and posting of judgment; and

(iii) Monetary fine (2059-2066 Luxembourg Civil Code)
Reference should also be made to the saisie-contrefaçon procedure (Section 8 of the Copyright Act), which allows a rights holder to enter, without prior warning, the premises of an alleged infringer or an intermediary third party in order to find evidence of and more information regarding infringements.

Criminal remedies are:

(i) Monetary fine;

(ii) Confiscation or destruction of infringing goods or goods that directly served the purpose of committing the infringements at hand;

(iii) In case of a bad-faith/fraudulent infringement:

   (a) Imprisonment;
   
   (b) Monetary fine; and
   
   (c) Confiscation and possible destruction of infringing goods.

(iv) Heavier sanctions in case of repeated infringement:

   (a) Possible combination of imprisonment and monetary fine;
   
   (b) Permanently or temporarily closing the establishment run by the condemned party for a maximum period of 5 years; and
   
   (c) Publication and posting of judgment.

**MASK WORKS**

**NATURE OF RIGHT**

The topography of a semiconductor product is protected if it is the result of its creator’s own intellectual effort and is not commonplace in the semiconductor industry. Where the topography of a semiconductor product consists of elements that are commonplace in the semiconductor industry, it shall be protected only to the extent that the combination of such elements, taken as a whole, is the result of the creator’s own intellectual effort and the combination is not commonplace in the industry. The protection extends solely to the topography and not to any concept, process, system, technique or encoded information embodied in the topography.

The rights holder has the exclusive and temporary right to reproduce and commercially exploit the topography. The rights holder may, however, not assert this exclusive right: (i) to prohibit reproductions of the topography that serve the sole purpose of analyzing its techniques (reverse engineering) and (ii) to act against any topography resulting from such analysis to the extent that it is the result of the creator’s own intellectual effort and is not commonplace in the semiconductor industry.

**LEGAL FRAMEWORK**

The protection of semiconductor topographies is governed by the Law of December 29, 1988 on the Legal Protection of Topographies of Semiconductor Products.
DURATION OF RIGHT
The exclusive right related to the protection of topographies of semiconductor products come into existence on the earlier of (i) the date on which the topography was first commercially exploited anywhere in the world or (ii) the date on which the application for registration was filed. This exclusive right expires after ten years.

Exclusive rights will no longer be enjoyed or will expire if an application for registration has not been filed with public authority within two years of its first commercial exploitation.

Where a topography has not been commercially exploited anywhere in the world within a period of 15 years from its first fixation or encoding, the exclusive rights may no longer commence unless an application for registration has been filed within that period.

OWNERSHIP/LICENSES
The ownership of the exclusive right is granted to the creator of the topography of a semiconductor product. Where this topography is created by an employee in the course of his employment, the employer shall be deemed to be the creator, unless otherwise agreed in writing. Where this topography is created under a contract, other than a contract of employment, the person who has commissioned the topography shall be deemed to be the creator, unless otherwise agreed in writing.

The exclusive rights are not granted automatically, but require a registration; they are freely licensable and transferrable, including to the successors in title of the rights holder.

REMEDIES FOR INFRINGEMENT
Compensation for infringement is governed by the same provisions of the legislation on patents for invention. (See below “Patents – Remedies for Infringement”).

PATENTS
NATURE OF RIGHT
An invention is eligible for patent protection if it satisfies three conditions: (a) it is new, (b) inventive and (c) susceptible to industrial application.

(i) An invention is new if it does not fall within the relevant state of the art, meaning everything made available to the public before the date of filing of the patent application.

The novelty of an invention is not jeopardized if the invention was disclosed to the public in the course of six months prior to the filing of the application and it is due directly or indirectly to (a) an obvious abuse in relation to the applicant; or (b) the invention has been showed at an exhibition organized by the public authorities or an official international exhibition. In the latter case, the applicant shall declare, when submitting his application, that the invention was actually disclosed during an exhibition and furnish a relevant certificate.

(ii) It is inventive if it, in regard to the state of the art, is not obvious to a person skilled in the art.

(iii) Finally, the term industrial application must be understood very widely as being able to be made or used in any kind of industry, including agriculture.
Patent protection requires the successful completion of a patent application process.

(i) A priority right is granted by the person who has filed an application for a patent for the same invention. In order to benefit from this priority right, registrations must be carried out before the end of the 12th month following the date of filing of the first application. In addition, the applicant must make a “statement of priority” when applying.

Such priority right provides that the date of priority shall be the date of filing the application.

(ii) Any person who, in good faith, prior to the patent application or the priority date, possessed in Luxembourg a justified right in the prior use of the patented invention is entitled to continue the exploitation of the invention, for personal use, notwithstanding the existence of a patent granted to a third party.

The patent shall confer on its owner the right to prevent all third parties not having his consent:

(a) from making, offering, putting on the market or using a product that is the subject matter of the patent, or importing or stocking the product for those purposes; (b) from using a process that is the subject matter of the patent or from offering the process for use in Luxembourg territory, or when the third party knows, or it is obvious in the circumstances, that the use of offering of the process is prohibited without the consent of the owner of the patent; (c) from offering, putting on the market, using, or importing or stocking for those purposes the product obtained directly by a process that is the subject matter of the patent; (d) supplying or offering to supply, in Luxembourg territory, a person other than a person entitled to exploit the patented invention, the means of implementing, in that territory, the invention with respect to an essential element thereof where the third party knows, or it is obvious from the circumstances, that such means are suited and intended for putting the invention into effect.

**LEGAL FRAMEWORK**


**DURATION OF RIGHT**

Patents have a duration of 20 years from the date of filing of the patent application. Renewal is not possible.

Exploitation of the invention is not a prerequisite for maintaining patent protection. However, if the invention is not exploited in Luxembourg or any other Member State of the Agreement Establishing the WTO for a period of four years following the date of patent application or for a period of three years following the grant of the patent, a compulsory license may be granted following a request to the court.

**OWNERSHIP/LICENSES**

The Patents Act provides that the patent rights are owned by the inventor or his successor in title.

In case of joint ownership, each co-owner has a personal right to exploit the invention or give non-exclusive licenses if they compensate the other owner(s). An exclusive license may, however, only be granted with the consent of all co-owners. Each co-owner may act against infringement actions or assign any rights of the patent, but he has to notify the other co-owners thereof. In the latter event that one of the co-owners wishes to assign his share, the other co-owners have a pre-emption right over the proposed assignment for a three-month period from the moment they have been informed of the intention to assign. In addition, the co-ownership regime as specified in the Luxembourg Civil Code (815 et seq.; 1973a-1 et seq and 883 et seq) is not applicable to patent co-ownership.
If a patent application is submitted only by one owner without the involvement of the other joint owner(s), the other joint owner(s) may initiate legal proceedings requiring the transfer of the patent or the patent application as joint owner.

REMEDIES FOR INFRINGEMENT
The possible remedies for infringement are set out under title IX “Infringement” of the Patent Act:

(i) Cessation of infringement (provisional or permanent), possibly accompanied by the penalty of a daily fine;

(ii) Publication of the judgment;

(iii) Damages to make good the prejudice caused; and

(iv) Confiscation or destruction of infringing goods and of the instruments, devices or means specifically intended for committing the infringement;

Reference should also be made to the description and saisie-contrefaçon procedures (Article 79 of the Patent Act), which respectively allow for (i) the drawing up of a detailed description of the allegedly infringing articles and the instruments that have served to commit the alleged infringement by a sworn expert; and (ii) and the unexpected seizure of allegedly infringing articles and the instruments that have served to commit the alleged infringement. Both procedures serve the purpose of gathering evidence of and more information regarding infringements and may not exceed a period of three months from notification of the order to the person or to his domicile.

TRADEMARKS

NATURE OF RIGHT
Any signs (such as, but not limited to, names, designs, imprints, stamps, letters, numerals, shapes of goods or their packaging, colors and slogans) that are able to be represented graphically and to be used to distinguish the goods or services of a company, are eligible to be registered as individual trademarks. However, signs solely comprising a shape which is imposed by the very nature of a product, which gives the product substantial value, or which is necessary for obtaining a technical result, may not be registered as trademarks.

Trademark protection requires the successful completion of a trademark registration process.

In order to be registered, the sign must have a sufficient “distinctive character.” Such distinctive quality is not a constant but a variable. This means that a rather weak trademark at the time of registration may become a strong trademark through intensive advertising and enforcement, or, conversely and failing sufficient advertising and enforcement, that a strong trademark may become a weak trademark with a smaller scope of protection or even become the normal commercial description of a product or service for which it is registered as a result of the activity or inactivity of its owner, in which case the trademark shall be declared as lapsed.

A registered trademark shall give its owner an exclusive right to prevent any third party, without its consent, from: (a) using in business a sign that is identical to the trademark for goods or services that are identical to those for which the trademark is registered; (b) using in business a sign that is identical or similar to the trademark because the goods or services covered by the trademark and the sign are identical or similar and there is a risk of confusion in the mind of the public because
of the risk of association between the sign and the trademark; (c) using in business a sign which is identical or similar to the trademark for goods or services which are not similar to those for which the trademark is registered, where the trademark enjoys a reputation in the Benelux territory and where use of the sign without due cause would take unfair advantage of or be detrimental to the distinctive character or the reputation of the trademark; and (d) using a sign for purposes other than those of distinguishing the goods or services, where use of the sign without due cause would take unfair advantage of or be detrimental to the distinctive character or the reputation of the trademark.

**LEGAL FRAMEWORK**


**DURATION OF RIGHT**

The duration of trademark protection is ten years starting from the date of filing of the application and renewable for an unlimited number of consecutive ten-year periods.

**OWNERSHIP/LICENSES**

The exclusive rights encompassed by a trademark are obtained by registration. An application for registration can be filed by anyone (private persons, public authorities, companies) and does not need to be filed by the enterprise that will commercialize the trademark.

No protection to trademark owners is guaranteed without registration, unless such unregistered trademarks are well-known.

No specific provisions are foreseen in Luxembourg law with respect to co-ownership of trademarks.

Independently of the transfer or all or part of a business, a trademark may be transferred for all of some of the goods or services for which the trademark was filed or registered. A trademark may also be the object of a license for all or some of the goods or services for which the trademark was filed or registered.

**REMEDIES FOR INFRINGEMENT**

The possible remedies for trademark infringement are set out in articles 2.21 and 2.22 of the Benelux Convention on Intellectual Property of February 25, 2005 as approved by the Law of May 16, 2006:

(i) Compensation of material and non-material damages, which consists of:

(a) Losses suffered, including costs and expenses imposed on it for the investigation and determination of the infringements and the inconveniences connected with the proceedings the trademark holder is forced to institute, loss of reputation, prejudice to the commercial value of the trademarks and loss of market share; and

(b) loss of profits.

(ii) The handing over of the materials and instruments that were mainly used for the production of the infringing goods.

(iii) In case of acts committed in bad faith, transfer of the profit enjoyed as a result of those infringing acts.
TRADE SECRETS

NATURE OF RIGHT
Trade secrets are not expressly mentioned as a property right under Luxembourg law.

Luxembourg law does not provide for a uniform definition of trade secrets. For a definition, reference should be made to:

(i) Section 39(2) of the TRIPS Agreement: “Natural and legal persons shall have the possibility of preventing information: lawfully, within their control, from being disclosed to, acquired by, or used by others without their consent in a manner contrary to honest commercial practices so long as such information: (a) is secret in the sense that it is not, as a body in the precise configuration and assembly of its components, generally known among or readily accessible to persons within the circles that normally deal with the kind of information in question; (b) has commercial value because it is secret; and (c) has been subject to reasonable steps under the circumstances, by the person lawfully in control of the information, to keep it secret.”

(ii) Section 1 (i) of the Commission Regulation (EC) 772/2004 of April 27, 2004 on the application of Article 101(3) of the Treaty to categories of technology transfer agreements, Section 3.2 of the Commission notice 2005/C 325/07: “know-how” means a package of non-patented practical information, resulting from experience and testing which is (a) secret, that is to say, not generally known or easily accessible; (b) substantial, that is to say, significant and useful for the production of the contract products; and (c) identified, that is to say, described in a sufficiently comprehensive manner so as to make it possible to verify that it fulfills the criteria of secrecy and substantiality.

LEGAL FRAMEWORK
Luxembourg law does not have specific provisions on trade secrets in its labor laws or in its Civil Code.

Protection is offered by means of:

(i) Tort Law;

(ii) Unfair Competition Law;

(iii) Criminal Law, the offender must act with the intent to reach a competitive advantage or to cause harm to the owner; violations of trade secrets may constitute theft.

(iv) Contract Law, if an agreement (such as a non-disclosure agreement) was concluded.

OWNERSHIP/LICENSES
As for most European jurisdictions, competition rules prevail over contractual arrangements. Licenses of trade secrets are subject to Commission Regulation (EC) 772/2004 of April 27, 2004 on the application of Article 101(3) of the Treaty to categories of technology transfer agreements. Such licenses permitting the production of contract products are exempted from the application of Article 101 of the Treaty in case the parties’ joint market share does not surpass certain thresholds, and such for as long as the trade secrets remain secret, except in case the disclosure of the trade secrets is the result of an action by the licensee. In any case, trade secrets licenses containing any of the hard-core restrictions listed in Section 4 of aforementioned Regulation are not exempted.
REMEDIES FOR INFRINGEMENT

Civil remedies for misappropriation of trade secrets include:

(i) Injunction (cease and desist order; ordinary action and interim relief);
(ii) Publication of judgment;
(iii) Damages (for both losses suffered and loss of profits); and
(iv) Restraint measures, such as a penalty for future breach of the Court's order, ordinary action and interim relief.

Reference should also be made to the possibility of obtaining a search order to search the premises and computer in order to find misappropriated data.

Criminal remedies include:

(i) Monetary fines;
(ii) Imprisonment (natural persons);
(iii) Confiscation of goods used to commit the offence;
(iv) Exclusion of public procurement markets (companies); and
(v) Dissolution of company (companies).

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

EMPLOYEES

Copyright: In case of a work commissioned by third parties or works created by an employee in the performance of his tasks or upon instructions given by the employer, the employer or the commissioner is to be considered the assignee of the economic rights unless the parties have expressly agreed otherwise in writing.

The original author retains the moral rights on the work, since such rights are, in principle, non-transferable and inalienable.

Patent: When the inventor is an employee and unless the parties have expressly agreed otherwise in writing, patent rights belong to the employer:

(i) When an industrial invention is made during the performance or fulfillment of the employment contract, whereby the inventive activity is deemed to be the objective and the employee is paid to invent and make researches; and
(ii) When an industrial invention is made through the knowledge or use of technics or specific means to the employer or data procured by the employer.

Design: If a design has been created by an employee in the course of his employment, the employer shall, unless specified otherwise, be regarded as the creator.
CONSULTANTS/CONTRACTORS
Please see the “Employees” section above.

KEY COMMERCIAL CONTRACT CONSIDERATIONS

REGISTRATION OF COMMERCIAL AGREEMENTS
There are no general registration requirements for commercial contracts. Registration of licenses for patents, designs and trademarks is a legal requirement and will entitle the license to have an absolute defense against infringement, but is not required for the validity of the license itself.

RECOGNIZED LANGUAGE OF COMMERCIAL AGREEMENTS
Commercial contracts may be concluded in any language. From an enforceability perspective, the claimant has to prove that the counterparty consented to the terms, which includes understanding the language. For consumers, this evidentiary burden of proof will be difficult to satisfy if the contract language is not the official language of the region of residence of the consumer.

COUNTRY-SPECIFIC ISSUES FOR ONLINE CONTENT
The Luxembourg E-commerce Law of August 14, 2000, as lastly amended by the Law of April 2, 2014, provides several additional requirements regarding the information to be provided to conclude online agreements, including information about the service provider and the languages in which the agreement can be concluded.

ENFORCEABILITY OF ONLINE/CLICKWRAP/SHRINKWRAP TERMS
When a contract is drafted by one party and the other party merely has the opportunity to accept it (i.e. the contract is not negotiated), some provisions must be specifically approved in writing by the other party in order to be enforceable against the party that has not drafted the agreement. Such provisions include those relating to limitation of liability, time limits, exclusivity, withdrawal rights and choice of venue.

For contracts approved online, it is a common practice to contemplate a second check box to specifically approve the relevant clauses. However, such second tick is not deemed sufficient and consequently there is the risk that users challenge the enforceability of the provisions mentioned above while the other terms of the contract will remain valid.

GOVERNING LAW
Subject to the case law of the European Union on the conclusion of cross border online agreements, the Rome I and Brussels I regulations, and the limitations they impose on consumer contracts and employment contracts, the governing law and venue for resolution of disputes (including arbitration) specified in a commercial contract will generally be accepted and recognized.

KEY COMMERCIAL CONTRACT TERMS

ENFORCEABILITY OF WARRANTY DISCLAIMERS
Limitations and exclusions of warranty claims are generally permissible, including in business-to-consumer contracts, but are subject to the Law of April 8, 2011 introducing a Consumer Code in Luxembourg in respect of the sale of consumer goods, as lastly amended by the Law of April 2, 2014, which provides a two-year warranty period.
ENFORCEABILITY OF EXCLUSIONS/LIMITATIONS OF LIABILITY

Limitations of product liability for defects are severely restricted under Luxembourg law. Aside from product liability, liability in general may be excluded in principle, subject to certain conditions. For instance, liability may not be excluded if such would lead to a complete elimination of the main obligations of the agreement, or would lead to limiting one’s liability for fraud or willful misconduct.

INDEMNIFICATION

Under the general provisions of the Luxembourg Civil Code, only the damages that are the immediate and direct result of the non-performance or delay in the performance of the contractual obligation (Article 1142 and following of the Luxembourg Civil Code) can be claimed by the parties.
GUIDE TO GOING GLOBAL - INTELLECTUAL PROPERTY AND TECHNOLOGY

MEXICO

INTELLECTUAL PROPERTY FRAMEWORK

Two Federal laws provide the core legal basis for protection of intellectual property rights in Mexico (i) the Industrial Property Law (Ley de la Propiedad Industrial), and (ii) the Federal Copyright Law (Ley Federal del Derecho de Autor).

COMMERCIAL CONTRACT FRAMEWORK

Commercial matter provisions are governed by Federal laws. In general, commercial agreements are governed by the Commercial Code; thus certain agreements are governed by specific Federal laws (i.e., bank credit agreements, insurance, pledge, trusts, among others).

Additional commercial contract provisions may be found in other Federal laws (i.e., antitrust, consumers’ protection), regulations and official standards.

Venue for resolution of disputes specified in a commercial contract corresponds to Federal Courts although state courts may accept venue.

Commercial contracts with Federal and state government agencies are subject to separate governmental regulations, which can include among other matters, specific auditing and recordkeeping requirements.

RECOGNIZED INTELLECTUAL PROPERTY RIGHTS

COPYRIGHTS

NATURE OF RIGHT
Copyright can apply to a variety of works, including musical, literary, broadcasting, photography, works of art (graphic design, pictorial, drawing, sculpture and caricature), cinematography, audiovisual work, editorial compilations (such as encyclopedias and anthologies), operating systems and computer programs.

Copyright grants both moral and economic rights to its author, which shall be an individual (as opposed to an entity).

Moral rights make the author the first and only perpetual owner of the rights of the copyright work; patrimonial rights allow the titleholder to exploit the work exclusively or to authorize third parties to exploit the copyright.

LEGAL FRAMEWORK
Federal Copyright Law (Ley Federal del Derecho de Autor) governs copyrights.

DURATION OF RIGHT
Moral rights are perpetual; economic rights last for the life of the author plus an additional 100 years.
In order to perfect ownership of a copyright, the author must register his work with the National Institute of Author Rights (Instituto Nacional del Derecho de Autor).

Titleholder of the economic rights of the copyright may grant exclusive or non-exclusive licenses to third parties, as well as, transfer his rights.

All transfers shall be conducted against valid consideration and on a non-perpetual basis.

Licenses and transfer of copyrights shall be evidenced in writing and shall be registered with the National Institute of Author Rights.

Infringement of copyright may lead to the payment of damages and losses, which shall be determined by a court of law based on actual damage and loss.

Criminal penalties may be imposed.

In order to perfect the ownership in a mask work, registration is required before the IMPI.

Mask works registrations or registrations in process may be encumbered, transmitted or licensed pursuant to commercial general provisions. Registration of the agreement is required before the IMPI to perfect the encumbrance, transmission or license.

No obligatory license operates in mask work registrations.

Violation of a registered mask work may lead to the payment of damages and losses, which shall be determined by a court of law based on actual damage and loss.

Criminal penalties may be imposed.
PATENTS

NATURE OF RIGHT
Regarding inventions, the right granted is a patent; regarding utility models and industrials designs, the right granted is a registration.

LEGAL FRAMEWORK
Second Title of the Industrial Property Law (Ley de la Propiedad Industrial).

DURATION OF RIGHT
The duration of a patent is 20 years from the filing requesting the patent; the duration for utility models is ten years from the filing requesting the registration; and the duration for industrial designs is 15 years as of the filing requesting the registration.

OWNERSHIP/LICENSES
In order to perfect the patent, registration is required before the IMPI.

Patents registrations and registrations in process may be encumbered, transmitted or licensed pursuant to commercial general provisions. Registration of the agreement is required before the IMPI to perfect an encumbrance, transmission or a license.

REMEDIES FOR INFRINGEMENT
Violation may lead to the payment of damages and losses, which shall be determined by a court of law based on actual damage and loss.

Criminal penalties may be imposed.

TRADEMARKS

NATURE OF RIGHT
Trademarks can be visible names and figures that are sufficiently distinctive and capable of identifying the products or services to which they are applied, or are intended to be applied, compared with others of the same type or category; three-dimensional shapes; trade names and company or business names, provided that they are not an exception; and the proper name of a natural person, provided that it is not the same as a registered mark or published trade name.

Trademarks shall be registered in relation to specific products or services according to the classification provided for by the Regulations of the Law.

LEGAL FRAMEWORK
Trademarks are governed by the Fourth Title of the Industrial Property Law (Ley de la Propiedad Industrial).

DURATION OF RIGHT
Trademarks have a duration of ten years as of the filing requesting the trademark registration.
OWNERSHIP/LICENSES
In order to perfect the title, registration of the trademark is required before the IMPI.

Trademark registrations and registrations in process may be encumbered, transmitted or licensed pursuant to commercial general provisions. Registration of the agreement is required before the IMPI to perfect the encumbrance, transmission or license.

REMEDIES FOR INFRINGEMENT
Violation may lead to the payment of damages and losses, which shall be determined by a court of law based on actual damage and loss.

Criminal penalties may be imposed.

TRADE SECRETS

NATURE OF RIGHT
Trade secrets can include the nature, characteristics or purposes of the products; the production methods or processes; or to the means or forms of distribution or commercialization of the products or rendering of services.

All trade secrets shall be evidenced in documents, electronic or magnetic media, microfilms or similar.

LEGAL FRAMEWORK
Third Title of the Industrial Property Law (Ley de la Propiedad Industrial).

DURATION OF RIGHT
As long as reasonable efforts are taken by the owner of the information to maintain the information as a trade secret; trade secret protection is potentially perpetual.

OWNERSHIP/LICENSES
No registration is required. An owner must use means or systems to preserve a trade secret’s confidentiality and restricted access to the trade secret.

An owner may transfer or allow the use of the trade secret to a third party. A third party shall have the obligation to not disclose the trade secret.

REMEDIES FOR INFRINGEMENT
Violation may lead to the payment of damages and losses, which shall be determined by a court of law based on actual damage and loss.

Criminal penalties may be imposed.
INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

EMPLOYEES
The Mexican Labor Act provides that an employee-inventor has the right to be named as author of his inventions. This is a right to recognition, not ownership. With respect to ownership of inventions, the Labor Act provides that:

(i) Where an employee-inventor works in research and development or works on perfecting processes used in the employer’s business, the resulting intellectual property belongs to the employer; provided that if the benefit to the employer is disproportionate to the salary paid to the employee, the employee shall have the right to a royalty, as determined by mutual agreement of the parties or by the Mediation and Arbitration Board; and

(ii) Intellectual property developed by an employee engaged in any other area shall belong to the employee; provided that the employer shall have the first right to the exclusive use or acquisition of the invention or patents (on terms to be negotiated by the parties or determined by the Mediation and Arbitration Board).

CONSULTANTS/CONTRACTORS
There is no specific legal framework under Mexican law for ownership of intellectual property developed by consultants and contractors. It is customary for consultants and contractors to sign written agreements. Absent a written present assignment of developments, consultants and contractors will retain ownership of the intellectual property developed by them, even if contracted and paid for by another party.

KEY COMMERCIAL CONTRACT CONSIDERATIONS

REGISTRATION OF COMMERCIAL AGREEMENTS
No general registration requirement though as described in this section, all intellectual property related agreements shall be registered before the relevant governmental authority to be effective against third parties.

RECOGNIZED LANGUAGE OF COMMERCIAL AGREEMENTS
Spanish. Documents to be filed with a governmental authority shall be translated into Spanish by an official translator.

COUNTRY-SPECIFIC ISSUES FOR ONLINE CONTENT
There is no specific legislation regarding online content.

ENFORCEABILITY OF ONLINE/CLICKWRAP/SHRINKWRAP TERMS
Online terms are generally viewed as enforceable if conspicuous, users have an opportunity to review and indicate affirmative assent (e.g., check a box).

GOVERNING LAW
Governing law and venue for resolution of disputes specified in a commercial contract corresponds to Federal Courts although State Courts may accept venue.

Dispute resolution is litigation Federal Courts unless an alternative dispute resolution procedure, such as mediation or arbitration, is specified in the contract.
KEY COMMERCIAL CONTRACT TERMS

ENFORCEABILITY OF WARRANTY DISCLAIMERS
Under Mexican law, the granting of warranties is mandatory only for determined products and services. If a seller or service provider grants warranty to its client, it shall respect such warranty in all its terms and conditions and contain the minimum requirements set forth by the applicable law.

ENFORCEABILITY OF EXCLUSIONS/LIMITATIONS OF LIABILITY
Provided that granting a warranty is not mandatory, if the seller or service provider grants warranty to its client, it shall respect such warranty in all its terms and conditions and contain the minimum requirements set forth by the applicable law.

INDEMNIFICATION
Federal and state civil laws set forth the provisions related to indemnification for damages and losses, which shall be and are limited to direct and immediate consequence of the act or omission that generated the indemnification.

Liquidated damages provisions may be used in agreements, provided that the amount of such liquidated damages may not be greater than the principal amount of the agreement.
NETHERLANDS

INTELLECTUAL PROPERTY FRAMEWORK

In the Netherlands, the intellectual property rights are governed by the following statutory laws:

(i) Copyright – Copyright Act of 1912.

(ii) Software – Regulation regarding software is included in the Copyright Act of 1912 (see chapter VI of the Copyright Act of 1912) implementing the EU Directive of May 14, 1991 on the Legal Protection of Computer Programs (91/250/EEG).


(viii) Trade name – Trade Names Act of July 5, 1921

In addition, certain other statutory laws may protect other manifestations of intellectual property that do not fulfill the requirements of the intellectual property types cited above, such as know-how, trade and industrial secrets, company names, domain names and misleading and comparative advertising.

COMMERCIAL CONTRACT FRAMEWORK

Depending on the circumstances, such as the type of contract and sector, the Dutch Civil Code and other Dutch laws apply to commercial contracts.

RECOGNIZED INTELLECTUAL PROPERTY RIGHTS

COPYRIGHTS

NATURE OF RIGHT

To qualify for copyright protection, a work must be an original intellectual creation of the author. Even if the work consists of elements which, considered in isolation, are not as such an intellectual creation of the author who employs them, the author may express his creativity in an original manner through the choice, sequence and combination of those elements.

The same requirement of originality applies to the copyright protection of databases, which is considered to be original when it constitutes the author’s own intellectual creation by reason of the selection or arrangement of their contents.

There is no registration process for copyright protection. The author’s right arises automatically with the creation of the work. Mere ideas or concepts are not protected.
LEGAL FRAMEWORK
Copyrights are governed by the Copyright Act of 1912.

DURATION OF RIGHT
The copyright shall expire 70 years after the first of January of the year following the year of the death of the author. The duration of the copyright belonging jointly to two or more persons in their capacity as co-authors of a work shall be calculated from the first of January of the year following the year of the death of the last surviving co-author.

OWNERSHIP/LICENSES
The Copyrights Act of 1912 provides a rebuttable presumption of authorship: the author is presumed (unless proven otherwise) to be the person identified by name on the work by virtue of the mention of his company name or the appearance of another sign that enables his identification.

Persons collaborating directly in the creation of a work become co-authors. The right of exploitation belongs to the authors together. In these situations, the exercise of the right of co-authors is governed by the rules regarding community (which is regulated in the Dutch Civil Code).

While an author’s moral rights are in principle non-transferable and inalienable, an author’s economic rights can be assignable and transferable, in whole or in part. The delivery of the copyrighted work requires a deed of assignment. The assignment shall comprise only such rights as are recorded in the deed or necessarily derive from the nature or purpose of the title. The works transferred must be sufficiently determinable. It is generally accepted that copyright in a not yet existing work can also be transferred, provided that the work is sufficiently determinable.

Authorization given by the designer of a work protected by copyright to a third party to file a design in which that work is incorporated shall imply the assignment of the copyright attached to that work insofar as it is incorporated in the design. The party filing a design shall be presumed also to be the owner of the copyright relating thereto; this presumption shall not, however, apply in respect of the actual author of the copyrighted work or his beneficiary. The assignment of the copyright relating to a design shall result in the assignment of the right in the design and vice versa.

REMEDIES FOR INFRINGEMENT

Monetary relief entails the possibility to claim damages as a lump sum or a payment of unfair profits made, in case of a bad faith infringement. A number of supplementary, injunctive measures are available, such as (i) a recall or definitive removal from the channels of commerce or destruction, of the infringing goods and in appropriate cases, of the materials and implements principally used in the creation or manufacture of these goods; (ii) the right of information, ordering that the infringer tolerate the disclosure of information about the origin of the infringing goods or services, the distribution channels and the identity of any third parties involved in the infringement; and (iii) the publication of the decision, including the displaying and publishing of the decision, in full or in part.

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DURATION OF RIGHT
The copyright shall expire 70 years after the first of January of the year following the year of the death of the author. The duration of the copyright belonging jointly to two or more persons in their capacity as co-authors of a work shall be calculated from the first of January of the year following the year of the death of the last surviving co-author.

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While an author’s moral rights are in principle non-transferable and inalienable, an author’s economic rights can be assignable and transferable, in whole or in part. The delivery of the copyrighted work requires a deed of assignment. The assignment shall comprise only such rights as are recorded in the deed or necessarily derive from the nature or purpose of the title. The works transferred must be sufficiently determinable. It is generally accepted that copyright in a not yet existing work can also be transferred, provided that the work is sufficiently determinable.

Authorization given by the designer of a work protected by copyright to a third party to file a design in which that work is incorporated shall imply the assignment of the copyright attached to that work insofar as it is incorporated in the design. The party filing a design shall be presumed also to be the owner of the copyright relating thereto; this presumption shall not, however, apply in respect of the actual author of the copyrighted work or his beneficiary. The assignment of the copyright relating to a design shall result in the assignment of the right in the design and vice versa.

REMEDIES FOR INFRINGEMENT

Monetary relief entails the possibility to claim damages as a lump sum or a payment of unfair profits made, in case of a bad faith infringement. A number of supplementary, injunctive measures are available, such as (i) a recall or definitive removal from the channels of commerce or destruction, of the infringing goods and in appropriate cases, of the materials and implements principally used in the creation or manufacture of these goods; (ii) the right of information, ordering that the infringer tolerate the disclosure of information about the origin of the infringing goods or services, the distribution channels and the identity of any third parties involved in the infringement; and (iii) the publication of the decision, including the displaying and publishing of the decision, in full or in part.
DESIGNS

NATURE OF RIGHT
A registered or unregistered design can be protected to the extent that it is new and has individual character. The appearance of the whole or a part of a product can be regarded as a design. The appearance of a product is derived from, in particular, the features of the lines, contours, colors, shape, texture and materials of the product itself and its ornamentation. Those features of appearance of a product which are solely dictated by its technical function, are excluded from protection.

A design shall be considered new if no identical design has been made available to the public before the date of filing of the application or the date of priority. Designs shall be deemed to be identical if their features differ only in immaterial details.

A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design that has been made available to the public before the date of filing or the date of priority. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.

In order to assess novelty and individual character, a design shall be deemed to have been disclosed to the public if the design has been published following registration or otherwise, or exhibited, used in trade or made public in any other way, unless such events could not in the normal practice of business reasonably be known to specialists within the sector concerned operating within the European Community or the European Economic Area prior to the filing or priority date. The design shall not, however, be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality.

The novelty of a design is not jeopardized if the design was disclosed to the public within twelve months prior to the filing of the application and it is due directly or disclosure has been made following improper conduct with regard to the creator or his beneficiary.

In order to benefit from the priority right, connected registrations must be filed within a period of six months from the filing date of the application. In addition, the applicant must make a "statement of priority" when applying.

A right of prior use is recognized for third parties who, prior to the filing date for a design or to the priority date, manufactured on Benelux territory products that are identical in appearance to the design filed or that do not produce a different overall impression on an informed user.

LEGAL FRAMEWORK

DURATION OF RIGHTS
Benelux filings shall be registered for a term of five years from the date of filing. The registration may be renewed for four successive periods of five years up to a maximum of 25 years.
OWNERSHIP/LICENSES

In principle, the exclusive rights conferred by a Benelux design are acquired by virtue of registration to the holder. However, there is an unregistered form: the unregistered Community design. An unregistered Community design shall, however, confer on its holder the exclusive right to use it and to prevent any third party not having his consent from using it only if the contested use results from copying the protected design.

The contested use shall not be deemed to result from copying the protected design if it results from an independent work of creation by a designer who may be reasonably thought not to be familiar with the design made available to the public by the holder.

There are no specific provisions in the laws of the Netherlands with respect to co-ownership of designs. However, it is generally understood that the exercise of the right of co-ownership of designs is governed by the rules regarding community (which is regulated in the Dutch Civil Code).

A design may also be the subject of a license. Entry of a license in the register may be cancelled only at the joint request of the holder of the design right and the licensee.

If a license has been recorded, registration of the design may be surrendered only at the joint request of the holder of the design and the licensee.

The assignment or other transfer of the license shall be valid as to third parties only after filing of an extract from the document establishing the assignment or transfer or a corresponding declaration signed by the parties involved has been registered in the manner specified by the implementing regulations and following payment of the fees due.

REMEDIES FOR INFRINGEMENT

In respect of designs, the possible remedies are set out in Chapter Three of the Benelux Convention on Intellectual Property, which also warrant both (interim and final) injunctive and monetary relief.

Monetary relief includes the possibility to claim damages as a lump sum as well as payment of unfair profits made in case of a bad faith infringement. A number of supplementary, injunctive sanctions may be applied for, such as (i) a recall or definitive removal from the channels of commerce or destruction of the infringing goods and, in appropriate cases, of the materials and implements principally used in the creation or manufacture of these goods; (ii) the right of information, ordering the infringer to share precise information on the origin of the infringing goods or services, the distribution channels and the identity of any third parties involved in the infringement; and (iii) the dissemination of the decision, including the displaying and publishing of the decision, in full or in part.

MASK WORKS

NATURE OF RIGHT

Pursuant to the Dutch Act on the Legal Protection of Topographies of Semiconductor Products, the topography of a semiconductor product is protected if it is the result of its creator’s own intellectual effort and is not commonplace in the semiconductor industry. Where the topography of a semiconductor product consists of elements that are commonplace in the semiconductor industry, it is protected only to the extent that the combination of such elements, taken as a whole, fulfills the above-mentioned conditions. The protection applies solely to the topography and excludes any concept, process, system, technique or encoded information embodied in the topography.
The rights holder shall have the exclusive and temporary right to reproduce and commercially exploit the topography. The rights holder may, however, not assert this exclusive right of (i) reproduction solely for the purposes of analysis, evaluation or teaching of the topography or the concepts, processes, systems or techniques embodied in the topography and (ii) a topography resulting from the analysis and evaluation of another topography carried out in accordance with item (i), at least insofar as the new topography is the result of its creator’s own intellectual effort and is not commonplace in the semiconductor industry.

**LEGAL FRAMEWORK**
Semiconductor topographies are protected pursuant to the Act of October 28, 1987 on the Legal Protection of Topographies of Semiconductor Products.

**DURATION OF RIGHT**
The exclusive right related to the protection of topographies of semiconductor products shall come into existence when the topography is fixed for the first time and expires ten years from the end of the calendar year in which the topography was filed or is first commercially exploited anywhere in the world, whichever comes first. The exclusive right expires where a topography has not been commercially exploited and if no application was made the right expires within a period of 15 years from the date on which it was first fixed.

**OWNERSHIP/LICENSES**
The ownership of the exclusive right is granted to the creator of the topography of a semiconductor product.

Like a copyright in the Netherlands and contrary to many other EU member states, the exclusive right is granted automatically, i.e. without the obligation to register, and is freely licensable and transferable, including to the successors in title of the rights holder. However, the exclusive right to a topography may only be exercised against third parties after the registration of the topography with the respective authority (the Dutch Patent Office).

**REMEDIES FOR INFRINGEMENT**
Monetary relief also entails the possibility to claim damages as a lump sum as well as payment of unfair profits made in case of a bad faith infringement. A number of supplementary, injunctive sanctions may be applied for, such as (i) a recall or definitive removal from the channels of commerce or destruction of the infringing goods and, in appropriate cases, of the materials and implements principally used in the creation or manufacture of these goods and (ii) the right of information, ordering the infringer to share precise information on the origin of the infringing goods or services, the distribution channels and the identity of any third parties involved in the infringement.

**PATENTS**

**NATURE OF RIGHT**
Subject to the provisions of Articles 54 to 60 of the Dutch Patents Act of 1995, a patent shall confer on its owner the exclusive right: (i) to make, use, put on the market or resell, hire out or deliver the patented product, or otherwise deal with or for his business, or to offer, import or stock it for any of those purposes; (i) to use the patented process in or for his business or to use, put on the market, or resell, hire out or deliver the product obtained directly as a result of the use of the patented process, or otherwise deal with or for his business, or to offer, import or stock it for any of those purposes.
An invention is eligible for patent protection if it satisfies three conditions: (i) it is new; (ii) inventive; and (iii) susceptible of industrial application. An invention is new if it does not fall within the relevant state of the art. It is inventive if it would not be obvious to a skilled technician. Finally, the term industrial application must be understood very broadly and can include agriculture.

The novelty of an invention is not jeopardized if the invention was disclosed to the public within six months prior to the filing of the application and it is due directly or indirectly to (i) an obvious abuse in relation to the applicant or (ii) the invention has been shown at an exhibition organized by the public authorities or an official international exhibition.

In order to benefit from the priority right, registrations must be carried out during the 12 months from the filing date of the application (priority date).

Any person who, in the Netherlands or Netherlands Antilles or, in the case of a European patent, in the Netherlands, has already manufactured or applied or commenced implementation of his intention to manufacture or apply, in or for his business, the subject matter of a patent application filed by another on the filing date thereof or, if the applicant has a right of priority under Article 9(1) or Article 87 of the European Patent Convention, on the filing date of the priority application, shall, notwithstanding the patent, continue to have the exploitation right(s) (as mentioned in the Dutch Patent Act), this right being based on prior use, unless his knowledge was obtained from matter already made or applied by the applicant or from the applicant’s descriptions, drawings or models.
Damages as well as surrender of profits made can only be awarded if the infringer knew or should reasonably have known his actions entailed a patent infringement. A number of supplementary, injunctive sanctions may be applied for, such as (i) a recall or definitive removal from the channels of commerce or destruction, of the infringing goods and in appropriate cases, of the materials and implements principally used in the creation or manufacture of these goods; (ii) the right of information, ordering the infringer to share precise information on the origin of the infringing goods or services, the distribution channels and the identity of any third parties involved in the infringement; and (iii) the dissemination of the decision, including the displaying and publishing of the decision, in full or in part.

TRADEMARKS

NATURE OF RIGHT
Any signs (such as, but not limited to, names, designs, imprints, stamps, letters, numerals, shapes of goods or their packaging, colors and slogans) that are able to be represented graphically and to be used to distinguish the goods or services of a company, are eligible to be registered as individual trademarks. However, signs solely comprising a shape which is imposed by the very nature of a product, which gives the product substantial value, or which is necessary for obtaining a technical result, may not be registered as trademarks.

In order to be registered, the sign must have a sufficient “distinctive character.” Such distinctive quality is not a constant but a variable. This means that a rather weak trademark at the time of registration may become a strong trademark through intensive advertising and surveillance, or, conversely and failing sufficient advertising and surveillance, that a strong trademark may become a weak trademark with a smaller scope of protection or even become the normal commercial description of a product or service for which it is registered as a result of the activity or inactivity of its owner, in which case the trademark shall be declared as lapsed.

On the basis of a registered Benelux trademark its owner has the exclusive right to prevent any third party, who does not have the consent thereto from the trademark owner, from: (i) using in business a sign that is identical to the trademark for goods or services that are identical to those for which the trademark is registered; (ii) using in business a sign in respect of which, because it is identical or similar to the trademark and because the goods or services covered by the trademark and the sign are identical or similar, there is a risk of confusion in the mind of the public which includes the risk of association between the sign and the trademark; (iii) using in business a sign which is identical or similar to the trademark for goods or services which are similar to those for which the trademark is registered, where the trademark is well known in the Benelux territory and where use of the sign without due cause would take unfair advantage of or be detrimental to the distinctive character or the repute of the trademark; and (iv) using a sign for purposes other than those of distinguishing the goods or services, where use of the sign without due cause would take unfair advantage of or be detrimental to the distinctive character or the repute of the trademark.

LEGAL FRAMEWORK

DURATION OF RIGHT
Trademarks have a duration of ten years starting from the date of filing of the application and is renewable for an unlimited number of consecutive ten-year periods.
The exclusive rights conferred by a trademark are acquired by virtue of registration to the registration holder. Thus, no protection to trademark owners is guaranteed without registration, unless such unregistered trademarks are well-known to the public. However, if the owner of an unregistered trademark is confronted with the registration by a third party of a similar sign for similar goods or services, he can annul the registration on grounds of bad faith if the applicant had knowledge of the previous use.

No specific provisions are in the laws of the Netherlands with respect to co-ownership of trademarks. However, it is generally understood that the exercise of the right of co-ownership of trademarks is governed by the rules regarding community (which is regulated in the Dutch Civil Code).

Independently of the transfer of all or part of a business, a trademark may be transferred in respect of all or some of the goods or services for which the trademark was filed or registered. A trademark may also be the subject of a license for all or some of the goods or services in respect of which the trademark was filed or registered as well as for a specific territory. To be valid against third parties, the license will need to be recorded in the register. However, if a license has been recorded, registration of the trademark may be surrendered only at the joint request of the holder of the trademark and the licensee. The same applies for cancellation of the license in the register.

The possible remedies for trademark infringement are set out in Articles 2.20, 2.21 and 2.22 of the Benelux Convention on Intellectual Property, which also allow both interim and final injunctive and monetary relief.

Monetary relief also entails the possibility to set the damages as a lump sum as well as the possible conveyance to the claimant of infringing goods and in appropriate cases, of the materials and implements principally used in the creation or manufacture of these goods. In case of a bad-faith infringement, monetary relief also includes the possibility to claim payment of unfair profits made. A number of supplementary, injunctive sanctions may be applied for, such as (i) a recall or definitive removal from the channels of commerce or destruction of the infringing goods and, in appropriate cases, of the materials and implements principally used in the creation or manufacture of these goods; (ii) the right of information, ordering the infringer to share precise information on the origin of the infringing goods or services, the distribution channels and the identity of any third parties involved in the infringement; and (iii) the dissemination of the decision, including the displaying and publishing of the decision, in full or in part.

Trade secrets are not expressly mentioned as a property right under Dutch law.

However, the essence of the prohibition as mentioned in Section 39(2) of the TRIPS Agreement has been interpreted in Dutch case law to be incorporated Article 6:162 of the Dutch Civil Code (unlawful act).
LEGAL FRAMEWORK

Civil law:

(i) Article 6:162 of the Dutch Civil Code provides a basis for action for instance against someone who breached a non-disclosure obligation or who has provoked such a breach. Also, when a third party takes advantage of the breach of someone else's non-disclosure obligation, this can be unlawful.

(ii) Contract law, if an agreement (such as a non-disclosure agreement) was concluded with the third party.

(iii) Article 7:678 sub I of the Dutch Civil Code, provides that an employee who discloses information about the company of his employer, which information should have been kept a secret can be dismissed with immediate effect.

Criminal law:

(i) Articles 272 and 273 of the Dutch Criminal Code stipulate the criminal protection of trade secrets.

OWNERSHIP/LICENSES

Licenses for know-how and trade secrets are common under the laws of the Netherlands. Licenses in respect of trade secrets are subject to Commission Regulation (EC) 772/2004 of April 27, 2004 on the application of Article 81(3) of the Treaty to categories of technology transfer agreements.

REMEDIES FOR INFRINGEMENT

There can be criminal and civil proceedings for trade secret misappropriation. In principle, both (interim and final) injunctive and monetary relief can be obtained.

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

EMPLOYEES

Copyright: The Dutch Copyright Act stipulates that where labor carried out by an employee consists in the making of certain literary, scientific or artistic works, the employer shall be deemed the author thereof, unless otherwise agreed between the parties.

As the employer is deemed to be the author of the work, it is likely that he also retains the moral rights. However, this is still an unanswered issue in Dutch literature. It is also justifiable to understand that the employee (as the original author) retains the moral rights on the work. However, they may be waived as far as permitted by law.

Patent: The Patents Act provides that the right to a patent shall belong to the inventor or his successor in title. Where the invention for which a patent application has been filed has been made by a person employed in the service of another person, the employee shall be entitled to the patent unless the nature of the service entails the use of the employee’s special knowledge for the purposes of making inventions of the same kind as that to which the patent application relates. Should the latter be the case, the employer shall be entitled to the patent.

Design: If a design has been developed by an employee in the execution of duties, the employer shall, unless otherwise agreed, be deemed to be the designer.

Where a design is created in an employment context, the copyright relating to the design shall belong to the party deemed to be the designer, in accordance with the provisions of the Benelux Convention on Intellectual Property.
CONSULTANTS/CONTRACTORS

Copyright: If a work has been made according to the draft and under the guidance and supervision of another person, that person shall be deemed the author of the work.

Where a design is created in a consultants/contractors context, the copyright relating to the design shall belong to the party deemed to be the designer, in accordance with the provisions of the Benelux Convention on Intellectual Property.

Patent: The applicant shall generally be deemed to be entitled to exercise the right to the patent. Where an invention has been made by two or more persons working together by agreement, they shall have a joint right to a patent. Any person who has made an invention for which a patent application has been filed, shall have a right to be mentioned as the inventor in the patent.

Design: If a design has been created on commission, the commissioning party shall, unless specified otherwise, be deemed to be the designer, provided that the commission was given with a view to commercial or industrial use of the product in which the design is incorporated.

Where a design is created in a consultants/contractors context, the copyright relating to the design shall belong to the party deemed to be the designer, in accordance with the provisions of the Benelux Convention on Intellectual Property.

Trade secrets: Article 7:678 sub I of the Dutch Civil Code, provides that an employee who discloses information about the company of his employer, which information he should have kept a secret can be dismissed with immediate effect. Post-employment, the disclosure by a former employee of trade secrets of the former employer can be interpreted to be a breach of the obligation following from Article 7:611 of the Dutch Civil Code to act as a good employee.

KEY COMMERCIAL CONTRACT CONSIDERATIONS

REGISTRATION OF COMMERCIAL

There are no general registration requirements for commercial contracts.

AGREEMENTS

Registration of licenses for patents, designs and trademarks is possible and necessary for the license to have third-party effect, but is not required for the validity of the license itself.

RECOGNIZED LANGUAGE OF COMMERCIAL AGREEMENTS

Commercial contracts may be concluded in any language.

ENFORCEABILITY OF ONLINE/CLICKWRAP/SHRINKWRAP TERMS

In order to be enforceable, the customer must have accepted the terms, usually by ticking a box, and a copy of the terms must be provided or made available. The obligation to provide a copy of the standard terms means that the user has to afford the other party a reasonable opportunity to review and accept the standard terms. The user has afforded the other party this opportunity when he has handed over the standard terms to the other party at the time of entering into the contract. This obligation will be satisfied in an online environment if the standard terms were made available to the consumer either prior to or upon concluding an agreement in such a manner that the consumer could download them and save them on his own data carrier (e.g. hard drive, USB stick, etc.), since the other party must also be able to refer to them at a later point in time. Including a link to a website is not sufficient.

Clickwrap/Shrinkwrap terms are generally believed not to be enforceable.
GOVERNING LAW
Subject to the conflict of law provisions as laid down in the Rome I and Brussels I regulations and in the Dutch Civil Code, and the limitations they impose, for example, consumer contracts and employment contracts, the governing law and venue for resolution of disputes (including arbitration) specified in a commercial contract will generally be accepted and recognized.

KEY COMMERCIAL CONTRACT TERMS

ENFORCEABILITY OF WARRANTY DISCLAIMERS
The concept of a disclaimer for express and implied warranties as such does not exist under Dutch law. Limitations of warranty claims are generally permissible, including in business-to-consumer contracts, but may be subject to certain restrictions in the Dutch Civil Code (especially in respect of general terms and conditions). Limitations are generally prohibited in a sale of goods agreement entered into with a consumer. In a consumer sale, a warranty must state in plain intelligible language which rights or remedies are granted to the buyer and make clear that these entitlements are without prejudice to rights or remedies conferred by law. The warranty must further state the name and address of the seller or the producer who granted the warranty and the duration and territorial scope for which it holds.

ENFORCEABILITY OF EXCLUSIONS/LIMITATIONS OF LIABILITY
In principle, a party will be liable for all damages related to an attributable breach of the contract. With some exceptions, commercial entities are largely free to agree on a limitation of liability. Limitations and exclusions, for example with respect to consequential damages, are common to Dutch law contracts. Liability clauses do not apply to the extent, in the given circumstances, this would be unreasonably unacceptable according to standards of reasonableness and fairness. In B2B relationships within the supply chain, risk for product liability can, in general, be apportioned between the parties on an agreed basis by indemnity protection.

INDEMNIFICATION
The concept of indemnification will, in general, be interpreted in accordance with the Dutch law principles (meaning the principles of reasonableness and fairness) and is subject to freedom of contract.
RUSSIA

INTELLECTUAL PROPERTY FRAMEWORK

As a general matter, intellectual property rights are governed by Part IV of the Russian Civil Code.

COMMERCIAL CONTRACT FRAMEWORK

There are a number of laws that may apply to commercial contracts, depending on the type of contract and on the industry involved. However, the general provisions are contained in the Russian Civil Code (Parts I and II).

RECOGNIZED INTELLECTUAL PROPERTY RIGHTS

COPYRIGHTS

NATURE OF RIGHT
Copyright protection is available to works having a creative character and pertaining to works of literature, science and arts, regardless of their purpose, qualities and the mode or form of expression. Computer programs and databases are generally protected as literary works.

Copyright owners have certain exclusive rights, including the right to reproduce, distribute, publicly display, import, loan, perform publicly by any distance medium, communicate by air, communicate by cable, translate/transform, implement (in relation to architectural and design projects) and convey the work to the public.

In addition to the above, the author (individual creator of the work) has moral (personal inalienable) rights such as the right to claim authorship of his work, the right to indicate or not indicate his identity, the right to integrity of the work and the right to make the work available to the public.

LEGAL FRAMEWORK
Part IV of Russian Civil Code governs copyrights.

Russia is also party of the main international copyright treaties and conventions such as Universal Copyright Convention, Convention for the Protection of Producers of Phonograms, Berne Convention, WIPO Performances and Phonograms Treaty and WIPO Copyright Treaty.

DURATION OF RIGHT
Copyright protection lasts for the life of the author plus an additional 70 years, starting from the first calendar year after the death of the author. The law provides certain specifics in relation to anonymous works or works published under pseudonym, to works published post mortem and for certain categories of authors (such as participants of the Second World War).

In the case of joint works, the duration of rights is determined in relation to the life of the last-surviving co-author.
Unless differently specified, with regard to neighboring rights, the period of protection is 50 years and occurs from the date of broadcasting or performance.

Personal inalienable rights never expire. Upon the death of the author, the rights may be enforced by the author’s heir(s). Furthermore, such rights cannot be waived.

**OWNERSHIP/LICENSES**

Joint ownership of copyright is recognized with regard to joint works.

Transfer of copyright ownership (exclusive rights to a work) is allowed and must be in writing for most types of use. In general, the transfer of one or more copies of a copyrighted work does not imply the transfer of the copyright, unless differently agreed.

**REMEDIES FOR INFRINGEMENT**

The copyright owner or exclusive licensee is entitled to the following primary remedies:

(i) demand to stop infringement;

(ii) demand to redress damages in full;

(iii) as an alternative to claiming damages, to demand the monetary compensation in the amount from 10,000 to 5,000,000 Russian Rubles, or in double amount of cost of originals of the work or imputed license fee; and

(iv) demand seizure of media bearing infringing objects.

Criminal penalties may also apply under certain circumstances.

**MASK WORKS**

**NATURE OF RIGHT**

The topography of a semiconductor product is a series of fixed or encoded correlated designs, representing the three-dimensional pattern of the layers that make up a semiconductor product.

Mask work owners have the exclusive right to totally or partly reproduce the topography in any method or shape and commercially exploit the mask work, in particular, keeping or distributing for commercial purposes or importing a topography or a semiconductor product in which the topography is fixed.

**LEGAL FRAMEWORK**

Part IV of the Russian Civil Code governs the protection of semiconductor topographies.

**DURATION OF RIGHT**

The protection is granted for ten years starting from the earlier of either the filing date of the application or the date when the semi-conductor containing the topography was put on sale for the first time in any part of the world.

**OWNERSHIP/LICENSES**

The owner of the mask work is the author that has expressed a creative intellectual effort resulting in a topography.
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**REMEDIES FOR INFRINGEMENT**
The owner of the mask work or an exclusive licensee is entitled to the following primary remedies:

(i) demand to stop infringement;

(ii) demand to redress damages in full; and

(iii) demand seizure of media bearing infringing objects.

Criminal penalties may also apply under certain circumstances.

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**PATENTS**

**NATURE OF RIGHT**
Patent protection is available for inventions that are deemed to be new, not obvious, and suitable for application in the industrial field.

From the grant of the patent, the patent owner has the exclusive right to forbid third parties from producing, using, trading in, selling or importing the product (should the invention be a product) or applying the method, or using, trading in, selling or importing the product that is directly obtained from the method (should the invention be a method).

There are separate legal provisions on protection of utility models and industrial designs (which have the basic regime of legal protection similar to that granted to inventions, but with certain distinctions).

**LEGAL FRAMEWORK**
Part IV of the Russian Civil Code governs patents.

Russia is a party to the Patent Cooperation Treaty and Paris Convention.

**DURATION OF RIGHT**
Patent protection lasts for 20 years from filing the application, based on a “first to file” principle.

**OWNERSHIP/LICENSES**
Ownership of (or exclusive right to) a patent may be transferred to third parties by means of assignment, as well as licensed, authorizing the exploitation of the patent within the limits determined by the parties. Transfers of ownership and exclusive licenses must be registered to be effective.

**REMEDIES FOR INFRINGEMENT**
The owner of the patent or an exclusive licensee is entitled to the following primary remedies:

(i) demand to stop infringement;

(ii) demand to redress damages in full; and

(iii) demand seizure of media bearing infringing objects.

Criminal penalties may also apply under certain circumstances.
Trademark protection is available to signs that can be represented graphically, provided that they are capable of distinguishing the goods or services of a company from those of other companies. In particular, it is possible to register words and their combinations (including personal names), drawings, the combination of both as well as less traditional marks such as three-dimensional marks, sounds etc. To qualify for protection, a trademark must be registered with the Russian Trademark Office (Rospatent) or protected in Russia by virtue of the Madrid Protocol.

The trademark owner has the right to forbid third parties from using a sign identical or confusingly similar to its trademark if it is used in relation to goods or services identical or similar to those for which the mark was registered. This also captures the use on the Internet, including within domain names. The enforcement of trademark rights against violation in relation to dissimilar goods and services is much more difficult, but might be possible in rare cases depending on circumstances (typically through an unfair competition action).

An unregistered trademark does not enjoy legal protection. The exception is taking the intensively used designation into account when confronting with bad faith applicants or users. However, this requires a significant amount of evidence and is resolved on a case-by-case depending on circumstances of each specific dispute.

**LEGAL FRAMEWORK**

Part IV of the Russian Civil Code governs trademarks.

Russia is a member of the Singapore Treaty and Madrid Convention and Protocol.

**DURATION OF RIGHT**

Trademark registration lasts ten years from the filing date (unless the registration is waived by the owner) and it can be renewed, within the date of expiration, for an unlimited number of times.

**OWNERSHIP/LICENSES**

A trademark can be transferred to a third party (legal entity or individual entrepreneur) by way of trademark assignment. A trademark can be the object of a license (including non-exclusive licenses) for all or part of the goods or services for which it was registered. Both trademark assignments and licenses must be registered with Rospatent.

**REMEDIES FOR INFRINGEMENT**

The trademark owner or exclusive licensee is entitled to the following primary remedies:

(i) demand to stop infringement;

(ii) demand to redress damages in full;

(iii) as an alternative to claiming damages, to demand the monetary compensation in the amount from 10,000 to 5,000,000 Russian Rubles, or in double amount of cost of counterfeit originals or imputed license fee; and

(iv) demand seizure or destruction of media bearing infringing objects.

Criminal or administrative penalties may also apply, under certain circumstances.
TRADE SECRETS

NATURE OF RIGHT
Trade secrets are defined as any company information of technical, economical, organizational, manufacturing and other nature, which:

(i) is kept secret by its holder;

(ii) has an economic value due to its secrecy; and

(iii) is subject to commercial secrecy regime.

The disclosure or unlawful use of trade secrets is a breach of the rights to commercial secrets.

LEGAL FRAMEWORK
Part IV of the Russian Civil Code governs trade secrets.

DURATION OF RIGHT
Trade secret protection is potentially perpetual should the owner be able to keep the information secret.

OWNERSHIP/LICENSES
The holder of the trade secret is the owner of such secret (joint ownership is possible). The right to trade secret may be assigned or licensed.

REMEDIES FOR INFRINGEMENT
The owner of the trade secret is entitled to demand to redress damages in full.

Criminal penalties may also apply under certain circumstances.

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

EMPLOYEES
The patentable and copyrightable works created by an employee in an employment context are deemed to be owned by the employer (unless the parties agree otherwise or, in case of patentable objects, unless the employer fails to timely formalize its patent rights). However, the employee is entitled to remuneration payable by the employer. While the law is more liberal in relation to copyright works and generally allows the remuneration for their creation to be part of the salary, for patentable works the stand-alone remuneration must be agreed on and paid.

The author retains personal inalienable rights to created objects in any case.

CONSULTANTS/CONTRACTORS
The above rules for employees do not automatically extend to non-employees, such as consultants and contractors. Unless the parties specify the allocation of intellectual property rights in a written contract, the respective intellectual property rights would generally vest on the creator and would not automatically be transferred to the party who ordered the respective work.
KEY COMMERCIAL CONTRACT CONSIDERATIONS

REGISTRATION OF COMMERCIAL AGREEMENTS
There is no general registration requirement with regard to commercial agreements, though some kind of contracts, such as contracts involving transfer of trademarks and patents, require a prior registration.

RECOGNIZED LANGUAGE OF COMMERCIAL AGREEMENTS
The agreement can be executed in any language. However, for agreements concluded with Russian consumers (B2C), the Russian version is necessary as its absence may entail the risk of consumer claims based on “lack of information on the goods.” Also, Russian counterparties may request a Russian translation for administrative purposes (such as tax inspections).

COUNTRY-SPECIFIC ISSUES FOR ONLINE TERMS
In relation to Internet-related infringements, under certain circumstances, the copyright owner or exclusive licensee may request the court to order blocking of an infringing website even before consideration of the case on the merits.

ENFORCEABILITY OF ONLINE/CLICKWRAP/SHRINKWRAP TERMS
There is still no established practice on acceptance/enforceability of online terms. In most cases, however, such online terms should be deemed binding if accepted by the addressee (e.g. by click method), and such accepting party can be identified in case of dispute.

GOVERNING LAW
The law can be freely chosen by the parties. However, the parties must consider the possibility of certain “super-imperative” provisions of Russian laws which may be applicable regardless of the choice of law (e.g. registration of contract, currency control regulations, consumer laws etc.).

KEY COMMERCIAL CONTRACT TERMS

ENFORCEABILITY OF WARRANTY DISCLAIMERS
Warranty disclaimers may be recognized as not valid if they contradict mandatory Russian legal provisions (especially, in the consumer context, where minimal statutory warranties in relation to specific goods or services are provided).

ENFORCEABILITY OF EXCLUSIONS/LIMITATIONS OF LIABILITY
The liability may be limited (but not entirely excluded) by the parties only in the B2B context, but even in that case, liability for willful actions cannot be limited or excluded.

INDEMNIFICATION
Indemnification is not a legal concept generally recognized as enforceable in Russia.
SAUDI ARABIA

INTELLECTUAL PROPERTY FRAMEWORK

Intellectual property rights are protected by laws that have been passed by Royal Decree and are enforced by the courts. All laws in the Kingdom of Saudi Arabia (KSA) are subject to Islamic principles found in Sharia law.

COMMERCIAL CONTRACT FRAMEWORK

Unlike a number of the Gulf Coast Council (GCC) jurisdictions, the KSA does not have a unified Civil Code or Commercial Code that governs commercial transactions.

The Ministry of Commerce and Industry has passed a large number of laws by Royal Decree that govern commercial activities in the KSA. Further, the Saudi Arabian Monetary Authority (SAMA) oversees banking activities in the KSA.

The interpretation and enforceability of commercial contracts is left to the courts, unless arbitration has been specified in any contract governing the relationship between parties.

As stated above, there is no umbrella Royal Decree that has been passed that captures commercial transactions, therefore, Sharia principles of contract law are applied, unless a specific issue is raised for which a specific Royal Decree has been passed (for example competition-related issues).

As a civil law jurisdiction, there is no concept of judicial precedent, which means that the decisions of the courts and other judicial authorities do not have binding authority in respect of another case. In addition, court cases are not generally published as a matter of course. This means that it is not always possible to reach a conclusive interpretation of laws and regulations or to understand how the courts would view a particular matter.

RECOGNIZED INTELLECTUAL PROPERTY RIGHTS

COPYRIGHTS

NATURE OF RIGHT
Copyright protection applies to works of Saudi and non-Saudi authors published, produced, performed or displayed for the first time in the KSA, and works of Saudi authors published, produced, performed or displayed for the first time outside the KSA, works of broadcasting organizations and producers of sound recordings and performers as well as works copyrighted pursuant to international agreements or treaties for protection of copyright to which the KSA is a party.

Copyright owners have the exclusive right to reproduce, distribute, prepare derivative works, publicly perform and publicly display their works of authorship.

An author of works has the following moral rights (Moral Rights): (i) to have the work attributed to himself or to have it published anonymously or under a false name; (ii) to object to any infringement of his work and prevent any amendment of the work; (iii) to make any amendment to or deletion
from his work, at his sole discretion; and (iv) to have the work withdrawn from circulation. These Moral Rights are permanent rights of the author and, significantly, cannot be subject to waiver, lapse or transfer (except to the heir(s) of the author in case of the author’s death).

Assignment by an author of all his future intellectual production is, under copyright law, also deemed to be null and void.

The application of Moral Rights and restrictions on future assignment have implications for the drafting of contracts and assignment documents.

Copyright law does not require registration of a copyright.

LEGAL FRAMEWORK
Copyrights are governed by Royal Decree No. M/41 (and its implementing regulations), passed in 2003.

DURATION OF RIGHT
The period of protection for an author is the duration of his life and 50 years following his death. Where the writing is part of a joint work, then the law considers the date of the last surviving author. If the writing is in the form of various parts or volumes then each volume is treated as a separate and independent piece of work.

The period of protection for audio works, audio-visual works, films, collective works and computer software is 50 years from the date of the first show or publication of the work.

The period of protection for applied arts (handcrafted or manufactured) and photographs shall be 25 years from the date of publication. Computation of the period starts in this case on the date of the first publication of the work.

The period of protection for broadcasting organizations shall be 20 years from the date of the first transmission of programs or broadcasted materials.

The period of protection for the producers of sound recordings and performers shall be 50 years from the date of performance or its first recording.

OWNERSHIP/LICENSES
Joint ownership of copyright is recognized; any transfer of a copyright must be recorded in writing and must express any limits to the scope of the transferred right with respect to time and place.

REMEDIES FOR INFRINGEMENT
The following remedies can be applied in the event of violation of copyright law:

(i) A warning to the violator;
(ii) A fine not exceeding ₨ 250,000 (the penalty may be doubled for a repeat offender);
(iii) Financial compensation and a separate cause of action for defamation where considered appropriate;
(iv) A temporary injunction;
(v) A temporary shutdown of the violating establishment for a maximum of two months (the penalty may be doubled for a repeat offender);

(vi) A suspension from participating in specific commercial events for a period of up to two years;

(vii) Confiscation of violating goods; and

(viii) A jail term of up to six months (the penalty may be doubled for a repeat offender).

MASK WORKS

NATURE OF RIGHT
There is no specific legislation that covers mask works, but the provisions relating to patents (below) and intellectual property rights (above) are broad enough to cover such works and therefore the details captured in each section could apply.

PATENTS

NATURE OF RIGHT
Patents are available for inventions, layout-designs of integrated circuits, plant varieties and industrial designs.

An application must be made to the General Directorate of Patents at King Abdulaziz City for Science and Technology (Directorate) for the protection of patent rights to apply, at which point the patent owner may grant a right to exclude others from making, using, selling, offering for sale and importing a protected invention.

LEGAL FRAMEWORK
Patents are governed by Royal Decree No. M/38 (and its implementing regulations), passed in 1989.

DURATION OF RIGHT
Patent protection (a patent, a certificate of layout-design, a plant patent, or a certificate of an industrial design) is valid for a period of 20 years from the date of filing the application.

A layout-design certificate protection (three-dimensional disposition of elements, at least one of which is active, and of some or all of the interconnections of an integrated circuit, or such a three-dimensional disposition prepared for an integrated circuit intended for manufacture) is valid for ten years from the date of filing the application for the same or ten years from the start of its commercial exploitation (but in any case no longer than 15 years).

An industrial design certificate protection (composition of two-dimensional lines or colors, or any three-dimensional shape that gives an industrial product, or a product of traditional crafts, a special appearance provided that this is not only for functional or technical purpose including textile designs) is valid for a period of ten years from the date of filing the application.
OWNERSHIP/LICENSES
The employer is the owner of the protected document unless an employment contract specifies otherwise. Any assignment of the patent or patent application must be in writing, signed by all parties and approved by an authority acceptable to the Directorate.

REMEDIES FOR INFRINGEMENT
Available remedies can include:

(i) An injunction;
(ii) A fine of up to ﷼ 100,000, the penalty may be double for a repeat offender;
(iii) A possible jail term (duration not specified);
(iv) Name and shame in two daily newspapers (the cost of which is borne by the party in breach); and
(v) Further criminal liability arising from other laws.
Criminal penalties may also apply under certain circumstances.

TRADEMARKS

NATURE OF RIGHT
Trademarks include names, distinct shapes, signatures, words, letters, numbers, drawings, symbols, stamps and protruding inscriptions or any other sign or combination thereof which can be recognized by sight and suitable to distinguish industrial, commercial, vocational or agricultural products or a project to exploit forests or natural resources or to indicate that the object upon which the trademark is put belongs to the owner of the trademark on grounds of manufacture, selection, invention thereof, or trading therewith, or to indicate the rendering of a certain service.

An application must be submitted to the trademark register within the Ministry of Commerce. The holder of a validly registered trademark may refuse or grant a right to others from using the same.

LEGAL FRAMEWORK
Trademarks are governed by Royal Decree No. M/21 (and its implementing regulations), passed in 2002.

DURATION OF RIGHT
The period of protection for a trademark is ten years, with the right to renew during the last year of the existing registration of the trademark.

OWNERSHIP/LICENSES
Joint ownership of a trademark is recognized. A trademark may be sold, mortgaged or licensed out by the registered owner.
REMEDIES FOR INFRINGEMENT
 Remedies for trademark infringement can include:

(i) a jail sentence of up to one year for a forger or for the intentional use of a trademark of another, or for selling a product knowing it illegally uses the trademark of another; the penalty may be double for a repeat offender;

(ii) a fine of up to $50,000 for a forger or for the intentional use of a trademark of another, or for selling a product knowing it illegally uses the trademark of another; the penalty may be double for a repeat offender;

(iii) closure of business premises for between 15 days and six months; and

(iv) right of wronged party to seek compensation/damages.

TRADE SECRETS

NATURE OF RIGHT
 A commercial secret is defined as information not known in its final form or where information is not usually easily obtainable by those engaged in this type of business, as well as where the information is of commercial value due to its confidentiality, and where the rightful owner takes reasonable measures to maintain its confidentiality under its current circumstances.

LEGAL FRAMEWORK
 Ministry of Commerce and Industry Decision No. 3218 (as amended), passed in 2005 governs trade secrets.

DURATION OF RIGHT
 As long as reasonable efforts are taken by the owner of the information to maintain the information as a trade secret, then the duration of the right is potentially perpetual.

OWNER SHIP/LICENSES
 Trade secrets or know-how licenses are enforceable.

REMEDIES FOR INFRINGEMENT
 Remedies include a claim for compensation for damages.

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

EMPLOYEES
 There are no regulatory protections that cover employees in Ministry of Commerce and Industry Decision No. 3218. However, agreed confidentiality provisions in an employment contract may grant certain levels of protections, although there are no precedents in the court of law relating to employee-employer’s trade secrets protection.

CONSULTANTS/CONTRACTORS
 There is no regulatory protection that cover consultants and contractors in Ministry of Commerce and Industry Decision No. 3218. However, agreed confidentiality provisions in a consultancy contract may grant certain levels of protections, although there are no precedents in the court of law relating to trade secrets protection for consultants specifically.
Key Commercial Contract Considerations

Registration of Commercial Agreements
There is no legal requirement for commercial contracts to be registered (except agency, distribution and franchise agreements which generally require registration, and must satisfy certain conditions in order to be registered).

Recognized Language of Commercial Agreements
The preferred language for commercial agreements is Arabic. Where a potential dispute may arise, then the courts will consider all documents in Arabic; where there is a discrepancy between the Arabic version of any document and any other language, then the Arabic version will prevail.

Enforceability of Online/Clickwrap/Shrinkwrap Terms
We are not aware of any decided court precedent relating to the enforceability of online terms. Therefore, online terms should be reviewed and advised on a case-by-case basis.

Governing Law
In practice, Saudi Arabian Courts tend to apply Saudi Arabian law to all disputes falling under their jurisdiction, regardless of the parties' agreement.

Key Commercial Contract Terms

Enforceability of Warranty Disclaimers
Warranty disclaimers are regularly used in commercial contracts and can be enforceable. However, such disclaimers must not waive the core elements of a party's commitment or obligations under the contract, such as, for example, delivery of goods in a distribution agreement. Any disclaimer language must be evaluated for enforceability with this principle in mind, and this will be determined on a case-by-case basis.

Enforceability of Exclusions/Limitations of Liability
Under Saudi Arabian law, limitations of liability are rarely enforced even if the parties to a commercial contract agree to such limitation.

Indemnification
Indemnification is rarely available in the KSA, unless a detailed evaluation of damages is presented to the court. In general, enforceability of an indemnification obligation is subject to court evaluation and discretion.
SINGAPORE

DLA Piper Singapore is not permitted to practice Singapore law pursuant to local regulation. If you require further details, please contact John Goulios (john.goulios@dlapiper.com) and we will assist with the obtaining of any specific Singapore legal advice.

INTELLECTUAL PROPERTY FRAMEWORK

Intellectual property rights are governed by a body of local legislation in Singapore such as the Intellectual Property Office of Singapore Act (Cap. 140), Patents Act (Cap. 221), Copyright Act (Cap. 63) and Trademarks Act (Cap. 332) among others. The Intellectual Property Office of Singapore oversees and advises on the application of this legislation.

COMMERCIAL CONTRACT FRAMEWORK

Singapore contract law is largely based on English common law though in some cases, the precedent set by common law has been modified by statute. While there is no Contracts Act, the law has been codified in areas such as rights of third parties under contracts (Contracts (Rights of Third Parties) Act (Cap. 53B)), unfair contract terms (Unfair Contract Terms Act (Cap. 396)) and restitution (Frustrated Contracts Act (Cap. 115)).

RECOGNIZED INTELLECTUAL PROPERTY RIGHTS

COPYRIGHTS

NATURE OF RIGHT
Copyright protects literary, dramatic, musical and artistic works. The copyright owner has an exclusive right to engage in certain acts in relation to the copyrighted work, such as reproduction or publishing.

In order for a copyright to be applicable, the work must be original and exist in tangible form such as a writing or a recording.

Copyright does not need to be registered. The author of a work to which copyright applies automatically enjoys copyright protection as soon as the work is expressed in a tangible form.

LEGAL FRAMEWORK
The framework for the protection of copyright in Singapore is found in the Copyright Act (Cap 63). Singapore also acceded to the Berne Convention on September 21, 1998 which came into force in Singapore on December 21, 1998. Any artistic work which is applied to a product and industrially produced will no longer fall under the protection of the Copyright Act and instead the Registered Designs Act (Cap. 266) will apply.
DURATION OF RIGHT

The duration of copyright varies according to the type of work concerned. Copyright in a literary, dramatic, musical or artistic work shall be effective for 70 years from the end of the year in which the author died. Copyright in published editions of literary, dramatic, musical or artistic works shall be effective for 25 years from when the edition was first published. Copyright for sound recordings and films shall be effective for 70 years from the end of the year in which the sound recording or film was first published. Copyright for broadcastings shall be effective for 50 years from the end of the year of making the broadcast or cable program. Copyright in performances shall be effective for 70 years from the end of the year of the performance.

OWNERSHIP/LICENSES

Generally, the creator owns the copyright. However, if an employee creates a work according to the terms of his employment contract, the employer will own the copyright and in the case of a journalist working for a newspaper or magazine, the owner of the newspaper or magazine owns the copyright of the publication in any newspaper or magazine but the employee owns the remaining rights that make up the copyright bundle of exclusive rights. If a portrait/photograph/engraving work is commissioned, the person who has commissioned the work will own the copyright. If any other sort of work is commissioned the commissioned party shall hold the copyright unless agreed otherwise in writing. Copyright owners may transfer their rights to other parties either partially or wholly.

REMEDIES FOR INFRINGEMENT

The owner of a copyright may bring an action for an infringement of the copyright. The types of remedies available include injunction, a monetary award (e.g., damages, an account of profits, statutory damages) or an order for delivery of and disposal of the infringing copies.

MASK WORKS

NATURE OF RIGHT

An original layout-design is one which is both the result of the creator’s own academic effort and which is not commonplace among creators and manufacturers of integrated circuits at the time it is created.

It is not necessary to file an application to protect the layout-design. A citizen or resident of Singapore, or a country which is a member of the WTO or a country designated by the Singapore Government as a qualifying country, who owns a layout-design, gains automatic protection for the layout-design if it qualifies for protection under Singapore law.

LEGAL FRAMEWORK

In Singapore, an original layout-design can be protected under the Layout-Designs of Integrated Circuits Act (Cap. 159A).

DURATION OF RIGHT

Any integrated circuit which is created after February 15, 1999 will be protected for ten years if it is first used commercially within five years of creation. In other cases, it will be protected for 15 years from the date of its creation.
OWNERSHIP/LICENSES
Unless otherwise agreed, the owner of a layout-design would be the creator or, if the design was created in the course of employment or under a commission, the owner would be the employer or person who commissioned the design.

REMEDIES FOR INFRINGEMENT
Under the Layout-Designs of Integrated Circuits Act, the owner has the right to prevent the copying and commercial exploitation of an original layout-design. The owner may take whatever proceedings and seek whatever remedies that are available for any other property rights. The usual remedies are damages, injunctions and an account of profits. In addition, the court may award additional damages depending on the circumstances of the case, including the flagrancy of the infringement and any benefit obtained by the defendant by reason of the infringement.

The court may make an order for delivery up to the owner of any infringing integrated circuit or any article used to make integrated circuits in which a protected layout-design is incorporated. An order for the disposal or destruction of the infringing articles may also be awarded.

PATENTS

NATURE OF RIGHT
A patent is a right granted to the owner of an invention that prevents others from making, using, importing or selling the invention without his permission.

For an invention to be patentable, it must be: new, involve an inventive step and be capable of industrial application.

LEGAL FRAMEWORK
The protection of patents in Singapore is regulated by the Patents Act (Cap 221). Under the Patents Act an application may be made to the Registry of Patents for the grant of a patent.


DURATION OF RIGHT
Once it is granted, the term of a patent is 20 years from the date of filing, subject to the payment of annual renewal fees.

OWNERSHIP/LICENSES
Patent owners may license their patents to a third party.

REMEDIES FOR INFRINGEMENT
The patent proprietor and his licensees are entitled to take legal action against an infringing party. Remedies available to the patent owner include applying for an injunction to stop the infringing action, demanding for the profits gained by the infringing party or seeking damages for the loss suffered.
TRADemarks

Nature of Right
A trademark is a sign that one can use to distinguish its goods or services from those of others.

Registration of a trademark gives the owner the exclusive right to use (and to authorize others to use) the mark for the goods or services for which the mark is registered.

Legal Framework
Trademark registration in Singapore is governed by the Trade Marks Act (Cap. 332). It is not compulsory to register a trademark in Singapore; one may also rely on rights under the common law doctrine of “passing off” to protect a trademark.


Duration of Right
A trademark can last indefinitely but an owner must renew the registration every ten years.

Ownership/Licenses
The owner of a trademark may authorize others to use their trademark by way of license or assignment.

Remedies for Infringement
Remedies available to the owner of a trademark include injunction, a monetary award (damages, an account of profits and statutory damages), and an order for erasure of the offending sign or for disposal of the infringing goods.

trade secrets

Nature of Right
A trade secret is information that is important to a business or company and is not known to the public. A trade secret can include a method or technique that would give a business or company an edge over its competitors.

Not all information will be considered a trade secret. The courts will look at various factors to determine if information constitutes a trade secret, such as if the information was confidential to the business, if the information has been revealed in breach of a promise of confidence and if the information has been used in an improper way that has resulted in financial damage to the business/company.

No registration procedures are required to protect a trade secret.

Legal Framework
The law on the protection of confidential information protects ideas and information not in the public domain, including trade secrets. This law is not codified in Singapore and is generally contractually controlled.
DURATION OF RIGHT
There is no specified time limit within which the secret may be protected.

OWNERSHIP/LICENSES
Information shall be owned by the business and such information will be protected as a secret from everyone except certain key individuals within the business or company and can be divulged within perimeters set by these key individuals on behalf of the company.

REMEDIES FOR INFRINGEMENT
When a trade secret is leaked, an action may be taken for breach of confidence as a leak of the secret may be unfair to the business and may have harmful consequences. Remedies for breach of contract will be available if appropriate.

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

EMPLOYEES
It is commonplace for employers to include confidentiality clauses in employment agreements in Singapore.

If work or a design is created by an employee in the course of his employment the trademark or registered design will be owned by the employer rather than the employee.

CONSULTANTS/CONTRACTORS
It is commonplace for contractors and consultants to be subject to confidentiality clauses in Singapore.

If a piece of work is commissioned, the person who commissioned the work, rather than the creator, will generally be the owner of the copyright (subject to the information detailed above).

KEY COMMERCIAL CONTRACT CONSIDERATIONS

REGISTRATION OF COMMERCIAL AGREEMENTS
There is no registration requirement for contracts in Singapore.

RECOGNIZED LANGUAGE OF COMMERCIAL AGREEMENTS
Generally, English is the language used in commercial agreements.

ENFORCEABILITY OF ONLINE/CLICKWRAP/SHRINKWRAP TERMS
Online/Clickwrap/Shrinkwrap contracts are generally enforceable in Singapore. Online transactions are regulated by the Electronic Transactions Act (Cap. 88). This sets out the regulations surrounding the formation of contracts through online and electronic means and enforceability of these contracts.

GOVERNING LAW
The governing law and venue for resolution of disputes specified in a commercial contract will generally be accepted and recognized by the courts. It should be noted that the use of Singapore Law as governing law and the Singapore International Arbitration Centre as the forum for any disputes has become increasingly common.
ENFORCEABILITY OF WARRANTY DISCLAIMERS
Warranty disclaimers are widely used in Singapore and are enforceable.

ENFORCEABILITY OF EXCLUSIONS/LIMITATIONS OF LIABILITY
Exclusions and limitations of liability are common and generally enforceable in Singapore. However, this is subject to Section 3(2)(a) of the Singapore Unfair Contract Terms Act (Cap. 396). In a contract where one party is a consumer or is subject to the other party’s written standard terms of business, the other party cannot exclude or restrict his liability if the other party is in breach of the contract, except if such an exclusion or restriction satisfies the requirement of reasonableness.

INDEMNIFICATION
Express indemnities stated in contracts are common and enforceable and generally respected in Singapore. However, this is subject to Section 4(1) of the Singapore Unfair Contract Terms Act (Cap. 396), which clarifies that a contract cannot require a consumer to indemnify another person (whether a party to the contract or not) for liability that may be incurred by the other party for the consumer’s negligence or breach of contract.
SOUTH KOREA

INTELLECTUAL PROPERTY FRAMEWORK

As a general matter, intellectual property rights are governed by various Korean intellectual property statutes, including the Patent Act (PA), the Copyright Act (CA), the Utility Model Act, the Trademark Act (TMA), the Design Protection Act, the Unfair Competition Prevention and Trade Secret Protection Act (UCPA) and the Semiconductor Chip Act (SCA).

COMMERCIAL CONTRACT FRAMEWORK

The Civil Code, the Commercial Code (KCC) and the Standard Terms Control Act (STCA) are the primary statutes that govern private and commercial contracts. The Monopoly Regulation and Fair Trade Act (FTA) is relevant to antitrust laws, and there are industry-specific regulations that may be applicable to contracts in particular industries.

Commercial contracts with national and local government agencies are subject to additional laws and governmental regulations, which can include among other matters, specific bidding requirements as well as a grant of intellectual property rights to the government by default.

RECOGNIZED INTELLECTUAL PROPERTY RIGHTS

COPYRIGHTS

NATURE OF RIGHT

Copyright protection arises upon creation of an original copyright work without any formality. Copyright registration is not a prerequisite for copyright protection or enforcement, although it provides certain statutory presumptions that give advantages in enforcement. Protection under the CA applies to any creative work that expresses ideas or sentiments of mankind.

The copyright holder who has the right to reproduce and distribute a work (initially, the author) may license or assign the right of publication to a person who intends to publish the work (whether in writing or drawing).

LEGAL FRAMEWORK

Copyrights are governed by the CA. Korea has also acceded to the Universal Copyright Conventions, the Berne Convention, the Rome Convention, the Geneva Phonograms Convention, the GATT, the TRIPS Agreement, the WIPO Copyright Treaty, and the WIPO Performances and Phonograms Treaty.

DURATION OF RIGHT

An individual author can enjoy copyright protection for 70 years after his death (an individual author of a cinematographic work or a computer program can enjoy copyright protection for 70 years from the date of its publication) and the copyright protection term for a work made for hire is 70 years after the date of its publication.
OWNERSHIP/LICENSES
Joint ownership of copyrights is recognized. To exercise copyrights in a jointly owned work, consent from all joint owners are required. Both exclusive and non-exclusive licenses are available.

REMEDIES FOR INFRINGEMENT
Remedies available for infringement are:

(i) criminal action;
(ii) preliminary injunction;
(iii) permanent injunction; and
(iv) damages.

Under the CA, infringement of a copyright is punishable by imprisonment of up to five years or a fine of up to ₩50 million ($50,000), as determined based on the particulars of each case.

In addition, the CA also provides for imprisonment of up to three years or a fine of up to ₩30 million ($30,000), if:

(i) a claimant uses the information on an infringer that has been received from an online service provider for purposes other than the intended purpose of pursuing a legal action against the infringer;
(ii) if a person manufactures or distributes equipment that descrambles or decodes encrypted broadcast signals;
(iii) if a person forges copyright labels to be attached to a work (e.g., a DVD), or transacts labels beyond the permitted scope; or
(iv) if a person emits signals to a third party without legitimate authority before the work is broadcast.

Also, a person who watches, listens to or transmits illegally descrambled broadcast signals or records or publicly transmits a cinematographic work on video tape without receiving proper permission from the copyright holder will also face up to one year imprisonment or a fine of up to ₩10 million ($10,000).

The CA generally provides copyright holders with the ability to claim for damages and the right to demand restoration of reputation, depending on what may be appropriate given the nature of infringement.

The CA introduces a system of statutory damages, which takes into account the difficulty in assessing the amount of actual damages suffered as a result of copyright infringement. Under this system, a copyright holder may now claim up to ₩10 million ($10,000) in statutory damages (or ₩50 million ($50,000) for intentional copyright infringement for profit) for each copyrighted work.

Another alternative is to seek administrative remedies through the Ministry of Culture, Sports and Tourism, which grants to certain government officials the authority to confiscate and destroy any illegal or unauthorized reproduction of copyrighted works. The officials may also order the infringer to delete any illegal or unauthorized reproduction online.
MASK WORKS

NATURE OF RIGHT
The SCA defines a protectable layout-design as a plane or three dimensional design of circuit elements and wires connecting those elements such that the design could be used in manufacturing an integrated circuit topography. Registration is necessary for protection under the SCA. If the registered layout-design lacks creativity, it may be cancelled.

LEGAL FRAMEWORK
Circuit layout-design protection is governed by the SCA.

DURATION OF RIGHT
The term is ten years from the date of registration. However, the term shall not exceed ten years from the date when the registered layout was first used for commercial purposes or 15 years from the date when the registered design was created.

OWNERSHIP/LICENSES
Joint ownership of layout-design rights is recognized. Both exclusive and non-exclusive licenses are available.

REMEDIES FOR INFRINGEMENT
A person who infringes the layout-design right or exclusive license is subject to imprisonment for a term of up to three years or a fine of up to ₩50 million ($50,000). This offense may be prosecuted only upon filing of a criminal complaint by the holder of a layout-design right.

A preliminary or permanent injunction may be sought against infringers of the layout-design right. Compensation for damages may also be sought in a civil action.

PATENTS

NATURE OF RIGHT
Patents are examined and granted by the Korean Intellectual Property Office (KIPO). A patent may be granted for a new and industrially applicable invention. The industrial applicability requirement is often discussed when an invention is directed to the treatment of humans or involve the human body as an indispensable element, such as surgical methods and methods of treatment of humans.

Inventions that are likely to injure public order, morality or public health are unpatentable in Korea. Further, under the PA, technical information made public through the Internet may be also regarded as prior art.

LEGAL FRAMEWORK
The legislation governing registered patents is the PA.

DURATION OF RIGHT
Under the PA, the term of a patent is 20 years from the filing date of the application.
As for a patent application filed on or after March 15, 2012, the term may be extended to compensate for unreasonable delays during the prosecution of the application, where the delay is caused by KIPO. If the registration of a patent is delayed for more than four years from the filing date of the application or more than three years from the request for examination, whichever is later, the patent term can be extended for a period equal to the delay occurred. Any delays attributable to the applicant will not be included in the patent term adjustment period. The above patent term adjustment is not automatically granted by KIPO and may be awarded only upon a petition by the applicant within three months from the registration date of a patent.

**OWNERSHIP/LICENSES**
Joint ownership of patents is recognized. Both exclusive and non-exclusive licenses are available.

**REMEDIES FOR INFRINGEMENT**
The remedies available for infringement are:

(i) criminal sanction (quite rare);
(ii) preliminary injunction;
(iii) permanent injunction; and
(iv) damages.

**TRADEMARKS**

**NATURE OF RIGHT**
A trademark is defined as any of the following, which is used on goods related to the business of a person who carries on business activities, such as producing, processing, certifying or selling such goods, to distinguish them from the goods of others:

(i) a sign, character, figure, three-dimensional shape, color, hologram, motion or any combination; and

(ii) any other visually recognizable characteristics.

A service mark is a mark that is used by a person who carries on a service business to distinguish such business from those of others. Except as otherwise expressly provided for under the TMA, the provisions under the TMA relating to trademarks shall apply to service marks as well.

Rights in a trademark based on prior use are only minimally protected, with the exception of “well-known” trademarks. The owner of a well-known, unregistered trademark may prevent others from using or registering a similar mark or may bring an invalidation action against such a registration. As it may be difficult to establish the well-known status of a trademark, registration of trademarks is highly advisable to secure protection.

**LEGAL FRAMEWORK**
Protection of trademarks is governed by the TMA and the UCPA.

**DURATION OF RIGHT**
The term of protection is ten years from registration, renewable indefinitely as long as the prescribed fees are paid.
OWNERSHIP/LICENSES
Joint ownership of trademarks is recognized. Both exclusive and non-exclusive licenses are available.

REMEDIES FOR INFRINGEMENT
The remedies available for infringement are:

(i) criminal sanction;
(ii) preliminary injunction;
(iii) permanent injunction; and
(iv) damages.

TRADE SECRETS
Nature of Right
The UCPA defines “trade secret” to mean information of a technical or managerial nature that can be used in business activities (including production or marketing methods), is generally unknown to the public, possesses independent economic value and the secrecy of which is maintained through substantial effort.

The UCPA defines infringement of a trade secret to include the following:

(i) Acquiring a trade secret through larceny, embezzlement, coercion or other improper methods (i.e., an illegal acquisition), or subsequently using or revealing an acquired trade secret (including the revelation of the trade secret to certain people while generally maintaining the confidentiality of the trade secret);

(ii) Acquiring a trade secret knowing (or being grossly negligent in not knowing) that it was the subject of illegal acquisition, or subsequently using or revealing a trade secret so acquired;

(iii) Using or revealing a trade secret having learned (or being grossly negligent in not learning) subsequent to the acquisition of the trade secret that it was the subject of an illegal acquisition;

(iv) Using or revealing a trade secret in breach of a contractual or other obligation to maintain that trade secret for purposes of acquiring an improper benefit or harming the owner of the trade secret;

(v) Acquiring a trade secret knowing (or being grossly negligent in not knowing) that the trade secret had been revealed in the manner set out in item (iv) above, or that the trade secret had otherwise been the subject of such revelation, or subsequently using or revealing a trade secret so acquired; and

(vi) Using or revealing a trade secret having learned (or being grossly negligent in not learning) subsequent to the acquisition of the trade secret that the trade secret had been revealed in the manner set out in item (iv) above, or that the trade secret had otherwise been the subject of such revelation.
LEGAL FRAMEWORK
Trade secrets are protected by the UCPA and the Act on Protection and Prevention of Disclosure of Industrial Technology (Industrial Technology Act) in Korea.

DURATION OF RIGHT
The term of protection is potentially perpetual as long as the prescribed definition is met.

OWNERSHIP/LICENSES
Joint ownership is possible. Trade secret (know-how) licenses are enforceable.

REMEDIES FOR INFRINGEMENT
Trade secret misappropriation in violation of the UCPA is punishable by up to five years of imprisonment or a fine of at least twice (not to exceed ten times) the pecuniary amount gained from such acts. The penalty is aggravated in case the trade secret is used overseas or disclosed to a third party knowing that such trade secret will be used overseas (maximum ten years of imprisonment, the fine is the same as above). In addition, the employer (company or an individual) of an employee who committed acts in violation of the law is vicariously liable unless the employer can prove that it was not negligent in preventing such act.

A person who commits illegal use or disclosure of Industrial Technology shall be punished by imprisonment of up to five years or by a fine of up to ₩500 million ($500,000). However, in case any of the such acts are committed to “use the industrial technology overseas” or “with the purpose of using the industrial technology overseas” the penalty is increased to imprisonment of up to ten years or by a fine of up to ₩1 billion ($1 million). Similar to the UCPA, the employer (company or an individual) of an employee who committed acts in violation of the law is vicariously liable unless the employer can prove that it was not negligent in preventing such act.

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

EMPLOYEES
In Korea, the right to a patent belongs to the inventor or his successor in title. The right to a patent may be transferred by assignment, in whole or in part. An inventor has the right to be identified in a patent application. Conversely, the applicant for a patent application need not be the inventor, as the right to a patent may be transferred before the filing of the application, e.g., by contract or inheritance.

The Invention Promotion Act (IPA) defines a “work for hire” invention as an invention that results from: (i) present or past duties of the employee and (ii) being within the scope of the employer’s business. Unless otherwise stipulated, the ownership of a “work for hire” invention belongs to the inventor-employee. In the meantime, the employer is given a royalty-free and non-exclusive license (often called ‘shop right’) to use the invention if the employee is a small or medium sized entity defined under the Small or Medium Sized Entity Framework Act (SME). In order for an employer who is not an SME to receive a non-exclusive license, the employer must have a contract or employment regulation where the employee agrees to assign the “work for hire” inventions to the employer in advance and which has to be executed or adopted after consultation with the employee.
In this regard, the employee must report the completion of the works made for hire to his employer (when two or more employee-inventors contributed to the invention, all of the employee-inventors must report together). The employer must notify in writing whether it plans to succeed the works made for hire or not within a certain period from the above invention completion report by the employee. However, if the employer fails to make such notification in writing, the works made for hire are deemed as free inventions of the employee.

The employee is entitled to ‘reasonable compensation’ for any “work for hire” invention acquired by the employer. Further, the IPA provides several factors for determining the compensation:

(i) The employer is required to adopt an internal compensation rule and provide the employees with adequate details about the program in writing, including the type of compensation, criteria for determining the amount of compensation and the payment method;

(ii) The employer is required to provide the inventor employee with adequate details in writing, regarding the compensation amount, including how the amount was derived based upon the above rules;

(iii) The employer is required to consult with the employees regarding adoption or amendment of the above compensation rule; if an amendment is pursued that is less favorable to the employees, the employer is required to obtain consent from at least 50% of the employees;

(iv) In addition to the above requirements, the compensation must be determined in consideration of the profits that the employer gained or expects to gain from the in-service invention and the degree of contribution by the employer and the employee to the creation of the particular invention; and

The IPA also stipulates that even if a patent application is not filed for a “work for hire” invention acquired by an employer, the employee is still entitled to reasonable compensation.

CONSULTANTS/CONTRACTORS

It is customary for consultants and contractors to sign written agreements. Absent a written assignment of developments, in principle, consultants and contractors will retain ownership of the intellectual property developed by them. However, depending on various factors such as price paid to consultants or contractors and degree of contribution in planning and developments, ownership in developments can be deemed assigned.

KEY COMMERCIAL CONTRACT CONSIDERATIONS

REGISTRATION OF COMMERCIAL AGREEMENTS

In Korea, either non-exclusive or exclusive licenses may take effect contractually between the parties without registration. However, if the exclusive licensee wishes to create a right that can exclude a third party from practicing the licensed patent, registration is necessary. Further, in either case of non-exclusive or exclusive licenses, a registered right of the licensee is honored in the event that the licensed patent is assigned to a third party, but unregistered right of the licensee does not have such an effect.
Registration does not ensure that a licensor’s bankruptcy administrator will not decline to perform obligations under a license agreement or revoke a license agreement under applicable law of bankruptcy. However, assuming that the administrator does not decline the license obligations or revoke the license agreement, registration will be beneficial if the licensed patents are transferred to a third-party purchaser in connection with the licensor’s bankruptcy. In other words, if the license is registered, the purchaser cannot acquire the patents free of the license.

A third-party purchaser will acquire a patent free of any existing license unless the license is registered. In contrast, if the license is registered, the license is enforceable to a third-party purchaser in the way that the third party purchaser acquires the patent subject to the pre-existing license.

The above applies to trademarks, utility models, designs and registered copyrights.

**RECOGNIZED LANGUAGE OF COMMERCIAL AGREEMENTS**

Any language agreed between parties can be adopted as governing language of a contract. However, the STCA requires that standardized contract terms be provided in language and expression that can be easily understood by customers. Providing the standardized contract term in Korean can be a positive factor in meeting the requirement in case of standardized contracts, but the positive effect is not so significant in case of large business entity customers.

**COUNTRY-SPECIFIC ISSUES FOR ONLINE CONTENT**

The CA sets out a detailed list of the requirements for exempting an online-service provider from liability for carrying infringing materials. Subject to these requirements, a service provider must confine itself to acting as a mere conduit, to caching, to hosting, and to searching information in order to escape liability and to avoid responsibility for monitoring or investigating for infringing acts. To some degree these safe-harbor provisions resolve the uncertainty previously surrounding the liability of online-service providers for direct infringement by their users. However, they also make it easier to impose liability on online-service providers if the requirements are not met.

**ENFORCEABILITY OF ONLINE/CLICKWRAP/SHRINKWRAP TERMS**

The Electronic Transactions Basic Law (ETBL) stipulates that an electronic document shall not be denied its validity only because it takes an electronic form, unless otherwise provided in other laws. Nor is there any law that restricts the effectiveness and enforceability of a contract in an online form.

For standardized contracts which we understand will be the case for most agreements executed via a web interface, the validity and effectiveness of such agreements will depend on meeting the requirements of the STCA. There is no black-letter law on what would be an acceptable form in an on-line setting to satisfy the foregoing requirements. However, it is widely accepted that a mere posting of the contract and its terms and conditions on a website would not be sufficient. Commonly used methods to meet this requirement include the posting of the online contract with an “I accept” button at the end (which can be clicked only if the counter-party had scrolled the screen to the bottom) or having a pop-up window show up with an explanation of the major terms and conditions and then having the other party click an “I understand” button.
GOVERNING LAW
While the choice of law agreed by parties is generally respected by the Korean Court and thus designating a foreign law for a contact would be valid, the Korean Court may apply mandatory Korean laws and deny the application of the selected foreign law which violates Korean public order and good morals.

In general, the forum selection agreed between the parties is enforceable under Korean law. In order to select a foreign court as exclusive jurisdiction (and contractually preclude the jurisdiction of Korean Courts), however, Korean Courts require that (i) the case is not under exclusive jurisdiction of Korean Court under Korean law; (ii) the foreign court in question selected by the parties has valid jurisdiction under the laws of the foreign court; (iii) the case has reasonable connection with the foreign jurisdiction; and (iv) the agreement on the exclusive jurisdiction is not grossly unreasonable or unfair.

KEY COMMERCIAL CONTRACT TERMS

ENFORCEABILITY OF WARRANTY DISCLAIMERS
Under the KCC, a seller is obligated under a statutory warranty to ensure that the product sold is not defective, unless the buyer was or should have been aware of the defect before it accepted the product. If defects are found in the product sold, the Korean law subjects the seller to the warranty liabilities vis-à-vis the purchaser.

ENFORCEABILITY OF EXCLUSIONS/LIMITATIONS OF LIABILITY
Under Korean law, damage claims are made for compensation of (i) ordinary damages and (ii) extraordinary damages. Ordinary damages are those that would normally be expected to result from a breach of contract or a particular tort. Extraordinary damages refer to all other damages than ordinary damages that arise from the special circumstances which the wrongdoer "knew" or "could have reasonably foreseen." Parties may validly agree to exclude indirect damages from compensation, limit indemnification for indirect damages, or exclude warranty liability. However, enforceability of such agreement may be restricted by (i) public policy and general principles of equity under the KCC and (ii) the court invalidating a clause that exempts a breaching party from liability for intentional wrongdoing or gross negligence on the part of that party. However, in practice, many companies provide for a damage cap despite the risk that such damage cap provision may be held unenforceable.

INDEMNIFICATION
As a general rule under Korean civil law, if a contract obligates a putative indemnitor to defend any third-party claim raised against an indemnitee, the indemnitor will have a contractual duty to assume the defense.
GUIDE TO GOING GLOBAL - INTELLECTUAL PROPERTY AND TECHNOLOGY

SPAIN

INTELLECTUAL PROPERTY FRAMEWORK

The Spanish Constitution establishes in the Article 149.1.9 that intellectual property rights shall be governed by Spanish National Statutes only. Self-Governing Regions (the Spanish equivalent of US states or German Länder) are not entitled to issue laws in this field.

COMMERCIAL CONTRACT FRAMEWORK

Although the Spanish Constitution establishes at Article 149.1.6 that commercial legislation is reserved to Spanish National Statutes, the powers of the Self-Governing Regions in the field of “trade” and “consumer protection” and the existence of regional limited Civil Codes cause interferences between different sources of legislation. In addition, Spanish National legislators have preferred over the last five decades to draft separate laws for each commercial contract/commercial law issue, instead of merging them into the pre-existing Code of Commerce. As a result, commercial issues are considered under the light of the two old Codes but also of the new National laws (Agency Act, Unfair Competition Act, Franchising Royal Decree, Retail Trade Act, Consumer In Addition Act, Mobile Property Pledge Act) and of the regional laws and regulations.

RECOGNIZED INTELLECTUAL PROPERTY RIGHTS

It is important to point out that under Spanish Law there is a strong culturally-based divide inside the international category of “intellectual property.” Copyright and rights of authorship are branded as “intellectual property” while rights regarding patents and trademarks, are branded as “industrial property”. Contractual definitions should take this into account to avoid undesired outcomes.

COPYRIGHTS

NATURE OF RIGHT

All original literary, artistic or scientific works are protected by copyright, in particular, books, music compositions, audiovisual works, projects, plans, graphics, and databases. Computer programs are also protected by copyright and with certain exceptions, are treated in the same way as literary works.

Registration is not required for valid copyright protection. However, works that qualify for copyright protection may be registered on the Copyright Register and/or filed with a Notary Public in order to serve as stronger evidence. Copyright protection is automatic and the rights arise at the time the work is created.

Copyright owners have the exclusive right to reproduce, distribute, prepare derivative works, publicly perform and publicly display their works of authorship.
LEGAL FRAMEWORK

In addition, Spain is party to the Berne Convention.

DURATION OF RIGHT
Copyright protection is generally granted for 70 years from the death of the author where the author is a natural person. In those cases in which the author is a legal person, the term of protection is 70 years from January 1 of the year following that in which the work was lawfully published, or following the year of its creation, if the work was not published. It should be noted that copyright of works owned by authors who died before 1988 may benefit from longer protection terms. Some types of works/rights do benefit from shorter terms only.

OWNERSHIP/LICENSES
The Legislative Royal Decree 1/1996 on Intellectual Property provides that copyrights in a work belong to the author, who is the person or group of persons who creates the work.

Economic rights of copyright owners may be transferred to third parties. All transfers must be formalized in writing. The transfer of rights is limited to the specific rights, use, term and geographic scope stated in the contract/license. Transfers of rights can be either exclusive or non-exclusive. Moral rights are protected and are not assignable.

REMEDIES FOR INFRINGEMENT
The owner of a copyright may bring civil and criminal actions against infringers before the corresponding courts.

Civil actions, governed by the Spanish Civil Procedure Law, should be exercised via an ordinary trial. The owner whose rights have been infringed may claim (i) the cessation of the infringing acts; (ii) damages; (iii) seizure of the infringing goods; (iv) to be awarded the seized objects or their means of production; (v) all necessary steps to prevent the continuation of the infringement; and (vi) publication of the judgment against the infringer.

The Criminal Code also includes measures such as fines or penalties of prison depending on the seriousness of the harm.

According to the Royal Decree 1/1996 on Intellectual Property, a copyright holder may apply for precautionary measures against the unlawful activity of an infringer and claiming reparation for material and moral damages caused. He may also request the publication or dissemination, in part or in full, of the judicial resolution or arbitration award in the media at the infringer’s expense. He may likewise apply, on a prior basis, for the ordering of precautionary measures for immediate protection.

Administrative enforcement measures have been introduced over the last years to support right-holders.
GUIDE TO GOING GLOBAL - INTELLECTUAL PROPERTY AND TECHNOLOGY

MASK WORKS

NATURE OF RIGHT
The topographies of semiconductor products, in other words the three-dimensional design-layout and connections of integrated circuits, are protected by the grant of exclusive rights insofar as it is the result of its creator’s own intellectual effort and is not commonplace in the semiconductor industry.

LEGAL FRAMEWORK

DURATION OF RIGHT
The exclusive rights shall expire ten years from the earlier of the following two dates: (i) the end of the calendar year in which the topography was first commercially exploited anywhere in the world or (ii) the end of the calendar year in which the application for registration was filed in due form.

However, any registration of a topography that has not been commercially exploited anywhere in the world within a period of 15 years from its first fixation or encoding shall lapse.

OWNERSHIP/LICENSES
The exclusive rights shall include the right to authorize or to prohibit any of the following acts: (i) reproduction of a topography with the exception of reproduction for private and non-profit-making purposes and (ii) commercial exploitation or importation for that purpose of a topography or of a semiconductor product manufactured by using the topography.

The exclusive rights may be the subject of compulsory licenses when the public interest dictates so. Under such circumstances, the relevant Sections of Law 11/1986 on Patents would apply.

REMEDIES FOR INFRINGEMENT
The owner of a topography may exercise its rights before the courts of ordinary jurisdiction the civil actions and measures provided for in Law 11/1986 on Patents, as discussed below.

Any person entitled to protection who can prove that another person has fraudulently reproduced or commercially exploited or imported for that purpose a topography created by him during the period between its first fixation or encoding and the coming into existence of the exclusive rights may exercise before the courts the appropriate action for unfair competition.

PATENTS

NATURE OF RIGHT
In Spain, both inventions and procedures are patentable. The three main requirements to obtain a patent are that the invention must (i) be new, i.e., novel; (ii) involve an inventive step; and (iii) be capable of industrial application.

Scientific discoveries or theories, mathematical methods, literary, scientific, artistic works and any other aesthetic creations are not considered patentable. Neither is it possible to obtain a patent for an invention if it is a new animal or plant variety, a method of medical treatment or diagnosis, or software item.
In Spain, the main law regulating patent protection is the Law 11/1986 on Patents. Spanish Patents and Trade Marks Office (Oficina Española de Patentes y Marcas) has the authority to grant patents and trademarks.

In addition to the national patent application system, regional registration systems are also available. Such systems allow the applicant to obtain protection for the invention in one or more countries; however each country determines whether or not to protect the patent in its territory pursuant to the applicable legislation. Since Spain’s ratification of the European Patent Convention (EPC) in 1973, Spain may be designated in a European patent application. The EPC system allows the registration of a bundle of national patents enforceable in the countries designated by the applicant.

Additionally, there are significant developments with regard to the creation of a unitary patent protection within the European Union. Such a unitary patent protection is expected to be available in the coming years, although Spain has initially decided not to join these efforts due to linguistic issues.

Patents are granted for a period of 20 years from the date on which the application was filed. A maintenance fee, which is subject to a gradual annual increase, is due yearly. Once the 20-year period has lapsed, anyone may make, use, offer for sale, or sell or import the invention without permission of the patentee, provided that matter covered by other unexpired patents is not used.

Both patent applications and patents shall be transferable and may be the subject of licenses. They may also be used as security for personal loans, which shall be governed by the relevant provisions, and such use shall be notified to the Security Rights section of the Registry of Movable Goods. To be valid, these acts shall be in writing when performed inter vivos (between the living).

Both patent applications and patents may be the subject of licenses covering the whole or part of the elements constituting the exclusive rights, for all or part of the Spanish territory. Licenses may be exclusive or non-exclusive. Unless otherwise agreed, a license shall not be deemed to be exclusive and the licensor may grant licenses to other persons and work the invention himself.

According to the Spanish Law 11/1986 on Patents, the owner of a patent may bring appropriate action of any type or nature before the ordinary courts against any person who infringes his rights and he may demand the necessary measures to safeguard those rights.

The owner whose patent rights have been infringed may, in particular, seek: (i) cessation of the acts that infringe his rights; (ii) compensation for the damages suffered; (iii) seizure of the objects produced or imported in infringement of his rights, as well as the means used for such production or for carrying out the patented process; (iv) whenever possible, attribution of the ownership of the objects and means seized. In such cases, the value of the goods concerned shall be deducted from the compensation for damages. Where that value exceeds that of the compensation granted, the owner of the patent shall pay the excess to the other party; (v) the adoption of the necessary measures to prevent continued infringement of the patent, in particular, the transformation of
the objects or means seized, or their destruction when such is indispensable in order to prevent infringement of the patent; and (vi) publication of the judgment against the person infringing the patent, at his cost, by means of announcements and notification to the persons concerned.

Any person who, without the consent of the owner of the patent, manufactures or imports items protected by the patent or uses the patented process, shall be liable for the damages.

Compensation for damages due to the owner of the patent shall not only include the amount of the loss that he has suffered, but also the profits lost through infringement of his rights.

The owner of the patent may also require compensation for the damage suffered as a result of the loss of reputation of the patented invention caused by the person infringing his rights through defective manufacture or unsatisfactory presentation of the invention on the market.

**TRADEMARKS**

**NATURE OF RIGHT**

Words or combinations of words, figures, symbols and drawings, letters, numerals and combinations, three-dimensional shapes, including wrappers, containers and the shape of goods or their packaging, sounds, and any combination of these elements, may constitute trademarks under Spanish law.

The procedures through which a registration having effect in Spain can be obtained are: (i) national system; (ii) international system; and (iii) Community trademark.

**LEGAL FRAMEWORK**

In Spain, the main law regulating trademark protection is the Law 17/2001 on Trademarks. Spanish Patents and Trademarks Office (Oficina Española de Patentes y Marcas) has the authority to grant trademarks as well as patents.

The “International System” comprises the Madrid Agreement of 1891 and the Protocol to the Madrid Agreement of 1989 administered by the World Intellectual Property Organization (WIPO). Since it is not, strictly speaking, an international registration, the applicant must designate the countries in which he wishes to obtain protection.

The Community trademark system provides a single registration which confers direct protection in all the Member countries of the European Union through a single application and a unitary procedure.

**DURATION OF RIGHT**

National trademark registration is valid for ten years and can be renewed indefinitely for further ten-year periods subject to the payment of the appropriate fees. However, the registration may lapse or be revoked if (i) the trademark is not renewed; (ii) it is not effectively used during an uninterrupted five-year period; or (iii) it becomes generic or deceptive in connection with the goods or services it covers.

Community trademark registration is valid for ten years. This period can be renewed for further ten-year terms subject to payment of the appropriate fees.
OWNERSHIP/LICENSES
The registration of a trademark confers on its owner the exclusive right to use it in economic transactions.

Both an application and a trademark may be licensed for all or some of the goods and services for which the trademark is registered and for all or part of Spanish territory. The licenses may be exclusive or non-exclusive.

REMEDIES FOR INFRINGEMENT
The owner of a registered trademark may, before the jurisdictional authorities, take appropriate civil or criminal action against those infringing his right and request the measures necessary for protection of the trademark, without any prejudice to submission of the case to arbitration, where possible.

In particular, an owner whose right to a trademark is infringed may in a civil action claim: (i) the cessation of the acts infringing his right; (ii) the compensation for the damage suffered; (iii) the adoption of the measures necessary to avoid the continuation of an infringement and in particular, the withdrawal from economic circulation of the goods, packaging, wrappers, advertising material, labels or other documents in which the infringement of a trademark has been manifested; (iv) the destruction or transfer for humanitarian purposes, where possible, as chosen by the party concerned and always at the expense of the guilty party, of the goods unlawfully identified with the trademark which are in the possession of the infringing party, except where the nature of the good allows the distinctive sign to be removed without affecting the good itself, or where destruction of the good would do disproportionate harm to the infringing party or owner, according to the specific circumstances of each case as determined by the court; and (v) the publication of a decision at the expense of the guilty party by means of announcements and notifications to the parties concerned.

TRADE SECRETS

NATURE OF RIGHT
Trade secrets are protected by restricting any unauthorized use and access thereto, both through civil proceedings under the Unfair Competition Act as well as under the Criminal Code.

LEGAL FRAMEWORK
Trade secrets are mainly protected in Spain under the Unfair Competition Act and the Criminal Code. Both contain provisions specifically aimed at trade secrets.

There are also other laws which deal with trade secret protection, such as the employment laws establishing secrecy obligations of directors/employees.

DURATION OF RIGHT
No specific duration of trade secret right is set forth under Spanish law. They are protected as long as they are considered trade secrets and protected as such.
OWNERSHIP/LICENSES
Trade secrets are not subject to a specific property right, and the protection is achieved indirectly by declaring that someone is unlawfully using trade secrets and then acting against that unauthorized access and exploitation. It is, however, accepted that they are intangible assets which may be subject of economic transactions. The assignment and licensing of know-how are clear examples.

There is no specific regulation for the license agreements on trade secrets or the know-how license agreements. They are subject to the general rules for legal agreements, and in some cases and by analogy, to those of patent license agreements.

REMEDIES FOR INFRINGEMENT
The specific civil and criminal law measures are available for protection of trade secrets in Spain. A wide criminal framework is dedicated to trade secrets infringements, including against disclosure, misappropriation, use or other infringement. Criminal liability for trade secret violation under the Criminal Code, punishable by imprisonment of up to seven years in most serious cases and fines of up to 24 months.

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT
EMPLOYEES
Generally speaking, intellectual property rights (inventions, topographies of semiconductor products, industrial designs, copyright works and computer programs) created by employees within the scope of their employment relationship in principle belong to the employer.

In particular, Law 11/1986 on Patents sets forth that inventions made by an employee during the term of his contract, work or service with a company, and which are the result of research that is explicitly or implicitly the object of his contract, shall belong to the employer. The employee will have the right to an additional remuneration in case that his personal contribution to the invention and the relevance for the company exceeds the scope of the tasks regulated in his employment agreement.

If inventions do not fulfill the aforementioned conditions, they shall belong to the employee who is the author. Nonetheless, if the employee makes an invention “related” to his professional activity and the knowledge gained within the company has had a decisive influence thereon or he has used means provided by the company, the employer shall have the right to claim ownership of the invention or to reserve a right to its use.

Regarding copyright works, according to the Legislative Royal Decree 1/1996 on Intellectual Property, the transfer of the exploitation rights of a work created by virtue of employment relations to the employer is governed by the terms agreed upon in the contract in writing. In the absence of such an agreement in writing, it is presumed that the exploitation rights have been granted exclusively and with the scope necessary for exercising the usual activity of the employer (at the time the work is delivered). Similarly, where a computer program is created by an employee in the course of his duties or following instructions given by his employer, the ownership of the exploitation rights on the computer program created, including both the source program and the object program, belong exclusively to the employer, unless otherwise agreed in writing.
CONSULTANTS/CONTRACTORS
It is customary for consultants and contractors to sign written agreements. Absent a written assignment of developments, consultants and contractors will retain ownership of the intellectual property developed by them, even if contracted and paid for by another party.

KEY COMMERCIAL CONTRACT CONSIDERATIONS

REGISTRATION OF COMMERCIAL AGREEMENTS
There is no general registration requirement for commercial agreements.

Registration of licenses for patents, registered copyrights and trademarks is possible but not required (only to have effect in front of third parties).

RECOGNIZED LANGUAGE OF COMMERCIAL AGREEMENTS
Parties are in principle free to choose the language to govern their contract. In consumer-facing commercial agreements and terms, Spanish is mandatory (with a relevant role of regional languages).

COUNTRY-SPECIFIC ISSUES FOR ONLINE CONTENT
Directive 2000/31/EC on information society services was implemented in Spain by Law 34/2002 on information society services and electronic commerce (LSSI).

Service providers are required to fulfill certain legal requirements set forth by LSSI. In particular, they shall make available a number of items such as the name or corporate denomination, residence, domicile or address of a permanent establishment in Spain, e-mail details of registration in the Companies Register or any other Public Register.

ENFORCEABILITY OF ONLINE/CLICKWRAP/SHRINKWRAP TERMS
Generally viewed as enforceable if conspicuous, users have an opportunity to review and indicate affirmative assent, e.g., check box.

The LSSI regulates electronic contracts, although the Spanish Civil Law must be also taken into account. The LSSI further obliges service providers to provide information in a clear, understandable and unambiguous way regarding the conclusion of the contract. Electronic contracts will have the same legal effects, provided that the consent and other legal requirements that is object and cause have been satisfied.

GOVERNING LAW
Under Regulation No. 593/2008 of the European Parliament and of the Council of June 17, 2008 on the law applicable to contractual obligations (Rome I), directly applicable in Spain, the parties to a contract are allowed to choose the law governing the contracts, whether or not it is the law of a EU member state. If the contracting parties do not make a choice (or if the choice is invalid), the law of the country of habitual residence of the characteristic performer when the contract is concluded, or in the case of a company, of its central administration, in principle applies.
Alongside this general rule, the EU Rome I regulation on the law applicable to contractual obligations establishes certain guarantees as to the requirements for the parties to be able to determine the applicable law in certain cases (e.g. consumer contracts and individual employment contracts) and if no choice is made, specific forms of jurisdiction that take precedence over the presumptions referred to above.

**KEY COMMERCIAL CONTRACT TERMS**

**ENFORCEABILITY OF WARRANTY DISCLAIMERS**
Disclaimers of warranties are usually enforceable in business to business deals unless they are unconscionable, unclear or not conspicuous. Disclaimers for gross negligence or willful behavior are void.

Warranty disclaimers against consumers are generally not allowed in most cases.

**ENFORCEABILITY OF EXCLUSIONS/LIMITATIONS OF LIABILITY**
A cap on direct damages or aggregate liability is common.

Exclusions and limitation on liability are usually enforced unless they are unconscionable, unclear or not conspicuous. Exclusions of liability for fraud, personal injury, death, bad faith, gross negligence or willful behavior are not enforceable under Spanish law.

Exclusions and limitations of liability against consumers are generally not allowed.

**INDEMNIFICATION**
Express indemnities stated in contracts are recognized and generally respected.

Indemnification provisions are generally enforceable unless they require indemnification of behavior that statutes or courts have held to be unenforceable (such as fraud, willful injury to person or property and other future unlawful acts).

Caps on liability under indemnification provisions can be enforceable.

Courts have the power to moderate indemnity payments agreed by the parties to a contract.
SWEDEN

INTELLECTUAL PROPERTY FRAMEWORK

Intellectual property rights in Sweden are protected by various laws. Swedish intellectual property legislation is based on various European Union (EU) directives and regulations. The protection of trade secrets is provided for by law.

COMMERCIAL CONTRACT FRAMEWORK

Swedish contract law is based on the main principles of Roman law (pacta sunt servanda) and the freedom of contract. The content of the agreement is determined primarily by what has been agreed between the parties, but may be supplemented by rules and case law, trade practice or custom.

The main source of Swedish contract law is the Contracts Act (1915:218) (Avtalslagen). The Contracts Act does not cover every aspect of contract law, but it sets forth the fundamental rules for Swedish contracts. Highly biased and unfair contractual provisions may be amended or declared null and void by a Swedish Court of law under the Contracts Act Section 36. For this to happen, the contract has to be highly unfair and detrimental to one party (one-sided).

Mandatory provisions apply in a business-to-consumer situation.

RECOGNIZED INTELLECTUAL PROPERTY RIGHTS

COPYRIGHTS

NATURE OF RIGHT

Copyrights protection is available for original works that are literary or artistic. The individual creator is entitled to copyright to the work. No registration or fixation is required; the right arises at the time of creation.

Copyright owners have the exclusive right to reproduce and distribute the work. Distribution includes transmission to the public, public performance, public display and distribution of copies.

Moral rights are recognized.

LEGAL FRAMEWORK

The Copyrights Act (Lag om upphovsrätt till litterära och konstnärliga verk (SFS 1960:729)) governs copyrights.

Sweden is a signatory to the Berne Convention.

DURATION OF RIGHT

Copyright protection lasts for the life of the creator plus an additional 70 years. If the work has several creators, the copyright lasts until the end of the 70th year after the last surviving creator’s death. For an anonymous work, the copyright endures until the end of the 70th year after the work was made public.
The Copyrights Act also protects neighboring rights of performing artists, producers, photographers, radio and TV-organizations, catalogues and databases. Most of the neighboring rights (similar to the economic rights of copyright) generally last until 50 years after the right was made public but the term may vary depending on various factors.

**OWNERSHIP/LICENSES**
Joint ownership of copyrights is recognized and the right can be transferred partly. Moral rights may not be transferred and can only be waived. No formal requirements for licenses.

**REMEDIES FOR INFRINGEMENT**
Remedies for copyright infringement include equitable and reasonable compensation for the use, as well as compensation for losses and further injuries caused by negligent or willful infringement. Costs and reasonable attorneys’ fees can also be recoverable.

It is possible to obtain a court order for destruction of infringing products and equipment used in the manufacture thereof, as well as to seek to prevent importation of goods that are infringing.

Injunctive relief is also a possible remedy.

Criminal penalties are possible.

**MASK WORKS (TOPOGRAPHIES)**

**NATURE OF RIGHT**
The right to topographies under Swedish Law requires that the topography is the result of a personal intellectual effort of the creator and that the circuit design is not commonplace in the semiconductor industry. Topographies made up of parts which are commonly used in the semiconductor industry are only protected if the combination of the parts meets the conditions for protection.

Owners are granted an exclusive right to reproduce, import and make topographies available to the public by sale, rent or lending, or in other similar ways.

**LEGAL FRAMEWORK**

**DURATION OF RIGHT**
The right lasts for ten years from the year when the topographies or semiconductor was first used commercially in any part of the world.

If the topography or semiconductor has yet to be used commercially, the right expires fifteen years after the year on which the topographies or semiconductor was created.

**OWNERSHIP/LICENSES**
The right is granted to the individual person who has invented the topographies provided that he is a citizen of the European Economic Area (EEA), or is domiciled in a country part of the EEA.
The right to topographies created by an employee during the course of an employment is granted to the employer provided that nothing else has been agreed and the employer is an individual who is a citizen of or is domiciled in a country part of the EEA or a legal person which conducts business in such country.

In the event that the right to the topographies does not follow from the sections above, the right is granted to such natural or legal person who fulfills the requirements regarding the connection to the European Economic Area provided that such a person has been granted the exclusive rights to exploit the topographies commercially in the entire economic area and first uses the topographies commercially in a country which is part of such area.

The right is also granted to the person who has assumed the right from those mentioned above.

**REMEDIES FOR INFRINGEMENT**

Remedies for infringement include equitable and reasonable compensation for the use and compensation for losses and further injuries caused by negligent or willful infringement. Costs and reasonable attorneys’ fees can also be recoverable.

It is possible to obtain court order for destruction of infringing products and equipment used in the manufacture thereof, as well as to seek preventing importation of goods that are infringing.

Injunctive relief is also a possible remedy. Criminal penalties are possible.

**PATENTS**

**NATURE OF RIGHT**

Upon registration, patent protection is available for inventions that are susceptible of industrial application, provided that the invention is new and significantly differs from what was known at the filing date of the patent application.

Patent right owners are granted the exclusive right to exploit the invention commercially.

**LEGAL FRAMEWORK**

Patents are regulated under the following legislative acts:

(i) Patents Act (1967:837) (*Patentlagen*) pertains to the protection of Swedish patents; and

(ii) The European Patent Convention (EPC) pertains to the protection of European patents.

Sweden became a party to the Patent Cooperation Treaty (PCT) in 1978.


Sweden has also signed the Paris Convention, the TRIPS Agreement and the London Agreement.
**DURATION OF RIGHT**

Patents have a duration of 20 years from the filing date of the application. Sweden is a “first to file” system.

**OWNERSHIP/LICENSES**

Patent rights are granted to the inventor or the inventor’s successor in title. In case of a jointly developed invention, joint ownership will be granted. It should be noted that the law does not provide specific details concerning joint ownership. Thus, to avoid disputes, joint owners should consider entering into an agreement concerning the use and management of the patent right in question.

Licenses may be registered. However, registration of licenses is not compulsory and does not affect their validity.

**REMEDIES FOR INFRINGEMENT**

Remedies for patent infringement include equitable and reasonable compensation for the use and compensation for losses and further injuries caused by negligent or willful infringement. Costs and reasonable attorneys’ fees can also be recoverable.

It is possible to seek preventing importation of goods that are infringing as well as to obtain a court order for destruction of infringing products and equipment used in the manufacture thereof.

Injunctive relief is also a possible remedy.

Criminal penalties are possible.

**TRADEMARKS**

**NATURE OF RIGHT**

A trademark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

Trademark owners are granted an exclusive right to use the trademark commercially and prevent third parties from using the same or similar marks commercially for identical or similar goods and services as those protected by the trademark.

**LEGAL FRAMEWORK**

The Swedish Trademark Act (Varumärkeslagen (2010:1877)) pertains to the protection of unregistered and registered Swedish trademarks. An unregistered mark is protected if it becomes known as a trademark for the goods or services provided under the mark to a significant part of the relevant consumers at which it is directed.


Sweden became member of the Madrid Protocol in 1995.

Sweden became party to the Trademark Law Treaty in 1995.


Sweden has also signed the Paris Convention, the TRIPS Agreement and the Nice Agreement.
DURATION OF RIGHT
Registered Swedish trademarks are in effect for ten years from the date of registration and are renewable indefinitely.

Unregistered Swedish trademarks are in effect for as long as the trademark fulfills the requirements for unregistered protection.

Registered Community trademarks are in effect for ten years from the date of application; renewable indefinitely.

OWNERSHIP/LICENSES
Any natural or legal person can apply for and own a trademark.

The owner has the exclusive right to use or permit others to use the trademark.

Licenses may be registered in the Swedish trademark registry or in the European trademark office OHIM’s register over Community trademarks. However, registration of licenses is not compulsory and does not affect their validity.

REMEDIES FOR INFRINGEMENT
The remedies for trademark infringement include equitable and reasonable compensation for the use and compensation for losses and further injuries caused by negligent or willful infringement. Costs and reasonable attorneys’ fees can also be recoverable.

It is possible to seek preventing importation of goods that are infringing and to obtain a court order for destruction or alteration of infringing products and equipment used in the manufacture thereof.

Injunctive relief is also a possible remedy.

Criminal penalties are possible.

TRADE SECRETS

NATURE OF RIGHT
The right serves to protect information about business or operating conditions in a trader’s business which the trader keeps secret and whose disclosure is likely to cause harm to the trader in terms of competition.

The law applies only to unauthorized attacks on trade secrets.

LEGAL FRAMEWORK

DURATION OF RIGHT
As long as the secret has a commercial value and is not generally known by others outside the company the secret will be protected by law.
REMEDIES FOR INFRINGEMENT
Liability for damages will occur for corporate espionage or unlawful dealing with a trade secret. The damages are intended to compensate for the injury. Criminal penalties are possible.

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

EMPLOYEES
The Copyright Act does not state any specific rules for work created in the scope of an employment other than copyright in computer programs. Unless otherwise agreed, computer programs created by an employee as a part of his tasks or by following instructions of the employer will be transferred to the employer. Other works made by an employee remains the property of the employee, unless otherwise agreed. Some collective labor agreements, for example within the mass media sector, provides acquisition rights in the employee’s copyright.

A copyright transfer may be implied, and if not otherwise expressly agreed, the employer may under certain circumstances be entitled to use the employee’s work to the extent necessary for running its business. It is customary for employees to sign copyright assignment and confidentiality agreements.

The right to a semiconductor product topographies created in an employment relationship belongs to the employer, unless otherwise agreed.

Pursuant to the Act of an Employee’s Inventions (Lagen om rätten till arbetstagares uppfinningar SFS 1949:345), the employer has under certain circumstances the right to implement the invention in its business or the right to fully or partly acquire the invention made by an employee as part of his tasks. Employees have a mandatory right to reasonable compensation for such transfer.

CONSULTANTS/CONTRACTORS
It is customary for consultants and contractors to sign written agreements. Absent such a written agreement, the consultant/contractor retains the ownership of the intellectual property developed by them, even if contracted and paid for by another party, as a general principle.

KEY COMMERCIAL CONTRACT CONSIDERATIONS

REGISTRATION OF COMMERCIAL AGREEMENTS
There is no general registration requirement for commercial contracts.

As a general principle, commercial agreements regarding intellectual property need not be registered. Some contracts may require registration, such as patent pledge agreements.

Registration of licenses for patents, designs and trademarks is possible to put potential buyers of the patents, designs and trademarks on notice of the license. Such registration is not required.

RECOGNIZED LANGUAGE OF COMMERCIAL AGREEMENTS
Commercial contracts in a business-to-business situation are often in English, although Swedish is the preferred language.
Though not legally required, Swedish is recommended for contracts in a business-to-consumer situation to avoid any arguments by customers that he is not to be bound by the agreement because he was not able to understand the content thereof. If English is used however, ‘plain English’ that is consumer-friendly is preferred.

**ENFORCEABILITY OF ONLINE/CLICKWRAP/SHRINKWRAP TERMS**

Online terms are generally viewed as enforceable if conspicuous and users have an opportunity to review and indicate affirmative assent (e.g. check a box).

Companies offering services online need to make terms available in a way which makes it possible to save and retrieve them according to the Act on E-Commerce (*Lagen om elektronisk handel*).

In a business-to-consumer situation, specific rules apply.

**GOVERNING LAW**

The parties’ contractual freedom applies to choice of law. Governing law and venue for resolution of disputes specified in a commercial contract will generally be accepted and recognized by Swedish Courts.

In a business-to-consumer situation, specific rules may apply.

Dispute resolution is litigation in district courts unless an alternative dispute resolution procedure, such as mediation or arbitration, is specified in the contract. Arbitration is generally not enforceable in a business-to-consumer situation.

**KEY COMMERCIAL CONTRACT TERMS**

**ENFORCEABILITY OF WARRANTY DISCLAIMERS**

Disclaimers of warranty are usually enforced unless they are unconscionable, unclear or not conspicuous. Unless otherwise agreed, goods shall, according to the Sale of Goods Act (*Köplagen (1990:931)*)) conform to the contract with respect to type, quantity, quality, other characteristics and packaging.

Unless otherwise specified in the contract, the goods shall:

(i) be fit the purpose for which goods of a similar kind are generally used;

(ii) be fit for the particular purpose for which the goods are intended to be used provided that the seller, at the time of sale, must have realized that particular purpose and the buyer was reasonably entitled to rely upon the seller’s expert knowledge and judgment;

(iii) possess the characteristics which the seller has referred to by providing samples or models; and

(iv) be packaged in the customary or otherwise satisfactory manner, if packaging is required in order to preserve or protect the goods.

If the goods deviate from the provisions of the first or second paragraphs or in some other respect deviate from the buyer’s reasonable expectations, the goods shall be deemed to be defective.

Sale of Goods Act may be applicable to intellectual property by analogy.

Consumer legislation on sale of goods provides mandatory provisions on warranties.
ENFORCEABILITY OF EXCLUSIONS/LIMITATIONS OF LIABILITY

Sellers in their contracts for the sale of goods customarily exclude indirect damages.

A cap on direct damages or aggregate liability is also common.

Exclusions and limitations on liability are usually enforced unless they are unconscionable, unclear or not conspicuous. Exclusions of liability for personal injury, death, intent and gross negligence are not enforceable.

In consumer situations, a term which disclaims the provider’s liability in cases of personal injury or death is presumed to be unfair. The same applies to a contractual term which disclaims all liability in cases of gross negligence and for contractual terms which inappropriately excludes or limits the legal rights in the event of total or partial non-performance or inadequate performance by the seller or supplier of any of the contractual obligations.

INDEMNIFICATION

Unless highly biased and unfair, an indemnification clause (and similar clauses under Swedish contract law) may be enforceable under Swedish law. Indemnification clauses are not uncommon in intellectual property licensing agreements.
SWITZERLAND

INTELLECTUAL PROPERTY FRAMEWORK

Intellectual property rights are governed by Federal statutes and by international treaties.

COMMERCIAL CONTRACT FRAMEWORK

Commercial contracts are governed by the Swiss Civil Code and the Swiss Code of Obligations, which contain the general rules about the formation, enforceability and interpretation of contracts, as well as specific provisions on specific types of contracts.

RECOGNIZED INTELLECTUAL PROPERTY RIGHTS

COPYRIGHTS

NATURE OF RIGHT
Copyright protection is available for intellectual creations of literature or art that have a distinct character. Copyright protection also applies to computer programs and related rights that include the rights of performing artists, of producers of phonograms and videograms and the rights of broadcasters to their products.

Registration is not required; the rights arise as soon as a work is created. It is not necessary to refer to the copyright in the work.

Copyright owners have the exclusive right to reproduce, translate, edit, distribute, sell, perform, broadcast or transfer the work.

LEGAL FRAMEWORK
Federal Act and Federal Ordinance on Copyright and Neighboring Rights govern copyrights. Switzerland became a signatory to the Berne Convention in 1956.

DURATION OF RIGHT
Copyright protection lasts for the life of the author plus an additional 70 years, with an exception for computer programs, for which the protection ends 50 years after the death of the author.

Protection for related rights expires 50 years after the performance, publication or production of the work. The right of a performing artist to be named as the artist (moral rights) expires with the death of the artist, but in any event no earlier than 50 years after the performance.

OWNERSHIP/LICENSES
Joint ownership of copyrights is recognized. Switzerland follows a system of Legal Licenses, which means that the law itself authorizes the private use of published works under certain circumstances. A system of Mandatory Licenses also exists concerning the creation of phonograms.
REMEDIES FOR INFRINGEMENT
Remedies for copyright infringement include declaratory actions, actions for performance, damages, confiscation and destruction.

Actual damages can be monetary loss suffered by the copyright owner or profits gained by the infringer.

Injunctive relief and publication of judgments are also possible remedies.

It is also possible to seek the prevention of importation of goods that are infringing.

Criminal penalties are also possible.

TOPOGRAPHIES

NATURE OF RIGHT
This right provides protection for original topographies of semiconductor products, regardless of their definition or coding. The object of protection is the design of the three-dimensional structure of the connected layers on which the semiconductor product (integrated circuit) is based. The protection only concerns the external form of the topography and not the electronic function of the semiconductor product.

Protection in Switzerland is available only if one of the following preconditions is fulfilled: (i) production by a Swiss manufacturer or a person whose normal place of residence or place of business is in Switzerland; (ii) first publication in Switzerland; or (iii) protection in Switzerland based on an international treaty.

LEGAL FRAMEWORK
Semiconductor topographies are protected pursuant to the Federal Act and Federal Ordinance on the Protection of Topographies of Semiconductor Products.

DURATION OF RIGHT
The duration of protection is ten years from the valid application for the registration of the topography; ten years from the first publication, if this took place before the application; and two years after the first publication, if the topography is not registered. The right ends 15 years after the development of the topography at the latest.

OWNERSHIP/LICENSES
Co-ownership is permissible.

REMEDIES FOR INFRINGEMENT
Declaratory actions, actions for performance and actions for damages are available remedies for infringement. Also, actions can be sought for confiscation of unlawfully produced topographies, except for products acquired in good faith.

Injunctive relief and publication of judgments are also possible remedies.

It is possible to seek preventing importation of goods that are infringing.

Criminal penalties are also possible.
PATENTS

NATURE OF RIGHT
Patents protect technical inventions.

Patents grant the right to exclude others from using the invention commercially, such as making, selling, offering and importing the invention.

LEGAL FRAMEWORK
Federal Patents Act and Federal Ordinance on Patents governs patents.

DURATION OF RIGHT
The duration of protection is 20 years from the filing date of the application.

OWNERSHIP/LICENSES
Co-ownership is permissible. With certain exceptions, no license can be granted without the consent of all co-owners. Each co-owner can dispose of his part and take action against infringement of the patent without the consent of the other owners.

REMEDIES FOR INFRINGEMENT
Available remedies for infringement include declaratory actions, actions for performance, damages, confiscation and destruction.

Actual damages can be monetary loss suffered by the patent owner, or profits gained by the infringer. Injunctive relief and publication of judgments are also possible remedies.

It is possible to seek the prevention of importation of goods that are infringing. Criminal penalties are also possible.

TRADEMARKS

NATURE OF RIGHT
A word, a combination of letters, numericals, graphic images, three-dimensional forms, slogans, a series of tones, or any combination of these elements which distinguish the products or services of one business from another can be protectable as a trademark.

Trademark rights become effective upon their registration.

LEGAL FRAMEWORK
Trademarks are governed by the Federal Trade Mark Protection Act and Federal Ordinance on Trademarks.

DURATION OF RIGHT
Trademark registrations remain in effect for ten years and are renewable indefinitely.

OWNERSHIP/LICENSES
Co-ownership as well as collective trademarks are possible (marks for collective associations). Licenses for collective marks must be registered.
GUIDE TO GOING GLOBAL - INTELLECTUAL PROPERTY AND TECHNOLOGY

AUSTRALIA
AUSTRIA
BELGIUM
BRAZIL
CANADA
CHINA
FRANCE
GERMANY
HONG KONG
INDIA
INDONESIA
IRELAND
ISRAEL
ITALY
JAPAN
LUXEMBOURG
MEXICO
NETHERLANDS
RUSSIA
SAUDI ARABIA
SINGAPORE
SOUTH KOREA
SPAIN
SWITZERLAND
SWEDEN
TURKEY
UNITED ARAB EMIRATES
UNITED KINGDOM
UNITED STATES

REMEDIES FOR INFRINGEMENT
Remedies for trademark infringement include declaratory actions, actions for performance, damages, confiscation and destruction.

Actual damages can be monetary loss suffered by the trademark owner, or profits gained by the infringer.

Injunctive relief and publication of judgments are also possible remedies.

It is possible to seek preventing importation of goods that are infringing.

Criminal penalties are also possible.

TRADE SECRETS

NATURE OF RIGHT
Trade secrets do not constitute a category of property rights, but are rather protected to a certain extent by unfair competition law, contract law and criminal law.

LEGAL FRAMEWORK
Trade secrets are addressed by the Federal Unfair Competition Act, Swiss Civil Code and Code of Obligations, Swiss Criminal Code.

DURATION OF RIGHT
There is no specific time limitation for protection.

OWNERSHIP/LICENSES
Co-ownership is possible when individuals work on the creation of the trade secret and their individual input cannot be separated, or if contractually agreed upon between employer and employee.

REMEDIES FOR INFRINGEMENT
Declaratory actions, actions for performance, damages and an account of profits are available remedies. There is an exception for cases where trade secrets are obtained in good faith.

Injunctive relief and publication of judgment are also available remedies in certain circumstances.

Criminal penalties are possible in some cases.

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

EMPLOYEES
Inventions and designs created by the employee in his function as an employee and in fulfillment of his contractual duties belong to the employer. Except for software, there is no corresponding statutory provision for copyrights. Therefore, it is advisable to include contractual clauses dealing with the transfer of copyrights from employees to employers in employment agreements.

If software is developed during the employment relationship, the employer acquires the right of use.

Non-technical trade secrets are not transferred to the employer.
CONTRACTORS/CONTRACTORS

It is customary for consultants and contractors to sign written agreements. Absent a written assignment of developments, consultants and contractors will retain ownership of the intellectual property developed by them.

KEY COMMERCIAL CONTRACT CONSIDERATIONS

REGISTRATION OF COMMERCIAL AGREEMENTS

There is no general registration requirement for commercial contracts.

Registration of licenses with the Swiss Federal Institute of Intellectual Property is possible in order to have a license effective as to third parties.

RECOGNIZED LANGUAGE OF COMMERCIAL AGREEMENTS

English language is recognized and enforced in both business and consumer-facing contracts. However, it is recommended that one of the official Swiss languages is used for contracts with consumers.

ENFORCEABILITY OF ONLINE/CLICKWRAP/SHRINKWRAP TERMS

Shrinkwrap terms are not valid. The terms of the license must be made available to the consumer before the opening of the package.

Online and Clickwrap terms are enforceable if they are visible, easily available and phrased clearly.

GOVERNING LAW

Governing law and forum specified in a commercial contract will generally be accepted and recognized by state courts.

Dispute resolution is litigation in state courts unless an alternative dispute resolution procedure, such as mediation or arbitration, is specified in the contract.

KEY COMMERCIAL CONTRACT TERMS

ENFORCEABILITY OF WARRANTY DISCLAIMERS

Disclaimers for implied warranties are generally enforceable unless defects have been concealed in bad faith by the disclaiming party. If express warranties are made for certain specifications, liability may not be validly excluded for these specifications, since this would constitute contradictory behavior.

If disclaimers are included in general terms and conditions, they are enforceable unless the provisions are unusual. Unusual provisions are only regarded as valid if the party proposing them has expressly drawn the attention of the other party to the special element.
Under Swiss mandatory law, it is not possible to validly exclude or limit the liability of a party for gross negligence or intentional breach of contract. In particular, the limitation of a party’s liability to a certain cap and the exclusion of certain categories of damages (such as indirect or consequential losses and loss of profits) would not be valid in the event of gross negligence or intentional breach of contract. As a result, liability may only be validly excluded or limited if a party caused the damage with slight or medium negligence.

Liability for auxiliary persons, such as employees, may be waived entirely.

**INDEMNIFICATION**

Indemnification provisions are often used and are generally enforceable.
TURKEY

INTELLECTUAL PROPERTY FRAMEWORK

In general, industrial property rights are governed by Decree Laws. Currently, there are draft laws to update and replace the Decree Laws. Copyrights are governed by a separate law. However, most of the international intellectual property conventions have been ratified by Turkey and as a result the framework governed intellectual property are generally harmonized with the international standards.

COMMERCIAL CONTRACT FRAMEWORK

Commercial contracts are governed by the Turkish Code of Obligations and Turkish Commercial Code, among other laws.

RECOGNIZED INTELLECTUAL PROPERTY RIGHTS

COPYRIGHTS

NATURE OF RIGHT
Copyrights are available for science, literary, artistic, music and cinematographic works that have originality. Additionally, neighboring rights are recognized for original interpretation, promotion, execution of existing works, first-recorder phonogram makers and radio-television organizations. Also, related rights cover the above-stated neighboring right owners and the first-recorders of films.

LEGAL FRAMEWORK
Copyrights are governed by the Law on Intellectual and Artistic Works dated 1951. Turkey became signatory to the Berne Convention in 1995.

DURATION OF RIGHT
The protection period is the lifetime of the owner and 70 years after his death.

OWNERSHIP/LICENSES
There is no need for registration to establish ownership. There are special arbitrary registries to facilitate proof of rights. There are punishments in case of false registries, i.e., registering material and moral rights that do not exist.

The same arbitrary registration principle prevails for license agreements as well.

 REMEDIES FOR INFRINGEMENT
There are legal and criminal punishments for infringement of copyrights.

Legal remedies include prevention of infringement (for possible future infringements), enjoining infringement (for currently present infringements) and compensation. In case of infringement of material rights, the right owner is entitled to demand treble of the contract or market value if such a license contract would have been concluded with the infringer. The right owner is also entitled to demand all other rights that could infer from such a contract. Additionally, the infringing copies that are placed on market or are about to be placed on the market could be collected by the right owner.
 Criminal punishments of one to five years are possible for those who copy, distribute, change original works; two to five years for those who hold themselves out as the owner of the work; six months to two years for plagiarism; six months for those who reveal content of an unpublished work; three months to one year for those who publish works under a renowned person’s name; six months for deceiving/false sources. These penalties can be decreased if the accused cooperates with authorities. Finally, it is established that the unauthorized persons and content providers who continue to provide infringing content could be punished with a penalty of a minimum of three months and up to a maximum of two years. Some penalties for infringement include only imprisonment and some include legal monetary fines and imprisonment.

INTEGRATED CIRCUIT TOPOGRAPHIES

NATURE OF RIGHT
Integrated circuit topographies are defined as the fixed sequence of images that demonstrate three-dimensional layers forming the integrated circuit for production of such topography.

LEGAL FRAMEWORK
Law on Protection of Integrated Circuit Topographies no. 5147 governs the protection of integrated circuit topographies. This is the only industrial right that is regulated with a law. There is also a Regulation on Protection of Integrated Circuit Topographies.

There are two methods for challenging the validity of the integrated circuit topography rights: the administrative and legal methods. The administrative methods include oppositions and appeals before the Turkish Patent Institute until the integrated circuit application is registered. After registry, these rights can be challenged for invalidation before the specialized intellectual property courts. Additionally, third-party infringement claims are decided by the courts.

DURATION OF RIGHT
The duration of protection is ten years from application for registration. If not registered or commercially exploited within 15 years, the right cannot be registered.

OWNERSHIP/LICENSES
There are two types of licenses: contractual and compulsory. The contractual one can be exclusive or non-exclusive.

As for the compulsory license, related rules are stipulated in the law. Accordingly, the Council of Ministers can decide for compulsory licensing in case of public interest, welfare, security reasons or the right owner’s use of right to prevent competition. In such cases, the relevant public institution or third party shall apply to the Turkish Patent Institute to get its opinion and submit its compulsory license request to the Council of Ministers.

REMEDIES FOR INFRINGEMENT
In principle, infringement actions can be filed after publication of the integrated circuit topography application. However, if bad faith can be proven, infringement can even be claimed before publication.

Legal remedies for infringement include determination of infringement, enjoining infringement, material and moral compensation, right to ask for takeover of the infringing product and loss of profit. Loss of profit can be determined according to the fictional value if the infringer and the right owner concluded a contract, or the right owner’s possible value in the absence of any competition...
of the infringer or the income of the infringer due to conducting the infringement. Additionally, any third party who has a legal interest can file a lawsuit for determination of lacking of infringement. Attorneys’ fees and court expenditure can be recoverable.

As an administrative remedy, the infringing products can be held at customs pursuant to the provision of the Customs Law no. 4458.

Criminal remedies include one to two years of imprisonment and legal monetary fines based on a daily amount for 500 to 1,000 days. The acts that are subject to punishment are stipulated in detail in the law. These are offenses prosecuted upon complaint of the right owner or any other beneficiary/stakeholder.

**PATENTS**

**NATURE OF RIGHT**

Patents are exclusive industrial rights that grant proprietary rights on inventions.

**LEGAL FRAMEWORK**


**DURATION OF RIGHT**

Patents granted upon examination are valid for 20 years, patents granted without examination are valid for seven years and utility models are valid for ten years from the date of application.

**OWNERSHIP/LICENSES**

There are two types of licenses: contractual and compulsory. The contractual license can be exclusive or non-exclusive.

On the other hand, compulsory license can be granted in case of non-use, dependency of patent subjects or public interest.

Joint ownership is permissible.

**REMEDIES FOR INFRINGEMENT**

Legal remedies for infringement include determination of infringement, enjoining infringement, material and moral compensation, the right to ask for takeover of the infringing product and lost profits. Additionally, any third party who has a legal interest can file a lawsuit for determination of non-infringement. Attorneys’ fees and court expenditure can be recoverable.

Injunctive relief is possible. This includes holding the infringing products at customs.

No criminal punishment is provided for in the current legislation. The criminal provisions have been annulled and the new ones are yet to be enacted.
TRADEMARKS

NATURE OF RIGHT
Trademarks are exclusive industrial rights which grant proprietary rights on the mark that identifies and distinguishes the source of goods or services of the owner from those of others. This mark can consist of words, designs, letters and has to be capable of being drawn, published and duplicated.

LEGAL FRAMEWORK

DURATION OF RIGHT
Trademarks have a duration of ten years from the date of application. The right is renewable indefinitely.

OWNERSHIP/LICENSES
Licenses can be exclusive or non-exclusive. Unless the license is registered before the Turkish Patent Institute, the rights conferred by the trademark right cannot be asserted against the infringing third parties.

Joint ownership is permissible.

REMEDIES FOR INFRINGEMENT
Legal remedies for infringement include determination of infringement, enjoining infringement, material and moral compensation, right to ask for takeover of the infringing product and lost profits. Additionally, any third party who has a legal interest can file a lawsuit for determination of lacking of infringement. Attorneys’ fees and court expenditure can be recoverable.

As an administrative remedy and injunctive relief, the infringing products can be held at customs. If such is done prior filing the infringement lawsuit, the lawsuit must be filed in ten days.

No criminal punishment is provided for in the current legislation. The criminal provisions have been annulled and the new ones are yet to be enacted.

TRADE SECRETS

NATURE OF RIGHT
Commercial secrets can be protectable as trade secrets.

LEGAL FRAMEWORK
There is no specific regulation governing trade secrets. Main applicable provision is the Turkish Commercial Code Article 55/(b)3. Solicitation of another’s employees, representatives or other persons to disclose or gain that person’s manufacturing and business secrets constitutes unfair competition.

Also trade secrets might be protected according to general good faith and honesty principles.
REMEDIES FOR INFRINGEMENT
Remedies can include unfair competition remedies, for example compensation and injunction. Claims must be filed within one year of learning of the unfair act and within three years of the occurrence of the act, unless a longer criminal prescription is foreseen.

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

EMPLOYEES
In principle, the right to use the copyrights that are formed during the employment relationship belongs to the employer. The right to use the industrial rights that are formed or invented during the employment relationship also belongs to the employer in principle. But the employer has to inform the employee of its intention to use or not to use the right. Nevertheless, if the employee does not use the skills he learned from his job, then the invention will be deemed as an independent invention and belong to the employee as a rule. However, if the invention relates to the field in which the employee is working, the employee has to offer the right to use the invention to the employer.

CONSULTANTS/CONTRACTORS
In practice, clauses for intellectual property are included in contracts stating who will retain ownership of the rights. If not explicitly stated in contracts, then the rules for employees can be applied by analogy for those who work as consultants and contractors.

KEY COMMERCIAL CONTRACT CONSIDERATIONS

REGISTRATION OF COMMERCIAL AGREEMENTS
There is no general registration requirement for commercial contracts in principle. However, the intellectual property license agreements can be registered before the Turkish Patent Institute as a public record and be used to claim rights against third parties.

RECOGNIZED LANGUAGE OF COMMERCIAL AGREEMENTS
If the agreement is concluded between two Turkish parties, the agreement will not be valid unless concluded in Turkish. If at least one party is not Turkish, then the agreement can be concluded in another language.

COUNTRY-SPECIFIC ISSUES FOR ONLINE CONTENT
Pursuant to the Law on Regulation of Internet Publications and Combat Against Crimes Conducted Via These Publications, hosting service providers can defend themselves against liability for infringing contents. This depends on fulfillment of the rules expressed in the law and relying on the right defenses.

ENFORCEABILITY OF ONLINE/CLICKWRAP/SHRINKWRAP TERMS
Enforceability of online terms is unclear. However, it is a customary practice for vendors to include check boxes as a way for customers to provide assent to their terms and indicate that they have been read.

GOVERNING LAW
Although it depends on the commercial contract, even if another law is chosen by the parties, the courts tend to apply Turkish law by invalidating law selection clauses based on consumer protection legislation.
KEY COMMERCIAL CONTRACT TERMS

ENFORCEABILITY OF WARRANTY DISCLAIMERS
Warranty disclaimers are encouraged to be included in agreements. They are quite common in customary practice as well. Nevertheless, the law sets minimum thresholds for warranty. For instance, electronic devices have to provide a warranty period for a minimum of two years.

ENFORCEABILITY OF EXCLUSIONS/LIMITATIONS OF LIABILITY
Exclusions/Limitations of liability clauses are generally incorporated in commercial agreements if customers have seen, understood and accepted such clauses. However, there is a strong practice regarding consumer protection that would result in invalidity of such clauses. Therefore, in drafting these types of exclusions and limitations, the relevant rules have to be taken into consideration to craft an equitable clause.

INDEMNIFICATION
Fixed clauses for liquidated damages could be enforced if stated expressly in the contracts. However, the actual damages will also be taken into consideration. If the indemnification clause results in too high a damage claim, it could be decreased to a reasonable level, i.e., lower level, by the courts.
UNIVERSAL ARAB EMIRATES

INTELLECTUAL PROPERTY FRAMEWORK

In the United Arab Emirates (UAE), intellectual property rights are governed by the following Federal Laws:

(i) Federal Law No. 15 of 1980 (Printed Matter and Publishing Law)
(ii) Federal Law No. 7 of 2002 (Copyright Law)
(iv) Federal Law No. 37 of 1992 as amended by Federal Law No. 8 of 2002 (Trademark Law)

In addition, the UAE is a civil law jurisdiction, so the laws and regulations are codified. Though courts are not bound to follow the prior decisions of superior courts, they are treated as persuasive. On this basis, it is difficult to predict with a degree of certainty how the law will be applied by the court.

COMMERCIAL CONTRACT FRAMEWORK

Commercial contracts are generally governed by:

(i) Federal Law No. 8 of 1984 as amended (Commercial Companies Law)
(ii) Federal Law No. 18 of 1993 (Commercial Transactions Law)
(iii) Federal Law No. 5 of 1985 as amended (Civil Code)

Commercial contracts which are concluded electronically will be subject to additional requirements under Federal Law No. 5 of 2012 (Cyber Crime Law) and Federal Law No. 1 of 2006 (Electronic Transactions Law).

Commercial contracts with government entities are subject to additional requirements under Federal procurement regulations including Ministerial Decision (20) of 2000 on Departmental Contracts Regulation.

Some commercial contracts will also be subject to additional requirements in Federal Law No. 24 of 2006 (Consumer Protection Law).

Exclusive distribution agreements and agency agreements (including franchise agreements) that have been registered with the Ministry of Economy as a commercial agency will be exclusively governed by Federal Law No. 14 of 1998 as amended by Federal Law No. 13 of 2006 (Agency Law).

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4 This overview relates to the Federal Laws of the UAE only. It does not cover the separate jurisdictions of any free zones in the UAE (including the Dubai International Financial Centre).
RECOGNIZED INTELLECTUAL PROPERTY RIGHTS

COPYRIGTHS

NATURE OF RIGHT
A “work” is defined under the Copyright Law as “any creative work in the field of literature or the arts or sciences of whatever kind or manner of expression or whatever its importance or its purpose.” It need only not be a copy and have sufficient differences from other works to be able to be distinguished from them.

The general principle is that copyright exists automatically without the need for registration. Copyright material may be registered in the UAE but this is essentially a process of depositing the work at the Ministry of Economy. However, enforcement of copyright which has not been registered may be difficult.

LEGAL FRAMEWORK
Copyrights are governed by the Federal Law No. 15 of 1980 (Printed Matter and Publishing Law) and Federal Law No. 7 of 2002 in respect of Author Copyrights and Parallel Rights (Copyright Law).

In addition to the Berne Convention, the UAE has acceded to the WIPO Copyright Treaty, the Rome Convention and the WIPO Performances and Phonograms Treaty.

DURATION OF RIGHT
Rights protected under the Copyright Law are protected for the entire lifetime of the author, and then for 50 years following the death of the author. Where the author is a corporate person, the right shall be protected for 50 years from the date of publication of the protected work.

OWNERSHIP/LICENSES
Assignments and licenses are both described under the Copyright Law as “transfers.” For a transfer to be valid, it must be in writing and while there is no requirement for the transfer to be notarized and legalized, in practice, government authorities in the UAE may not accept a document that has not been formalized in this way. Similarly, the document should be in Arabic and if it is not, it should have an official Arabic translation. The right that is the subject of the transfer must be specified together with the purpose of the transfer. There is a requirement for the period of exploitation to be identified for all licenses, together with the geographical area in which that the right will subsist.

REMEDIES FOR INFRINGEMENT
The court may grant remedies in the event of a successful claim for copyright infringement. These include:

(i) Orders to gather evidence;
(ii) Orders to seize works copies and the means of infringement;
(iii) Orders to stop certain acts; and
(iv) Orders to assess profits made as a result of the infringement.
No provision is made under the Copyright Law for the payment of damages. Instead, the rights holder must resort to other laws (such as the Commercial Transactions Law) to claim compensation.

Copyright infringement is also a criminal offense, and on conviction, the court may order confiscation and destruction of seized copies and equipment and the publication of the judgment in the newspapers. The court also has the right to close the business that committed the infringement for up to six months.

**MASK WORKS**

**NATURE OF RIGHT**
Mask works do not benefit from specific protection under the law in the UAE.

**PATENTS**

**NATURE OF RIGHT**
In relation to a product patent, the right to exploitation includes the right to:

(i) Manufacture the product;
(ii) Use the product;
(iii) Offer the product for sale;
(iv) Sell the product; and
(v) Import the product for any of the above purposes.

In the case of a process or method patent the right to exploitation includes the right to:

(i) Use the process or method;
(ii) Use the product that is obtained directly by means of the process or method;
(iii) Offer for sale the product that is obtained directly by means of the process or method;
(iv) Sell the product that is obtained directly by means of the process or method; and
(v) Import for any of these purposes the product that is obtained directly by means of the process or method.

Rights of prevention do not extend to acts done for non-commercial or non-industrial purposes and do not limit what can be done with a product after it has been sold.

**LEGAL FRAMEWORK**

**DURATION OF RIGHT**
Patents are valid for 20 years from the filing date.
OWNERSHIP/LICENSES
Both patent applications and granted patents can be assigned. Assignments must be executed in accordance with the Patent Law and recorded in the register. Both assignments of applications and granted patents are subject to the vetting procedure of the Department of Industrial Property and may be rejected on a wide range of grounds.

The owner may license the use or exploitation of “the right [which is] the subject of the protection” (Patent Law Article 54). The licensor should be able to license the various rights separately, for example, he should be able to give the right to produce the product (in the case of a product patent) to one person and the rights to offer it for sale and sell it to another, subject to approval from the Department of Industrial Property.

Article 54 of the Patent Law provides that the license term may not exceed the term of protection given by the law so no license can grant rights that exceed the term of patent protection. If no term is expressly stated in the license the term of the license is deemed to be the entire term of the patent.

All licenses are deemed to be non-exclusive unless they are expressed to be otherwise, similarly all licenses are deemed to be for “all the lands of the state” unless stated otherwise (Patent Law Article 57(1)). This means that the licensee is permitted to exercise its rights under the license anywhere in the UAE unless the license expressly states otherwise.

The licensee has the right to prevent infringement or threat of damage to the patent, however, the licensee may only instigate legal and judicial proceedings and demand compensation after the licensee has informed the patentee by registered letter and the patentee does not undertake the “necessary procedures” within 30 days of notice (Patent Law Article 57 (2)).

REMEDIES FOR INFRINGEMENT
The Patent Law sets out four criminal acts relating to infringement:

(i) Filing a false or forged document to obtain a patent, utility certificate, know-how or industrial drawing or design registration;

(ii) Declaring information that is false to obtain a patent, utility certificate, know-how or industrial drawing or design registration;

(iii) Copying an invention or method of manufacture or element of know-how; and

(iv) Intentionally infringing any right protected by the Patent Law.

A right holder or a licensee may apply for a precautionary attachment order ex parte to the urgent matters judge. The Patent Law gives the court the right to confiscate attached items but does not give the right to grant injunctions, which would order the defendant to stop the infringing acts. Compensation must be obtained under the Commercial Transactions Law.

TRADEMARKS

NATURE OF RIGHT
Registration of trademarks in the UAE is voluntary. It provides the proprietor with the exclusive right to the use of the mark in connection with the goods or services for which it is registered (Article 7 Trademark Law).
LEGAL FRAMEWORK
Trademarks are governed by Federal Law No. 37 of 1992 as amended by Federal Law No. 8 of 2002 as amended (Trademark Law).

The UAE is party to the Paris Convention and the TRIPS Agreement. The UAE is not party to the Madrid Protocol.

DURATION OF RIGHT
Registrations are valid for ten years from the date of the filing of the application, and can be renewed for successive ten-year periods.

OWNERSHIP/LICENSES
The UAE operates a mono-class system which means that a separate application must be filed for each trademark in each class of goods or services. The UAE follows the 9th Edition of the Nice Classification of Goods and Services. Applications for Class 33 are not accepted.

As a contracting party of the Paris Convention, the UAE is bound to follow the minimum standards that it sets. As such, in the UAE, a trademark owner has the right to claim priority from an earlier filed application. The priority period is six months from the filing date of the first application.

Article 17 Trademark Law grants trademark owners a higher level of protection of their rights when the following conditions have been satisfied:

(i) The owner has used the mark continuously for no less than five years from the date of registration; and

(ii) No decision has been issued in which it is decided that the registered owner is not the owner of the mark.

The protection that is granted is that no dispute may be raised against the ownership of the mark.

Conversely, the court can make an order for the cancellation of a mark for non-use. The parties must prove/disprove that the mark has not been used for five consecutive years. Use of the trademark by a licensee is deemed to be “use” for the purposes of disproving a non-use claim.

Trademarks may be licensed in the UAE. Licenses must be made pursuant to a written and legalized contract. This means that the contract must be witnessed by a notary public. If the contract is made in the UAE it must be witnessed by a UAE notary. Licenses exercised outside of the UAE must be legalized up to the UAE embassy in that country and then stamped by the Ministry of Foreign Affairs in the UAE. If the license is not in Arabic it must be translated either by a UAE licensed translator or a foreign translator and legalized up to the UAE embassy before it can be used for official purpose in the UAE.

Trademark licenses can only be registered in respect of registered trademarks and the term of the license must not exceed the term of the registration. All licenses are non-exclusive unless expressed to be otherwise.
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REMEDIES FOR INFRINGEMENT
In the UAE, trademark infringement is a criminal offense. Article 37 of the Trademark Law deals with the various offenses which range from the counterfeit and imitation of trademarks to the use and sale of products bearing an imitation of a trademark.

The Trademark Law provides for a fine of not less than AED 5,000 and imprisonment as the punishment for counterfeiting cases. Other penalties include the destruction of unlawful goods and a publication of the judgment at the expense of the defendant. There is also a right to claim compensation for damage resulting from the commission of any of the criminal acts under the Trademark Law. A claim must be made in the civil court to seek "compensation commensurate with the damage suffered" (Article 40 Trademark Law).

UAE law does not explicitly provide trademark owners with the right to apply for an injunction. In practice, the UAE Courts have granted “stop” orders to successful applicants.

The court may order the confiscation of things that have been attached. Further, the court may order the destruction of unlawful marks and it may order the publication of the judgment in the Trademark Journal and in any one of the Arabic newspapers published in the UAE at the expense of the defendant.

A trademark owner can petition the judge of urgent matters on an ex parte basis for a Precautionary Measures Order on the grounds that one or more of the crimes set out in the Trademark Law is being commissioned. However, civil proceedings must be commenced very quickly afterwards which limits the effectiveness of this type of Order.

TRADE SECRETS

NATURE OF RIGHT
Article 905 of the Civil Code provides that employees must not disclose industrial or trade secrets of their employer, even after the expiration of their employment contract.

Under Article 379 of the Penal Code, an employee who is entrusted with a secret by virtue of their trade, position, profession or art and who discloses that secret, or uses that secret for personal gain, is liable for penalties (see below).

Article 120 of the Labor Law also allows an employer to dismiss an employee without notice if they reveal any secrets of the establishment in which they have been working.

LEGAL FRAMEWORK
Trademark secrets are addressed by Federal Law No. 3 of 1987 (Penal Code), Federal Law No. 5 of 1985 as amended (Civil Code), and Federal Law No. 8 of 1980 as amended by Federal Law No. 8 of 2007 (Labor Law).

DURATION OF RIGHT
No time limits are placed on the confidentiality of the trade secret, and so this right will exist for as long as the information remains a trade secret.
OWNERSHIP/LICENSES
A trade secret will be owned by the entity to which the secret pertains.

REMEDIES FOR INFRINGEMENT
Penalties under the Penal Code include imprisonment for not less than one year and a fine of not less than AED 20,000.

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

EMPLOYEES
The Copyright Law restricts the right to assign copyright in future works. Specifically, future copyright may only be assigned in up to five future works. In practice, this requires that after an author has created five works, he will continue to own copyright from the sixth work onwards. Standard language in employment contracts often vests ownership of all works created by the employee in the employer. Employers that usually rely on future copyright assignments need to ensure they also have the right to require the employee to enter into additional assignments of copyright subsisting in additional future works and requiring retroactive assignments after they have been created. Ideally, they should also insist on a license covering the period between creation and assignment, because those rights will not automatically vest in the employer.

CONSULTANTS/CONTRACTORS
Please see point above in relation to employees. The same framework applies to all types of employment contracts including those with consultants and contractors.

KEY COMMERCIAL CONTRACT CONSIDERATIONS

REGISTRATION OF COMMERCIAL AGREEMENTS
There is no requirement to register a commercial agreement in the UAE. However, exclusive distribution agreements and agency agreements (including franchise agreements) can be registered with the Ministry of Economy as a commercial agency under the Agency Law.

If an agreement is registered as a commercial agency, the UAE Courts will have exclusive jurisdiction in the event of a dispute and will apply UAE law notwithstanding what the parties agreed in the contract (Article 6 Agency Law).

If an agreement is registered, the local agent will be able to benefit from statutory rights which cannot be waived by contract. The most pertinent of these statutory rights are:

(i) Their entitlement to territorial exclusivity;
(ii) Their presumptive extra-contractual right to compensation in the event of termination;
(iii) Their entitlement to receive commissions on sales of the products in their designated territory irrespective of whether such sales are made by or through them; and
(iv) Their ability to prevent the import of products into the UAE where they are not the consignee.
For as long as the agreement is registered, the Agency Law will allow the local agent to:

(i) Stop the imports of any products which are the subject of their distribution agreements and where they are not the consignee;

(ii) Prevent the sale of any of these products by third parties to retailers;

(iii) Issue criminal proceedings against the principal, its affiliates and any newly appointed agents in the UAE who are engaged in the activities covered by the registered agency (Article 22 imposes a fine of 1,500 on any person (this can include the principal) engaged in the activities covered by a registered agency with a party other than the registered agent); and

(iv) Issue civil proceedings against the principal for breach of contract and breach of the Agency Law to (i) claim compensation and (ii) claim the commissions made by such agents on any sales of the products made in their territories.

Where the agreement is registered, the UAE Courts will have jurisdiction over disputes and will apply UAE law. In addition, unless a principal has a legitimate material reason to terminate or refuse to renew an agreement which has been registered as a commercial agency, it can only be terminated by the mutual agreement of the parties.

The approach of the UAE Courts tends to be to protect an “agent” (understood to mean a distributor, licensee or franchisee, and typically a UAE entity) at the expense of a non-UAE principal. As such, even where agreements are not registered, there is a risk that the UAE Courts will award compensation to the “agent” on termination. When drafting an agreement with a UAE entity, steps should be taken to avoid the risk of the UAE Court accepting jurisdiction.

RECOGNIZED LANGUAGE OF COMMERCIAL AGREEMENTS
Contracting parties are free to choose the governing language of their agreements but, if an agreement is to be submitted to any official body or is subject to consideration in a local court in the UAE, it must be translated into Arabic.

ENFORCEABILITY OF ONLINE/CLICKWRAP/SHRINKWRAP TERMS

Online Terms

Consent and acceptance to enter into a contract may be expressed electronically. Article 17(1) bis. Federal Law No. 10 of 1992 the Law of Evidence in Civil and Commercial Transactions as amended (Law of Evidence) provides that an electronic signature shall be “any electronic signature, any letters, figures, codes, signs, images or sounds having a unique character allowing for identifying the signatory and distinguishing him from others.” Article 17(3) provides that electronic signatures may be afforded the same evidential weight as physical signatures if they comply with the provisions prescribed in the Electronic Transactions Law.

Clickwrap/Shrinkwrap Terms

Article 12 of the Copyright Law provides that the assignment of rights to commercial exploitation to computer software, its applications or databases, shall be subject to the licensing agreement associated or attached to the program, whether appearing on the supporting bar or upon downloading or saving the program. The buyer or user of the program shall be bound to abide by the terms set out in the said agreement.
GOVERNING LAW
While parties are free to choose a foreign law to govern an agreement, the UAE Courts may as a matter of practice set aside such a provision and apply UAE law. Issues may arise as to the enforceability of a foreign law decision on disputes which relate to the infringement of intellectual property rights where there is a nexus with the UAE, e.g., where one or more of the infringers reside in the UAE. This is because such infringements are considered to be criminal in nature, which allows UAE Courts to assume exclusive jurisdiction and apply UAE laws.

KEY COMMERCIAL CONTRACT TERMS

ENFORCEABILITY OF WARRANTY DISCLAIMERS
In the UAE, suppliers of products (goods and services) are required to warrant that the products supplied conform to safety standards, are of good workmanship and are suitable for use in relation to their intended purposes. Suppliers are also required to warrant that the products are free from any defects and to undertake the repair or replacement of defective products. Generally, suppliers cannot contract out of these requirements. The local courts may therefore construe a warranty disclaimer accordingly.

ENFORCEABILITY OF EXCLUSIONS/LIMITATIONS OF LIABILITY
Under UAE law, absolute exclusions of liability in contracts are null and void. Though restrictions on the ability of one contracting party to make a recovery of losses as a result of fault by the other contracting party are not generally enforceable in the UAE, the UAE Courts would be reluctant to award damages for economic reasons, other than those which the claimant can prove were actually suffered as a direct result of the defendant’s fault.

INDEMNIFICATION
In the UAE, a contracting party is only liable to indemnify another contracting party for losses which are proven to have been or will be actually incurred by the other party. Successful litigants usually only recover a nominal amount in respect of their legal costs of litigation which have little bearing on their actual legal costs.
Intellectual property rights are governed by a variety of statutes and common law. The substantive provisions are generally equally applicable throughout the United Kingdom (comprising England, Wales, Scotland and Northern Ireland). As the UK is part of the European Union (EU), some of its intellectual property law derives from EU legislation.

**COMMERCIAL CONTRACT FRAMEWORK**

The UK has three distinct legal systems:

(i) English law applicable in England and Wales;
(ii) Northern Irish law applicable in Northern Ireland; and
(iii) Scottish law applicable in Scotland.

This overview relates only to English law, which is the predominant jurisdiction used for purposes of commercial contracts in the United Kingdom and Scotland.

Commercial contracts are governed by domestic legislation, case law, the operation of EU law and international treaties in certain circumstances. There are specific rules that may apply to certain types of commercial contracts. There are often more stringent rules for consumer contracts, i.e., made between a business and a consumer to address the often unequal balance between the parties.

The interpretation and enforceability of commercial contracts is generally a matter for the courts and a number of common law principles have evolved through case law. Each contract and clause will, however, be determined on an individual basis depending upon the facts of the case in question and some well-established interpretive rules.

In addition, there are a number of statutes which are likely to require contractual protections drafted into the majority of contracts. For example, the Bribery Act 2010, which has extra-territorial effect and potential criminal sanctions for non-compliance; the Transfer of Undertakings (Protection of Employment) Regulations 2006, which provide that in certain circumstances employees of one contracting party may transfer to the other contracting party; and contracts with public sector authorities are generally subject to a more rigorous statutory framework.

**RECOGNIZED INTELLECTUAL PROPERTY RIGHTS**

**COPYRIGHT**

**NATURE OF RIGHT**

Copyright protection is available for works covered by the categories protected by the Copyright Act, which includes artistic, literary (including software), dramatic, musical, sound recording, film, broadcasts and typographical arrangements. Literary, dramatic, musical or artistic works must be original to qualify for protection.
Copyright owners have the exclusive right to prevent others copying the work, issuing copies of the work to the public, renting, lending, performing, showing, communicating works to the public or making an adaptation of the work.

Knowingly dealing with infringing copies is also prohibited as “secondary infringement.”

There is no requirement for a copyright to be registered, and no copyright registration system.

LEGAL FRAMEWORK
The UK became a signatory to the Berne Convention in 1887.

Copyright Designs and Patents Act 1988, as (extensively) amended (Copyright Act) governs copyrights.

Copyright and Rights in Databases Regulations 1997 govern separate sui generis rights in relation to databases in which an investment has been made in obtaining/verifying/presenting their contents.

DURATION OF RIGHT
Provided the work qualifies for protection, protection arises automatically on creation of the work.

For literary, dramatic, musical and artistic works, duration is the author’s life plus 70 years after the author’s death, unless it is computer generated, in which case copyright subsists for 50 years from the end of the calendar year in which it was made. Film copyright expires 70 years after the last death of the director, author and composer. Copyright in broadcasts expires 50 years from the end of the year of the broadcast. Copyright in published editions expires 25 years from the end of the year of first publication.

OWNERSHIP/LICENSES
Joint ownership of copyright is recognized, and arises automatically where a work has more than one author. Joint ownership can create limitations on the ability of a joint owner to independently exploit the relevant work.

REMEDIES FOR INFRINGEMENT
Principal remedies are injunctions (or interdict in Scotland), damages or an account of profits, delivery up, seizure, or destruction of infringing goods. No statutory damages are available. The starting point for the damages calculation is a reasonable license fee. Aggravated damages for flagrancy are possible.

It is also possible to prevent the import and export of infringing copies. Criminal penalties are also possible for secondary infringement.

MASK WORKS

NATURE OF RIGHT
The equivalent to a “mask work” right is a semiconductor topography right. However, this is rarely used. Integrated circuit layouts are protected through use of other intellectual property rights, e.g., copyright.
The right protects a UK unregistered design (within the meaning of the Copyright Act) which is:

(i) A pattern fixed or intended to be fixed in or upon:
   a. A layer of semiconductor product; or
   b. A layer of material in the course of and purpose of the manufacture of a semiconductor product; or

(ii) The arrangement of patterns fixed, or intended to be fixed, in or upon layers of a semiconductor product in relation to one another.

A semiconductor product is defined as an article consisting of at least two layers, at least one composed of semiconducting material, and in or upon one or more of which a pattern is fixed. The article must have as a purpose the performance of an electronic function.

The right is infringed by reproducing the design, either by making articles based on the design, or by creating design documents for the purpose of making such articles.

**LEGAL FRAMEWORK**
Design Right (Semiconductor Topographies) Regulations 1989 (as amended) governs semiconductor topographies.

**DURATION OF RIGHT**
The duration of protection is ten years from the end of the calendar year in which the design or an article made to the design was first made available anywhere in the world or, if not made available, 15 years from when the design was first recorded or an article made to it.

**OWNERSHIP/LICENSES**
The designer is the first owner of any semiconductor topography right if the design is not created under commission or in the course of employment.

For commission, the commissioner is the first owner of any semiconductor topography right, subject to agreement to the contrary. If created in the course of employment, the employer is the first owner of the right, subject to any agreement to the contrary between the parties.

**REMEDIES FOR INFRINGEMENT**
Injunctions (or interdict in Scotland), damages, an account of profits, delivery up, seizure or destruction of infringing products.

**PATENTS**

**NATURE OF RIGHT**
Patents are a registered right which may be obtained to protect inventions (which may include, for example chemical compounds, products, systems, processes and methods). Designs are protected by means of design rights, not by design patents. To be patentable, an invention must (i) be novel; (ii) involve an inventive step over the prior art; (iii) be capable of industrial application (which will be satisfied almost all cases); and (iv) not solely consist of excluded subject matter (such as discoveries, scientific theories, mathematical methods, aesthetic creations, business methods and computer programs). Hence business methods and computer programs are patentable provided the invention makes a contribution to the art over and above the fact it is a business method or computer program.
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It is possible to apply for a patent within the UK through the national route, the Patent Cooperation Treaty or under the European Patent Convention (a centralized process administered by the European Patent Office).

A patent owner may prevent third parties performing certain specified activities in relation to products or processes embodying the invention, or products derived from a patented process, including manufacturing, offering for sale and using a product or using or offering for use a process knowing that such use is an infringement in the UK.

Knowingly offering, for supply, an essential element of the invention for putting it into effect in the UK is also prohibited.

LEGAL FRAMEWORK
The United Kingdom became party to the Patent Cooperation Treaty in 1978 and the Paris Convention in 1884.

Patents Act 1977 governs patents.

DURATION OF RIGHT
Patents have a duration of 20 years from the filing date, subject to payment of renewal fees and as long as the patent is not invalidated.

OWNERSHIP/LICENSES
The UK has a “first to file” system. Subject to an employee’s responsibilities and duties, ownership will normally vest in the employer.

Co-owners are considered to have an equal undivided share in a patent subject to agreement to the contrary and consequently cannot assign or license their share without consent of the other unless otherwise agreed.

There are certain advantages to be obtained from registering assignments or assignations and licenses, e.g., binding third-party acquirers, but there is no strict requirement to do so.

When granting licenses it is generally advisable to include quality control and use provisions and prohibitions on sublicensing.

REMEDIES FOR INFRINGEMENT
Remedies for infringement can include injunctions (or interdict in Scotland), damages, an account of profits, an order for delivery up, seizure or destruction, as well as a declaration of validity and/ or infringement.

The Patents Act provides an actionable right against those who make unjustified threats of patent infringement.
TRADEMARKS

NATURE OF RIGHT
A registered right which may be obtained to protect a distinctive, non-descriptive sign consisting of words, slogans, designs, letters, numbers, domains, shapes, smells, sounds, colors, gestures or moving images that can be represented graphically and can be used to distinguish goods and services of one undertaking from those of another. Subject to various grounds for refusal including conflicts with prior rights.

It is possible to register a sign as a national UK trademark or as a Community Trade Mark (CTM) that applies to the UK and all other EU member states.

A trademark is infringed by use of an identical/similar sign for identical/similar goods or services for which the mark is registered where there exists a likelihood of confusion on the part of the public. Additional protection is given for well-known marks. Infringement of a CTM potentially gives a trademark owner EU-wide relief.

LEGAL FRAMEWORK
The United Kingdom became member of the Madrid Protocol in 1995.

The United Kingdom became party to the Trademark Law Treaty in 1996.

Trademarks are governed by the Trade Marks Act 1994 (UK marks) and the Community Trade Mark Regulation 207/2009 for CTMs (expected to be replaced by a new Regulation in the near future).

DURATION OF RIGHT
Trademarks are perpetual subject to renewal every ten years and as long as the trademark is not revoked.

OWNERSHIP/LICENSES
Both the UK registry and Community Trade Mark (CTM) registry Office of Harmonization for the Internal Market (OHIM) have a “first to file” system, though the registration may be refused or revoked if it conflicts with prior rights.

There are certain advantages to be obtained from registering assignments or assignations and licenses, e.g., binding third-party acquirers of the mark, but there is no strict requirement to do so.

When granting licenses, it is generally advisable to include quality control provisions to preserve the mark’s reputation and distinctiveness, and prohibitions on sublicensing.

REMEDIES FOR INFRINGEMENT
 Remedies for infringement include injunctions (or interdict in Scotland), damages, an account of profits, orders for erasure, removal or obliteration of offending sign, orders for delivery up or destruction. There is also a customs seizure regime.

There is an actionable right in the UK against those who make unjustified threats of trademark infringement.
TRADE SECRETS

NATURE OF RIGHT
The status of trade secrets as an item of property is not clear; the more generally accepted view is that trade secrets are not property. However, trade secrets may be protected either through a breach of contract action, where a non-disclosure agreement exists or can be implied, or a common law action for breach of confidence.

A common law action for breach of confidence is the principle that for information received in confidence a person cannot take unfair advantage of that information or prejudice the person giving the information. The same principle applies both in Scotland and in England.

To qualify, information must have the “necessary quality of confidence” and must be “disclosed in circumstances importing an obligation of confidence,” e.g., imposed by contract, implied by the circumstances of disclosure, or implied due to the relationship between the parties, such as employer/employee. However in employer/employee relationships in particular, there are limits as to how far information can be protected after termination of the relationship (information must be confidential to a sufficiently high degree, with highly confidential trade secrets possibly being protected indefinitely).

LEGAL FRAMEWORK
Case law governs trade secrets and is not the subject of legislation.

DURATION OF RIGHT
Trade secret protection has a potentially indefinite term.

However, information can lose the necessary quality of confidence and hence no longer be protectable, for example, if it enters the public domain, becomes out of date or loses its commercial value. Also, where the obligation of confidentiality arises under a contract, the duty of confidentiality will only apply for the duration specified in the contract.

REMEDIES FOR INFRINGEMENT
Injunctions (or interdict in Scotland), damages, an account of profits, and delivery up or destruction of records of confidential information illegitimately retained are possible remedies for misappropriation.

PASSING OFF

NATURE OF RIGHT
The tort of passing off (or a delict in Scotland) relates to misrepresentations made by one trader that damages or may damage the goodwill of another. It can be used to protect unregistered business and product names, logos and “get-ups.”
The “classic form” of passing off is generally defined by reference to three requirements: (i) goodwill in the UK attached to the goods or services; (ii) a misrepresentation by the defendant to the public (intentional or not) leading the public to believe goods or services are those of (or connected with) the plaintiff; and (iii) plaintiff suffers or likely to suffer damage due to that. However, the misrepresentation may be as to other matters, such as:

(i) That the plaintiffs goods are those of the defendant (reverse passing off);
(ii) Misrepresentations as to quality; and
(iii) False endorsement.

The misrepresentation must be one which confuses or deceives the public or is likely to. Goodwill has been described as the “benefit and advantage of a good name or reputation…” or the “attractive force that brings in customers.” Goodwill can be limited to certain areas/geographic locations.

The extended form of passing off requires (i) a misrepresentation; (ii) made by a trader in the course of trade; (iii) to prospective customers or ultimate consumers; (iv) which is calculated to injure the business or goodwill of another, i.e., such injury must be reasonably foreseeable; and (v) which causes actual damage to a business or goodwill.

LEGAL FRAMEWORK
Case law governs actions for passing off and they are not the subject of legislation.

DURATION OF RIGHT
There is no duration; however, goodwill must still subsist. It is possible that a business may have residual goodwill, even if no longer trading.

OWNERSHIP/LICENSES
Goodwill can be jointly owned and is considered to be a form of property right that can be transferred like any other property right.

As a general rule, goodwill accrues to the business and not to individual employees.

REMEDIES FOR INFRINGEMENT
Available remedies include injunctions (or interdict in Scotland), damages, an account of profits and delivery up, seizure or destruction or modification of packaging, products, marketing materials and similar.

DESIGNS

NATURE OF RIGHT
There are four types of design rights in the UK: registered and unregistered UK design rights, and registered and unregistered European Community design rights.

A registered design and a Community unregistered design can be the whole or part of a product resulting from features of lines, contours, colors, shape, texture or materials of a product or its ornamentation. This can include packaging, get up, graphics and typefaces.
Registered designs and Community unregistered designs must be new (not previously disclosed or available to the public anywhere in the world) and have individual character (creating a different overall impression on the “informed user” taking into account design freedom). There are exceptions to this and features dictated by function (must fit and must match exceptions) cannot be protected.

To obtain registered design right protection, it is necessary to register either with the UK Intellectual Property Office (UKIPO) or OHIM (for a Community registration). The UK is a “first to file” system, although a registration may be refused or revoked if it conflicts with prior rights. Unregistered design rights arise automatically.

The proprietor of the design may prevent any use of the design or any design which does not produce a different overall impression on the informed user (taking into account design freedom). To infringe unregistered Community design right the defendant must have copied the design. Copying is not a requirement to infringe registered design rights.

The regime for subsistence and infringement of UK unregistered design right is different. The right subsists in the shape of the whole or part of an article that is original and not commonplace, recorded in a design document or the subject of an article made to the design and created by a qualifying person. A key difference is that UK unregistered design right does not protect surface decoration.

LEGAL FRAMEWORK
The Registered Designs Act 1949 (as amended) governs UK registered designs, the Copyright Designs and Patents Act 1988 (as amended) governs UK unregistered designs, and the Community Designs Regulation (6/2002/EC) governs Community registered and unregistered designs.

DURATION OF RIGHT
Registered designs subsist for 25 years, subject to payment of renewal fees (every five years) for both UK and Community registrations and as long as the registration is not revoked.

UK unregistered designs are protected for ten years from the first marketing of articles made to the design or 15 years from creation of the relevant design document.

Unregistered Community design protection lasts for three years from the date that the design is made available to the public.

OWNERSHIP/LICENSES
Both the UK and CTM registry (OHIM) have a “first to file” system, though the registration may be revoked if it conflicts with prior rights.

Generally, a designer will be the owner of the right. Employers generally own a design if it is created in the course of employment.

In the last five years of a UK unregistered design right any person is entitled to a license. If parties cannot agree on the terms, the Comptroller of Patents, Designs and Trademarks will settle the terms (this can be a lengthy process but an infringer can manufacture products pending settlement of the terms).

REMEDIES FOR INFRINGEMENT
Available remedies include injunctions (or interdict in Scotland), damages, an account of profits, delivery up, seizure or destruction of goods.

There is an actionable right in the UK against those who make unjustified threats of design right infringement.
INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

EMPLOYEES
With respect to copyright and design rights (including semiconductor topography designs), where an employee (as distinct from independent contractors) makes a work in the course of employment, the employer will be first owner of the copyright in the work, subject to agreement to the contrary.

Inventions belong to the employer if the invention was made in the normal duties of the employee or specifically assigned duties.

CONSULTANTS/CONTRACTORS
For copyright in commissioned works, the contractor will own the copyright subject to a written agreement to the contrary. The preferred approach is for a commissioner to take an assignment of all existing and future copyright in the works and any associated materials or documents and obtain a waiver from the contractor of his moral rights in the same.

Without express written provisions to the contrary, legal title in an invention will vest in the contractor unless a court implies a term into the contract granting ownership to the commissioner.

KEY COMMERCIAL CONTRACT CONSIDERATIONS

REGISTRATION OF COMMERCIAL AGREEMENTS
There are no general registration requirements for commercial agreements.

There is also a distinction in English law between two main forms of contract – those executed under hand (simple contracts) and those executed as a deed. A contract made under a deed requires additional formalities to be satisfied but does not require consideration to pass between the parties in order to be binding.

Documents governed by Scottish law are not executed by way of a deed. Statute sets out formalities which can be followed in order to ensure documents are self-proving.

Some commercial agreements may need to be disclosed in certain circumstances, for example, in relation to public companies and contracts with public sector authorities.

RECOGNIZED LANGUAGE OF COMMERCIAL AGREEMENTS
There is no general requirement that contracts be in English language in order to have legal effect. In relation to consumer agreements ‘plain English’ is preferred to enable consumers to understand the terms on which they contract, and the courts may strike down limitations or similarly onerous provisions in consumer facing contracts which are not worded sufficiently clearly or with sufficient prominence.

ENFORCEABILITY OF ONLINE/CLICKWRAP/SHRINKWRAP TERMS
This topic is subject to much academic debate but little judicial scrutiny. The predominant view is that if this issue were to be decided before an English Court, the court would seek to uphold a shrinkwrap license (particularly for licenses to business users) on the basis that they are now acceptable commercial practice.

There are a number of requirements which relate to online terms which govern transactions. For example, the Electronic Commerce (EC Directive) Regulations 2002 and the Consumer Protection (Distance Selling) Regulations 2000 (amongst other legislation) cover formation of contracts online.
GOVERNING LAW
Parties are free under Scottish and English law to choose the governing law and jurisdiction of a contract as well as any arbitration institution they may see fit. Generally, both the Scottish and English Courts will uphold an express choice of law. However, in some circumstances, an express choice of law may be challenged and the applicable law modified (eg if a different law has been chosen solely to avoid the application of the UK’s “unfair contract terms” legislation). In the event that there is no express choice of law in the contract, then, for contracts created on or before December 17, 2009, the provisions of Rome I Regulation apply. For contracts created before December 17, 2009, the provisions of the Rome Convention apply.

Arbitration is often used by parties to resolve commercial disputes. It is private and confidential and governed by the Arbitration Act 1996 and Arbitration (Scotland) Act 2010 (in Scotland). There are also a number of alternative dispute resolution procedures. These include mediation, early neutral evaluation and adjudication.

KEY COMMERCIAL CONTRACT TERMS

ENFORCEABILITY OF WARRANTY DISCLAIMERS
In a contract for the sale of goods, the Sale of Goods Act 1979 (SGA) implies a number of terms into an agreement. It is possible, to a certain extent, to disclaim such implied terms (see below).

The terms implied by the SGA include a condition that the seller has the right to sell the goods (Section 12), the goods conform to their description (Section 13), the goods are of satisfactory quality (Section 14) and a condition that the goods supplied will be reasonably fit for purpose (Section 14).

Where there is a supply of goods, terms are also implied (but similarly, may to an extent be disclaimed) by the Supply of Goods and Services Act 1982 (SGSA) relating to the description (Section 3) and quality (Section 4) of the goods transferred. In a Supply of Services, terms are implied relating to the care and skill with which the work is performed (Section 13), requiring the work to be carried out within a reasonable time (Section 14) and that, where consideration is not expressed in the contract, the party contracting the supplier will pay a reasonable charge.

The extent to which terms implied by the SGA and the SGSA may be excluded is largely expressed in the Unfair Contract Terms Act 1977 (UCTA). Where the contract is a ‘consumer’ contract, an attempt to exclude terms implied by either the SGA or the SGSA relating to ‘description’, ‘quality’ or ‘title’ is ineffective. In a commercial contract, such an exclusion clause is only enforceable insofar as it is ‘reasonable’, which includes having regard to the circumstances in which it was incorporated into the contract.

The restrictions in UCTA do not apply to international supply contracts where contracting parties have places of business in different states and the goods either cross from one country to another, or offer and acceptance take place in different countries.

When goods or assets are transferred, warranties may be implied (as above) under statute which are deemed to be conditions of the contract, for example, goods have to be of satisfactory quality and if the intended purpose for use was made known to the seller, then they have to be fit for purpose. The parties cannot exclude these implied warranties. However, other implied warranties will be subject to the ‘reasonableness’ test briefly described above.
Consumer contracts are also subject to the Unfair Terms in Consumer Contracts Regulations 1999 which set out a number of requirements including terms which may be considered unfair.

**ENFORCEABILITY OF EXCLUSIONS/LIMITATIONS OF LIABILITY**

With some notable and important exceptions, commercial entities are largely free to agree between themselves how to apportion this risk and to limit their respective liability to each other. These can take varied forms from the complete exclusion of liability for specific types of loss to requiring claims to be made within a specific time frame.

Parties cannot, however, exclude or limit liability for:

(i) Implied warranties (except as identified above);

(ii) Death or personal injury caused by their, or their employees, negligence; or

(iii) Fraudulent misrepresentation.

Other provisions seeking to exclude or limit liability for actions such as negligence may need to pass the “reasonableness” test set out under UCTA for them to be valid; this will however depend on a range of factors, including whether a supplier is contracting on its standard terms, and the balance of bargaining power between the parties.

English and Scottish contract provisions are construed *Contra Proferentum* (against the party that drafted them); therefore, care should be taken to ensure accurate drafting of liability clauses. Equally, where there is any ambiguity in an exclusion of liability clause this will be interpreted against the party seeking to limit/exclude their liability, so care should be taken when drafting to avoid ambiguous terms.

Liability will continue throughout the contract and may not cease after the contract has been fulfilled, subject to statute and any warranties and indemnities set out in the contract.

It is common practice for the parties to agree on the total amount which can be claimed in the event that a contract is breached, and to expressly state this cap in the contract.

**INDEMNIFICATION**

Indemnities are generally enforceable as a promise to be responsible for another’s loss on a pound for pound basis. In addition, depending on the drafting, indemnities may not be subject to a duty of mitigation on the party making such indemnity claim (albeit that case law is not consistent on this point).

Due to the fact that indemnities are primary obligations, they can remain valid even if the underlying transaction is set aside for any reason. This is different to the provision of a guarantee, which, as a secondary obligation, is dependent on the primary obligation existing.

An indemnity remains subject to the usual contractual principles of offer, acceptance, intention to create legal relations and consideration just like any other contractual terms.
UNIVERSAL STATES

INTELLECTUAL PROPERTY FRAMEWORK

As a general matter, intellectual property rights are governed by Federal statutes with certain exceptions, including trade secrets, which are governed by state law.

COMMERCIAL CONTRACT FRAMEWORK

There are no Federal statutes that govern commercial contracts generally, though there may be Federal statutes that are relevant to certain commercial arrangements, e.g., antitrust laws, and there may be industry-specific regulations at the Federal level that may be applicable to contracts in particular industries. There may also be state regulations applicable to specific industries that are relevant to commercial contracts.

With respect to commercial contracts, a version of the Uniform Commercial Code (UCC) has been adopted by each of the 50 states in the United States. The UCC is a uniform act and was drafted by private organizations as a recommendation on harmonizing the laws applicable to commercial transactions. Each state has adopted its own version of the UCC and so laws may differ slightly from state to state. The UCC governs transactions in goods, e.g., buying and selling, security interests, letters of credit and other commercial transactions.

The Uniform Computer Information Transactions Act (UCITA) was an attempt to provide guidelines on licensing of intellectual property and software, which Article 2 of the UCC (the Article dealing with “goods,” which has been interpreted to include software) did not expressly address. UCITA was controversial because of the potential liability it imposed on software vendors and therefore was never adopted by more than just a few states (Virginia and Maryland).

The interpretation and enforceability of commercial contracts is generally a state law matter that is governed by the laws of the state that is specified in the contract. Case law precedent interpreting and enforcing UCC provisions can differ from state to state.

Commercial contracts with Federal and state government agencies are subject to separate governmental regulations, which can include among other matters, specific auditing and recordkeeping requirements as well as intellectual property rights that can be granted to the government by default.

RECOGNIZED INTELLECTUAL PROPERTY RIGHTS

COPYRIGHTS

NATURE OF RIGHT

Copyrights are available for original works of authorship fixed in a tangible medium of expression. Registration is not required for valid copyright rights and the rights arise at the time the original work of authorship is fixed in a tangible medium of expression.

Copyright owners have the exclusive right to reproduce, distribute, prepare derivative works, publicly perform and publicly display their works of authorship.
GUIDE TO GOING GLOBAL - INTELLECTUAL PROPERTY AND TECHNOLOGY

LEGAL FRAMEWORK
Title 17 of the US Code governs copyrights. The United States became signatory to Berne Convention in 1988. However, moral rights are not recognized in the US Copyright Act even though the Berne Convention grants authors moral rights. Under US law, moral rights can receive protection through judicial interpretation of several copyright, trademark, privacy, and defamation statutes, and for authors of a work of visual art, through 17 U.S.C. §106A, known as the Visual Artists Rights Act of 1990 (VARA).

DURATION OF RIGHT
For works created after January 1, 1978, copyright protection lasts for the life of the author plus an additional 70 years. For an anonymous work, a pseudonymous work, or a work made for hire, the copyright endures for a term of 95 years from the year of its first publication or a term of 120 years from the year of its creation, whichever expires first. For works first published prior to 1978, the term will vary depending on several factors.

No renewal is required for works created on or after January 1, 1978. Renewal of works published or registered prior to January 1, 1978, renewal registration is optional after 28 years but does provide certain legal advantages.

If a copyrightable work is not a “work for hire,” an assignment of copyright can be terminated within a five-year period beginning 35 years after grant or if rights granted include right to publish then 35 years after publication or 40 years after grant of publication right, whichever is first.

OWNERSHIP/LICENSES
Joint ownership of copyrights recognized; duty to account can be waived by contract. Implied licenses are recognized.

REMEDIES FOR INFRINGEMENT
Copyright registration is required to claim statutory damages for infringement. Absent registration, only actual damages may be claimed.

Statutory damages range from $750/work – $30,000/work; innocent infringement can be as low as $200/work; willful infringement can be as high as $150,000/work.

Actual damages can be actual monetary loss suffered by the copyright owner and profits gained by infringer.

Attorneys’ fees of the copyright holder in a copyright infringement suit are available only if the work is registered.

It is possible to seek preventing importation of goods that are infringing.

Injunctive relief is also a possible remedy.

Criminal penalties are possible.
MASK WORKS

NATURE OF RIGHT
The right protects original mask works fixed in semiconductor chip products.

Mask works are defined as a series of related images, however fixed or encoded, (i) having or representing the predetermined three-dimensional pattern of metallic, insulating, or semiconductor material present or removed from the layers of a semiconductor chip product, and (ii) in which series the relation of the images to one another is that each image has the pattern of the surface of one form of the semiconductor chip product.

Semiconductor chip products are defined as the final or intermediate form of any product (i) having two or more layers of metallic, insulating, or semiconductor material, deposited or otherwise placed on, or etched away or otherwise removed from, a piece of semiconductor material in accordance with a predetermined pattern and (ii) intended to perform electronic circuitry functions.

Mask work owners have the exclusive right to reproduce the mask work by optical, electronic or other means, import or distribute the semiconductor chip product in which the mask work is embodied and induce or knowingly cause another person to do any of the foregoing acts.

LEGAL FRAMEWORK
Mask works are protected under the US Semiconductor Chip Protection Act, administered by Copyright Office which is different from copyright protection.

DURATION OF RIGHT
The duration of protection is ten years from registration (ends at the end of the tenth calendar year). There must be a registration within two years of first commercial exploitation.

OWNERSHIP/LICENSES
Joint ownership of mask works is recognized; duty to account can be waived by contract.

REMEDIES FOR INFRINGEMENT
Statutory damages can be up to $250,000 for each work.

Actual damages can be actual monetary loss suffered by the mask work owner and profits gained by infringer.

Attorneys’ fees and costs can be recoverable.

It is possible to seek preventing importation of goods that are infringing.

Injunctive relief is also a possible remedy.

Criminal penalties are possible under certain circumstances.

PATENTS

NATURE OF RIGHT
Patents are a statutory right granted consistent with mandate in US Constitution.

Patents grant the right to exclude others from making, using, selling, offering for sale and importing the claimed invention.
**LEGAL FRAMEWORK**


**DURATION OF RIGHT**

Patents have a duration of 20 years from the filing date of the application. The US is a “first to file” system as of March 16, 2013.

**OWNERSHIP/LICENSES**

Joint ownership is permissible and parties can contractually agree to waive the duty to account to other joint owners. A license can be granted by one joint owner without consent of the other joint owner. Implied licenses are recognized.

**REMEDIES FOR INFRINGEMENT**

The patent statute permits an award of damages in an amount adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs. Some awards may be a combination of lost profits and a reasonable royalty.

Treble damages up to three times actual damages are possible if the infringement is willful.

Failing to include appropriate patent marking can preclude recovery of damages for past infringement.

Injunctive relief is also a possible remedy.

**TRADEMARKS**

**NATURE OF RIGHT**

A word, phrase, symbol or design, or a combination of words, phrases, symbols or designs, that identifies and distinguishes the source of the goods of one party from those of others are protectable as trademarks.

**LEGAL FRAMEWORK**

Federal Lanham Act protects unregistered and registered marks; registered marks signified by ®; Federal registration requires use in interstate commerce.

Common law marks are enforced by state law; signified by ™.

State registrations are available for marks used in individual states.

The US became a member of the Madrid Protocol in 2003.

The US became a party to the Trademark Law Treaty in 2009.

**DURATION OF RIGHT**

Federal registrations are in effect for ten years; renewable indefinitely so long as the mark’s use in interstate commerce continues.

State registrations differ (for example, in California it is five years and in New York it is ten years).
OWNERSHIP/LICENSES
Owners granting licenses to trademarks must include appropriate quality control language in order to preserve and avoid dilution (or loss) of the mark.

REMEDIES FOR INFRINGEMENT
Damages can include actual damages or lost profits resulting from the infringement.

Treble damages are possible for willful infringement.

Injunctive relief is also an available remedy.

Registered marks can be filed with US Customs to prevent importation of goods that contain infringing marks.

Costs and reasonable attorneys’ fees can be recoverable for willful infringement.

TRADE SECRETS

NATURE OF RIGHT
Trade secrets are rights granted under state law. States adopting the Uniform Trade Secret Act (UTSA) impose liability for improper acquisition of trade secrets; use or disclosure of trade secret is not required for liability, though additional damages can accrue.

UTSA defines trade secrets under a two-prong test:

(i) “Information, including a formula, pattern, compilation, program, device, method, technique or process, that derives actual or potential economic value from not being known and not being readily ascertainable by proper means by others; ” and

(ii) Such information is subject to “reasonable efforts by the owner to maintain its secrecy. ”

The Restatement of Torts (Section 757) defines a trade secret as follows: “a trade secret ‘may consist of any formula, pattern, device or compilation of information which is used in one’s business, and which gives him an opportunity to obtain an advantage over competitors who do not know or use it.’” States adopting the Restatement of Torts approach require unauthorized use or disclosure for liability to accrue.

LEGAL FRAMEWORK
UTSA adopted by 46 states, the District of Columbia and the US Virgin Islands; some states have slightly broader or narrower definitions of trade secrets than others. Remaining states (New York, New Jersey, Massachusetts and Texas) have adopted the approach taken by Section 757 of the Restatement of Torts.

DURATION OF RIGHT
As long as reasonable efforts are taken by the owner of the information to maintain the information as a trade secret the duration of protection is potentially perpetual.

OWNERSHIP/LICENSES
Joint ownership is possible. Trade secret (or know-how) licenses are enforceable.
Guidelines for Going Global - Intellectual Property and Technology

Remedies for Infringement

Damages can include actual loss and unjust enrichment caused by misappropriation.

Treble damages for willful and malicious misappropriation can be awarded.

Statutory attorneys’ fees can also be awarded for willful and malicious misappropriation.

Actual or threatened misappropriation can be enjoined; imposition of reasonable royalties instead of injunction is permitted under exceptional circumstances.

Criminal penalties are possible under certain circumstances.

Intellectual Property in Employment Context

Employees

It is customary for employees to sign inventions assignment and confidentiality agreements. Some states (such as California and Washington) have statutory prohibitions on employers requiring employees to assign inventions that the employees have developed entirely on their own time without use of employer resources and that are unrelated to the employer’s business.

US copyright law recognizes a “work for hire” doctrine in which an employer owns works of authorship created by an employee within the scope of employment.

The “work for hire” doctrine does not apply to inventions or patents. Employee inventors own their inventions and the resulting patents absent an assignment by the inventor to his employer.

US patent law recognizes a “shop right,” which is an implied license for an employer to use an invention of an employee who developed the invention within the scope of their employment using the employer’s resources (equipment or funding). The implied license is not transferable except in the sale of a business.

Consultants/Contractors

It is customary for consultants and contractors to sign written agreements. Absent a written present assignment of developments, consultants and contractors will retain ownership of the intellectual property developed by them, even if contracted and paid for by another party.

Key Commercial Contract Considerations

Registration of Commercial Agreements

There is no general registration requirement, though some government contracts may require filing. Material contracts of publicly-traded companies may require disclosure.

Registration of licenses for patents, registered copyrights and trademarks is possible to put potential buyers of the patents, registered copyrights and trademarks on notice of the license. Such registration is not required.

Recognized Language of Commercial Agreements

English, and “plain English” that is consumer-friendly is preferred, particularly in consumer-facing commercial agreements and terms.
US-SPECIFIC ISSUES FOR ONLINE TERMS
Service providers (as defined in the Digital Millennium Copyright Act) can shield themselves from liability for copyright infringement due to transmitting, routing or providing connections to infringing content if copyright agent is designated and certain other statutory requirements are fulfilled.

ENFORCEABILITY OF ONLINE/CLICKWRAP/SHRINKWRAP TERMS
Generally viewed as enforceable if conspicuous, users have an opportunity to review and indicate affirmative assent, e.g., check a box.

GOVERNING LAW
Governing law and venue for resolution of disputes specified in a commercial contract will generally be accepted and recognized by state and Federal courts.

Dispute resolution is litigation in state and Federal Courts unless an alternative dispute resolution procedure, such as mediation or arbitration, is specified in the contract. Waivers of class action arbitrations require special attention to be enforceable against consumers.

KEY COMMERCIAL CONTRACT TERMS

ENFORCEABILITY OF WARRANTY DISCLAIMERS
Sellers, in their contracts for the sale of goods under Article 2 of the UCC, customarily disclaim or exclude implied warranties that are provided in the UCC for the benefit of buyers. The implied warranties that are disclaimed are usually the implied warranties of merchantability, fitness for a particular purpose and sometimes, non-infringement, warranties arising from usage of trade and course of performance.

Disclaimers of warranty are usually enforced unless they are unconscionable, unclear or not conspicuous. Enforceability of disclaimers against consumers may differ from jurisdiction to jurisdiction.

ENFORCEABILITY OF EXCLUSIONS/LIMITATIONS OF LIABILITY
Sellers, in their contracts for the sale of goods under Article 2 of the UCC, customarily exclude indirect damages (including consequential, incidental and special damages).

A cap on direct damages or aggregate liability is also common.

Exclusions and limitations on liability are usually enforced unless they are unconscionable, unclear or not conspicuous. Exclusions of liability for fraud, personal injury, death and in some states, bad faith, willful injury or unlawful conduct, are not enforceable. Some states allow exclusions of liability for gross negligence if “gross negligence” is specified in the contract.

Enforceability of exclusions and limitations of liability against consumers may differ from jurisdiction to jurisdiction.

Most jurisdictions preclude recovery of punitive (exemplary) damages for contract breaches without a separate and independent tort claim.

Contracts with Federal and state government agencies may have statutory limits on their liability.
INDEMNIFICATION

Express indemnities stated in contracts are recognized and generally respected.

Implied indemnities are based on theories of comparative indemnity or partial indemnity or comparative equitable indemnity, i.e., comparative fault of the parties. Courts will not usually imply an indemnity obligation in a contract where an express indemnity is already stated.

Express indemnities based on comparative fault are enforceable.

Indemnification provisions are generally enforceable unless they require indemnification of behavior that statutes or courts have held to be unenforceable (such as fraud, willful injury to a person or property and other future unlawful acts); indemnification for past unlawful acts is enforceable.

Indemnification provisions generally have three distinct obligations: defense, indemnify (pay damages) and hold harmless (indemnifying party responsible for any other liability arising out of the claim). Indemnification is not limited to third-party claims.

Caps on liability under indemnification provisions can be enforceable.
## COUNTRY CONTACTS

<table>
<thead>
<tr>
<th>Country</th>
<th>Contact Name</th>
<th>Contact Email</th>
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<tbody>
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