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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, equity compensation, 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 43 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?

With this edition, we’ve also included a section for each country that discusses the enforceability of electronic signatures.

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.
This publication is provided to you as a courtesy, and it does not establish a client relationship between DLA Piper and you, or any other person or entity that receives it.

This is a general reference document and should not be relied upon as legal advice. The application and effect of any law or regulation upon a particular situation can vary depending upon the specific facts and circumstances, and so you should consult with a lawyer regarding the impact of any of these regimes in any particular instance.

DLA Piper and any contributing law firms accept no liability for errors or omissions appearing in this publication and, in addition, DLA Piper accepts no liability at all for the content provided by the other contributing law firms. Please note that intellectual property and technology law is dynamic, and the legal regime in the countries surveyed could change.
ARGENTINA

INTELLECTUAL PROPERTY FRAMEWORK

Overview

Protection of intellectual property rights is required by the Federal Constitution and by several multilateral treaties. The main statutes in this area are federal statutes. However, in case of litigation, some matters are subject to federal jurisdiction, and others to provincial jurisdiction.

COMMERCIAL CONTRACT FRAMEWORK

Overview

Commercial contracts are governed by the Civil and Commercial Code. This code came into effect in 2015 and it replaces the previous separate Civil Code and Commercial Code. It is part of the federal legislation, but jurisdiction regarding its implementation and litigation resulting thereunder corresponds primarily to the provincial courts.

The Civil and Commercial Code includes general provisions on contracts, which are applicable to all contractual transactions. These provisions govern matters such as the formation of contracts, offer and acceptance, possible subject matter of contracts, legal formalities, the legal effects of contracts, contract termination and others.

In addition, the Civil and Commercial Code includes provisions applicable to specific types of contracts, such as sale agreements, leases, franchise agreements and agency agreements. More than 30 types of agreements are subject to specific provisions of this kind. These specially regulated agreements are thus subject to the general rules applicable to contracts –described above – and to the special rules applicable to the relevant type of agreement. Agreements that are not subject to special rules are nevertheless valid, and they are governed primarily by the general contract rules and – to the degree possible – by the rules applicable to analogous specially regulated contracts.

Other laws include provisions on specific types of commercial contracts. For instance, the Copyright Law includes certain provisions of contracts related to software and to publishing; the Patent Law includes rules on license agreements; and the Insurance Law includes rules on insurance contracts. However, in all these specially regulated contracts, the general contract law rules included in the Civil and Commercial Code are also applicable.
Commercial contracts with the federal or provincial governments or with other governmental entities are also governed by administrative law. Special rules on contracts with state entities have been included in federal or provincial laws, or have been developed by case law.

**COPYRIGHTS**

*Nature of right*

Copyright protects intellectual creations in all fields of science, art and literature. Article 1 of the Copyright Law includes a non-exhaustive list of possible intellectual works protected by copyright. These include, among others, literary and artistic works, music, architectural works and software.

Copyright protects intellectual expressions, but not ideas. For example, the contents of a book in terms of sentences and other literary expressions are protected by copyright, but the creative idea underlying the book as a whole is not.

Copyright results from the creation of an intellectual work. Registration is not necessary for copyright to exist, although it is necessary for the exercise of some rights by local authors. Upon creation of a protected work, copyright belongs to the original author or authors, who then may transfer their right, by contract or by the operation of certain legal rules.

Copyright includes economic and moral rights. Economic rights consist, basically, in the exclusive right to use and exploit the protected work. The Copyright Law lists some of the elements of this exclusive right, such as the right to reproduce the relevant work, to market copies, to prepare derivative works or to have the work performed publicly.

Moral rights include the so call "integrity right" – that is, the right to preserve the text, title and other contents of the work, even if property rights on such work have been assigned; the "paternity right," the author’s right to be named and identified as such together with the work; the "publication right," the right to decide whether the right will be published; and the "alteration right," the right to modify the work, even after it has been published. Moral rights belong to the author and they are generally non-assignable.

*Legal framework*

Copyright law is included in Law 11, 723, as amended. In addition, multiple laws and regulations govern matters such as related rights, publishers’ rights and collective management societies.

Argentina is part of the main multilateral international copyright agreements, such as the Trips Agreement, the Berne Convention and the Rome Convention. The provisions of these agreements are actively enforced by the courts.

*Duration of right*

The general rule is that copyright protection lasts for a term of seventy years, counted as of January 1 of the first year after the death of the author, as well as through the life of the author.

In the case of work done through cooperation, the 70-year term is computed from the death of the last person
who participated in the joint authorship of the work involved.

In the case of posthumous works, the 70-year term is computed from the death of the author.

The duration of protection of anonymous works whose copyright belongs to institutions, corporations or legal entities is 50 years from the date of publication of the work.

Special rules on copyright duration apply to specific types of copyrightable works, such as photographs and cinematographic works.

Ownership / licenses

The basic rule is that ownership belongs to the author. Special rules have been developed in connection with special types of works, such as cinematographic works, derivative works and software.

There are several types of joint ownership. It may apply to works done through cooperation, which imply a creative collaboration between different authors; to collective works, which are those created through the initiative or direction of one or more individuals, who coordinate or direct the efforts of several other individuals to achieve a joint result; and to composite works, which are the result of adding different separate works, each with a possible separate author and owner, into one final result.

Works created by employees who have been hired for that purpose belong to the employer.

Copyright may be subject to licenses, generally as part of broader contractual arrangements such as publishing agreements.

Remedies for infringement

Damages may be claimed before civil courts for all types of copyright violation. Registration of works is not necessary, except for local authors, whose rights may be suspended until registration takes place.

It is also possible to file civil action to prevent further copyright violation, and to obtain preliminary remedies, such as injunction, in the course of civil procedures.

Criminal remedies, particularly fines, are possible, but are not frequently applied.

MASK WORKS / TOPOGRAPHIES

Nature of right

Mask works and topographies are not separately protected under Argentine law. They may be protected under patent law or by way of confidentiality.

Legal framework

Argentina has enacted no specific rules on chip protection. Although Argentina is part of the WTO and has approved the Trips Agreement, it has not yet implemented any rules on chip protection.
The provisions on chip protection included in the Trips Agreement have not been deemed immediately applicable under Argentine law. In addition, Argentina has not ratified or implemented other multilateral treaties on chip protection, in particular the Treaty of Washington of 1989.

Semiconductor technology, generally, and topographies, in particular, may be protected under the traditional intellectual property rules applicable to all types of technology, specially patent law and the rules on confidential information. Therefore, matters such as the duration of the relevant rights, ownership and remedies depend on the type of protection used in connection with each specific mask work or topography.

**Duration of right**

Not applicable for this jurisdiction.

**Ownership / licenses**

Not applicable for this jurisdiction.

**Remedies for infringement**

Not applicable for this jurisdiction.

**PATENTS**

**Nature of right**

Patents are a statutory right. The granting of patents is required by the Argentine Constitution and by different international documents, particularly the Trips Agreement. Patent rights imply an exclusive right to exploit a process or a product. The Argentine Patent Law defines the limits of these exclusive rights, on the basis of the provisions of the Trips Agreement.

**Legal framework**

Patents are governed by the Patent Law – Law 24,481, as amended. In addition, they are governed by the Trips Agreement and by the Paris Convention. Argentina is not a party to the Patent Cooperation Treaty.

**Duration of right**

The basic rule is that patents expire 20 years after the date in which the relevant patent application was filed. Argentina uses a “first to file” system, but it also applies the priority rules derived from the Paris Convention.

Argentine law provides special rules on compulsory licenses and on patent termination due to lack of exploitation of the patented invention. Compulsory licenses may be granted in case of non-exploitation, competition law violations or sanitary emergencies, among other cases. Patent termination may result when, after a compulsory license was granted for lack of exploitation, no exploitation of the invention takes place for two years after the license was granted.

**Ownership / licenses**

Not applicable for this jurisdiction.
Joint ownership is permissible. The Patent Law includes provisions on the exercise of patent rights by the joint owners. In addition the Civil and Commercial Code rules on joint property apply to patents.

The Patent law includes rules on licenses. Licenses are not exclusive, unless the parties provide otherwise. Competition law rules are applicable to restrictive clauses included in license agreements.

**Remedies for infringement**

The Patent law provides both civil and criminal law remedies for cases of infringement.

Civil remedies include the compensation of damages and termination of the infringing activities.

A complex system of rules for preliminary remedies in patent cases is included in the Patent law. Generally, suspension of an alleged infringer’s exploitation requires a preliminary procedure, with the participation of expert witnesses.

Criminal procedures and sanctions are rare.

**TRADEMARKS**

**Nature of right**

A trademark may consist of one or more words, with or without conceptual content, drawings, commercial symbols, monograms, engravings, prints, seals, images, stripes, color combinations, letter and number combinations, the special graphics of letters and numbers, advertisement phrases, reliefs, and any other sign with distinctive capacity.

A trademark is normally protected by means of its registration. However, de facto trademarks, that is those that are used but not registered, are also protected in a more limited way.

**Legal framework**

Trademarks are governed by the Trademark Law – Law 22,362, as amended.

In addition, trademarks are protected by the rules included in Trips Agreement and in the Paris Convention.

**Duration of right**

Registered trademarks are protected for a period of ten years, from the moment of registration. Trademark registration may be renewed indefinitely.

Registration may be cancelled for lack of use during a period of five years. In addition, renewal of registration requires proof of the trademark's prior use.

**Ownership / licenses**

Ownership is acquired by means of registration. However, use of unregistered trademarks may result in certain
Trademarks may be subject to joint ownership. The Trademark Law and the Civil and Commercial Code provide the rules applicable to these joint ownership relationships.

Trademark licenses are possible. They are valid even if they are not registered with the trademark office.

**Remedies for infringement**

The Trademark Law provides both civil and criminal law remedies for cases of infringement.

Civil remedies include the compensation of damages and the termination of the infringing activities.

Special preliminary remedies are applicable in cases of trademark infringement. The trademark owner may obtain an injunction against the infringer, when the trademark is registered and its violation is immediately evident.

Criminal law remedies are rarely used in practice.

**TRADE SECRETS**

**Nature of right**

Argentine law provides protection for trade secrets and confidential information. A complex set of rules creates rights against conduct whereby access is gained illegally to confidential information, or which implies illegal use of trade secrets or confidential information or which results in the unauthorized and harmful disclosure of confidential or secret information.

Confidential information is characterized by the fact that it is kept in a reserved manner and that it is not generally available for technicians working in the relevant technical field. Trade secrets receive a special degree of protection, particularly under criminal law.

**Legal framework**

Confidential information is governed and protected by Law 24,766. It is also protected by the Trips Agreement and by the Paris Convention.

In addition, multiple rules and statutes protect confidential information and trade secrets. Labor law protects the confidentiality and ownership of information used in employment relationships.

Several criminal law rules apply to special types of violations of confidentiality. In particular, disclosure of trade secrets and unfair competition by means of the illegal use or appropriation of trade secrets are subject to criminal law penalties.

**Duration of right**

Confidential information and trade secrets is protected for as long as the relevant information is kept confidential. The degree of protection diminishes if the information ceases to be objectively a secret, due to its previous disclosure or because it has been obtained independently by other parties.
Ownership / licenses

Ownership results from the obtention of the information, accompanied by legal or practical measures aimed at restricting access to that information by third parties. No registration requirement is applicable.

Joint ownership is possible.

Trade secret or know-how licenses are common and enforceable.

Remedies for infringement

Argentine law provides civil and criminal law remedies for cases of trade secret infringement.

Damages caused by these violations must be compensated. It is also possible to obtain court orders requiring termination of the violation.

Preliminary remedies include injunctions against further exploitation or disclosure of trade secrets.

Criminal remedies are applicable in cases of disclosure of trade secrets acquired in the course of employment and other professional relationship, as well as in cases in which the violation of the rights to confidential information or trade secrets results in unfair competition.

OTHER KEY IP RIGHTS

Nature of right

Industrial designs

Industrial models and designs are protected by special industrial property rights. An industrial model or design consists in the forms embodied in or the aspect applied to an industrial or artisan product, which confer an ornamental character to such product.

Exclusive rights on industrial models and designs result from registration of the relevant model or design.

Legal framework

Industrial designs

Industrial models and designs are protected by Decree 6673/1963, as amended. They are also protected in accordance with the Trips Agreement and the Paris Convention.

Duration of right

Industrial designs

The rights derived from the registration of an industrial model or design last for a five-year period, counted from the date of filing of the relevant application. The registration may be renewed for two successive five-year period,
Ownership / licenses

Industrial designs

Ownership belongs to the author. There is a rebuttable presumption to the effect that the first applicant of an industrial model or design registration is the author of such industrial model or design. Joint ownership is possible, and is governed by the Civil and Commercial Code and by Decree 6673/1963 as amended.

Industrial models or designs may be the subject matter of license agreements. No registration is necessary for the validity of these agreements.

Remedies for infringement

Industrial designs

Civil and criminal law remedies are applicable in case of infringement. Civil remedies include the compensation of damages and termination of the violation.

Preliminary injunctions and remedies are possible in accordance with general procedural rules.

Criminal sanctions have been recently reinforced, but they are rarely applied.

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

Employees

Special rules on employee inventions are included in the Patent Law and in the Labor Contract Law.

There are basically three types of invention, from the perspective of employer-employee relationships. First, inventions made in technological areas for which the employee was hired as a researcher or developer belong to the employer. The employee may be entitled to a special compensation if he or she develops a patented invention which exceeds the normal scope of the employee’s work. Second, inventions related to the employee’s work or related to the employer’s know-how or activities belong to the employee, but allow the employer to exercise an option to acquire rights over the invention. If the option is exercised, the employee is entitled to a payment reflecting the value of the invention. Third, inventions that do not fall into the two previous categories belong to the employee.

Similar rules are applicable in the case of other types of technology or intellectual property rights. In the case of software, the law applies the “work for hire” doctrine, but allows the parties to agree to different contractual rules.

Consultants / contractors

The law is not explicit about the rights of consultants and contractors, who do not qualify as employees, with regard to technology and other intellectual property they develop. Generally, the parties may agree as to the rules which will apply to such rights. In the absence of a contractual framework, the technology or intellectual property...
generated by a consultant or contractor who was hired with the purpose of developing such items that will belong to the person paying for such work.

KEY COMMERCIAL CONTRACT CONSIDERATIONS

Registration of commercial agreements

The general rule is that commercial agreements are not registered, and that their validity and effect is not subject to registration requirements. However, certain types of agreement must be registered to be effective or to have full effects against third parties. Agreements subject to registration include business association agreements, certain publishing agreements, certain chattel mortgages and certain agreements related to real estate. International transfer of technology agreements are subject to registration for tax purposes.

Recognized language of commercial agreements

Agreements are generally entered in Spanish. However, it is legally possible to enter agreements written in other languages. These agreements must be translated when presented in court. Spanish language may be necessary in consumer transactions.

Country-specific issues for online content

Argentina has ratified the WIPO conventions applicable online content and practices. However, enforcement of these conventions is weak.

Enforceability of online/clickwrap/shrinkwrap terms

The general rule is that acceptance of terms included in online, click wrap or shrink wrap elements is valid and effective, provided such acceptance is clearly stated and applies to terms that were known to the person giving the acceptance. However, several rules may limit the effects of agreements entered by these mechanisms, particularly consumer protection rules and rules on adhesion contracts.

Governing law

The basic rule is that the parties may agree as to the law that will govern their contractual rights and as to the applicable jurisdiction in case of dispute. This freedom of election is subject to several limitations. Non-Argentine law will not be enforced in Argentine courts if it is contrary to Argentine public policy. Also, certain matters are necessarily governed by Argentine law. For example, if a business association is created in Argentina, its organization and other corporate aspects will be governed by Argentine law. Decisions made by non-Argentine courts or arbitration tribunals are enforceable in Argentina only after going through a special procedure before the Argentine courts, in the context of which the decision will only be enforced if it complies with certain rules, particularly not violating Argentine public policy. In addition, certain matters – ie, deciding the validity of a patent issued in Argentina – are necessarily subject to Argentine jurisdiction.

KEY COMMERCIAL CONTRACT TERMS

Enforceability of warranty disclaimers
Argentine law provides certain warranties, generally applicable to all types of contracts implying the transfer of rights. These warranties apply, in particular, to the validity of the rights being transferred and to the fitness of the goods regarding which rights are transferred.

The general rule is that these warranties may be limited or eliminated by agreement between the parties. However, these disclaimers are totally or partially invalid in several types of cases: if the transferor had prior knowledge of the invalidity of the transferred rights or of the deficiency of the goods involved; if the transferor is a merchant and the parties waiving his or her rights are not; and if the warranty disclaimer is included in a consumer or adhesion contract.

**Enforceability of exclusions/limitations of liability indemnification**

Exclusions or limitations of liability indemnification are valid if they meet the general conditions applicable to contractual. However, they may be unenforceable in the following cases: when they extend to willful violations or defaults, or to violations or defaults resulting from gross negligence; when they are imposed in adhesion or consumer contracts; or when they result in the violation or annulment of rights that may not be removed or limited contractually.

**Indemnification**

The basic rule under Argentine law if full indemnification of economic or moral damages caused by illegal conduct, whether that conduct constitutes a contractual or a tort violation.

The parties are free to include contractual rules as to the extent of their indemnification obligations.

Penalty clauses and liquidated damages clauses are acceptable, but they may be limited or amended by the courts if their terms are deemed abusive.

In the absence of contractual provisions, the indemnification’s extent will depend on circumstances such as the willful or negligent nature of the violation, foreseeability of the damages caused and the comparative fault of the parties.

**Electronic signatures**

Electronic signatures are valid and effective under Argentine law. However, certain legal effects require that the signature comply with a special certification regime.
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AUSTRALIA

Last modified 01 January 2019

INTELLECTUAL PROPERTY FRAMEWORK

Overview

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

COMMERCIAL CONTRACT FRAMEWORK

Overview

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. There are also state and territory consumer laws.

The ACL also includes an unfair contract terms regime that applies to:

a. Standard form contracts for a supply of goods or services or a sale or grant of an interest in land to an individual whose acquisition of the goods, services or interest is wholly or predominantly for personal, domestic or household use or consumption

b. Standard form contracts where at least one of the parties is a small business (a business which employs less than 20 people) and the price payable upfront is AU$300,000 or less or AU$1 million or less for contracts with a term longer than 12 months

Commercial contracts with Commonwealth and state government agencies may be subject to additional
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 and the Trans-Pacific Partnership Agreement.

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 after the expiration of the calendar year in which the broadcast was made and for printed editions, 25 years after the expiration of the calendar year in which the edition was first published. For sound recordings and cinematograph film, copyright lasts 70 years after the end of the calendar year in which the recording or film is first published.

Ownership / licenses

Co-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 co-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 (alternatively to damages) 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. However, in these circumstances, copyright holders may be entitled to an account of profits for revenue from the infringing works.

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 / TOPOGRAPHIES**

**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

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
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 generally the first owner of its EL Rights (please refer to exceptions enumerated in the "Intellectual Property in Employment Context" section). 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 is a statutory right that must be applied for, and may be granted following examination. An owner of a granted 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

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

An owner of a granted 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 (Cth).

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, the TRIPS Agreement and the Trans-Pacific Partnership Agreement.

**Duration of right**

The duration of patent protection is 20 years from the effective date of filing for a standard patent, except for pharmaceutical standard patents which may have a maximum of up to 25 years to allow for the regulatory approvals processes. The duration of protection for an innovation patent is eight years from the effective date of filing. 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, including 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 co-owned. 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.

Legal framework

Australian trademark law is based on the Trade Marks Act 1995 (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. There is an initial ten year registration period and the registration can be renewed indefinitely every ten years without the need to provide evidence of use. However, a trademark registration that is more than five years old can be removed from the register if it has not been used for a period of three years or more. Notably, trademarks entered on the register after February 24, 2019, will only have a 3 year grace period before they are susceptible to removal.

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.

Licenses need not be recorded to be effective, and there is no specific provision allowing recordal on the Trade Marks Office Register.

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 plaintiffs 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 or 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 can be identified with specificity

ii. The information was confidential

iii. There was an obligation of confidence on the defendant

iv. The defendant used the information without the plaintiff's consent and to their detriment

**Legal framework**

Confidentiality of trade secrets is usually stipulated in the contracts between parties and is therefore enforceable under such contract. However, in instances where there is no contract, a plaintiff may be able to rely upon the common law doctrine of breach of confidence.

**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.

OTHER KEY IP RIGHTS

Nature of right

Not applicable.

Legal framework

Not applicable.

Duration of right

Not applicable.

Ownership / licenses

Not applicable.

Remedies for infringement

Not applicable.

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 (ie, 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.

Copyright holders may issue "take down notices" to internet service providers (ISPs) if, on reasonable grounds,
they believe that there is infringing material located on a webpage or network that is under the control of the ISP. Upon recipient of this notice, the ISP is required to immediately remove or block the content and issue an infringement notice to the individual or entity that posted the material.

**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, ideally, actively and explicitly accept) the terms of the contract prior to purchase or use of online services.

**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 (eg, 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.

If a "warranty against defects" is provided in relation to goods or services, it must be provided in addition to the consumer guarantees. A "warranty against defects" is a representation made to a consumer that if goods or services (or part of them) are defective, a business will repair or replace goods (or part of them), resupply or fix a problem with services (or part of them) or provide compensation to the consumer.

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 indemnification**

Clauses that seek to exclude certain warranties or consumer guarantees or exclude or excessively limit liability will be construed strictly against the person that seeks to rely on the clause.
Clauses in standard form consumer contracts or standard form small business contracts that seek to limit or exclude liability are at risk of being considered unfair, and therefore void, under the unfair contract terms regime in the ACL.

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.

**Electronic signatures**

Electronic signatures are acceptable and enforceable in Australia in most instances in which the law requires a signature. Electronic signatures are valid if they are a method that identifies the person who is signing and indicates the person’s intention with respect to the information communicated (eg, that the person agrees to the terms of a contract). The method of providing the electronic signature must generally be as reliable as appropriate for the purpose for which the electronic communication was given. Some laws exclude the use of electronic signatures in particular instances. Where documents as executed as deeds, certain additional requirements may apply (eg, that execution needs to be witnessed and the deed must be printed on paper, parchment or vellum) mean there is a degree of uncertainty about whether deeds can in all instances be validly executed using electronic signatures.
INTELLECTUAL PROPERTY FRAMEWORK

Overview

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

- Copyright – the Copyright Act (Urheberrechtsgesetz)
- Patent – the Patent Act (Patentgesetz)
- Utility Models – the Utility Model Act (Gebrauchsmustergesetz)
- Trademarks – the Trademark Act (Markenschutzgesetz)
- Semiconductors – the Semiconductor Protection Act (Halbleiterschutzgesetz)
- Designs and utility patents – the Designs Act (Musterschutzgesetz)
- Trade secrets – the Unfair Competition Act (Gesetz gegen den unlauteren Wettbewerb)

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 (Firmenbuchgesetzbuch), which provide protection for names and company names.

COMMERCIAL CONTRACT FRAMEWORK

Overview

Austrian law contains extensive federal legislation (of both dispositive and mandatory nature) on commercial
contracts, considering both the general principles (such as interpretation) and the specific contract types. In business-to-consumer relationships, the Consumer Protection Act (Konsumentenschutzgesetz) and the Distance and Off-Premises Act (Fern- und Auswärtsgeschäfte-Gesetz) are 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 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.

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 of 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 copyrighted 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, ie, 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 the 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, the 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

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 or her successor; a legal entity may only be a licensee. The right as such is not transferable (except in case of universal succession, ie, inheritance), the author may license only one, more, or all exploitation rights (eg, right to reproduce, right to distribute, right to make the work available, right to emit); personality rights (eg, 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 accounts

iv. Publication of judgment

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

Criminal remedies may include:
• Monetary fine

• Imprisonment

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

MASK WORKS / TOPOGRAPHIES

Nature of right

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

A "semiconductor product" is the final or an intermediate form of any product:

• Consisting of a body of material which includes a layer of semiconducting material

• 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

• 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 10 years from registration (ends at end of tenth calendar year). There must be a registration within 2 years of the first non-confidential commercial exploitation.

Ownership / licenses

Rights in semiconductor products and their topographies are freely transferable. 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

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

Criminal remedies include:

i. Monetary fine

ii. Imprisonment

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 a 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.

Legal framework


Duration of right

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

Ownership / licenses

The inventor or his or her successor in title has a right to the granted patent.

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 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

v. Monetary relief

Criminal remedies may include:

i. Monetary fine

ii. Imprisonment

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, color marks and sound marks are also protectable, if sufficiently graphically displayable/displayed. Haptic or olfactory marks and national emblems are not protectable as trademarks in Austria.

**Legal framework**

The Austrian Trademark Act (*Markenschutzgesetz*) protects registered trademarks. Non-registered trademarks, in Austria termed "signs," may have protection according to Article 9 of the Austrian Act on Unfair Competition.


**Duration of right**

Trademark registrations are in effect for 10 years and are renewable repeatedly for 10-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:

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

v. Monetary relief

Criminal remedies for infringement of trademarks include:

i. Monetary fine

ii. Imprisonment

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, 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 of the Criminal Code penalize the discovery, publication or exploitation of trade secrets in various ways.

The Act on Unfair Competition will provide protection of trade secrets in Section 26a – 26j. It will also contain certain measures concerning the disclosure of trade secrets during trials to ensure protection. These regulations have already been decided by the National Assembly but have to be approved by the Federal Assembly, which will happen in 2019. The regulations implement EU-Directive 2016/943 on the protection of undisclosed know-how and business information (trade secrets) against their unlawful acquisition, use and disclosure into Austrian law.
The Directive is a commitment to creating a single market for intellectual property and establishes additional measures, procedures and remedies that should be made available to the holder of a trade secret in case of unlawful acquisition, use or disclosure of that trade secret by a third party.

**Duration of right**

Not yet regulated.

**Ownership / licenses**

The owner of a trade secret can be a natural person or a legal entity.

**Remedies for infringement**

Civil remedies include:

i. Cessation of infringement (preliminary or permanent injunction)

ii. Monetary relief

Criminal remedies include:

i. Monetary fine

ii. Imprisonment

Additional remedies are available under the Act on Unfair Competition.

**OTHER KEY IP RIGHTS**

**Nature of right**

Not applicable for this jurisdiction.

**Legal framework**

Not applicable for this jurisdiction.

**Duration of right**

Not applicable for this jurisdiction.

**Ownership / licenses**

Not applicable for this jurisdiction.

**Remedies for infringement**


Not applicable for this jurisdiction.

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

Employees

The Austrian Copyright Act does not recognize "works made for hire," ie, the original author is always the original owner of the copyright. Licensing of the exploitation rights is possible and in certain cases 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.

The Austrian Patent Act provides similar principles 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 transferable and can therefore also be made for hire for a legal entity.

Consultants / contractors

Subject to the mentioned 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 are not any general registration requirements for commercial contracts, except for any transfer of patents and registered rights where the registry has to be provided with the transfer agreement in order to register the transfer.

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 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 (E-Commerce-Gesetz) 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, the Consumer Protection Act) are recognized and fully enforceable. In accordance with consumer protection laws, consumers are usually entitled to revocation of the contract. A notification regarding the revocation right and the respective template for revocation should be set forth in separate documents (not in the terms and conditions).

The enforceability of shrinkwrap terms is severely disputed under Austrian and EU law. This is due to the provisions of 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 (eg, 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 indemnification**

Exclusion or limitation of liability is permissible in principle for damages caused by slight negligence; they are not permissible for willful misconduct. Limitations or exclusion of liability for gross negligence are not permissible in business-to-consumer contracts and exclusion for slight negligence is only possible to a certain extent and are explicitly excluded in certain cases.

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, ie, 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 is recommended.

**Indemnification**

Express indemnities stated in contracts are, in general, permissible. Note, however, that Austrian law does not possess a concept of indemnification comparable to that in 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 legal concepts to such limitations.

**Electronic signatures**

In Austria, the implementation of Regulation 910/2014 on electronic identification and trust services for electronic transactions in the internal market, which also repealed Directive 1999/93 concerning electronic signatures has been effectuated by the Signatures and Trust Services Act (*Signatur- und Vertrauensdienstegesetz*).

Generally, a qualified electronic signature equals a handwritten signature and has the same legal effects as any written signature, unless the parties agree otherwise. According to the "non-discrimination-rule" in the Signatures and Trust Services Act, any documents signed with an electronic signature in general have to be equally accepted as evidence in the court.

There are some exceptions when electronic signatures are not acceptable – for example, surety agreements, last will and some other declarations in the area of family and inheritance law.
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INTELLECTUAL PROPERTY FRAMEWORK

Overview

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

i. Patent – Title 1 (Patents) of Book XI (Intellectual Property and Trade Secrets) of the Code of Economic Law

ii. Copyright – Title 5 (Copyrights and Neighboring Rights) of Book XI (Intellectual Property and Trade Secrets) of the Code of Economic Law

iii. Software – Title 6 (Computer Programs) of Book XI (Intellectual Property and Trade Secrets) of the Code of Economic Law

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

v. Semiconductors – Title 8 (Topographies of Semiconductor Products) of Book XI (Intellectual Property and Trade Secrets) 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 trade names, company names and domain names.

COMMERCIAL CONTRACT FRAMEWORK

Overview
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.


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 or her 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 and Trade Secrets) 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 the author’s 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. In this latter case, 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 employment agreement. However, there are some statutory presumptions, such as those regarding the assignment of economic rights in computer programs, that automatically favor employers (unless provided otherwise).

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 or her name or the appearance of another sign that enables his or her 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 and as a whole, 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 and the Code of Economic Law.

**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 and Trade Secrets) 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, after authorization by the judge and 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

- 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
  
- 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
  
- The dissemination of the decision, including the displaying and publishing of the decision in full or in part

**MASK WORKS / TOPOGRAPHIES**

**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, fulfils 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:

- Reproduction solely for the purposes of analysis, evaluation or teaching of the topography or the concepts, processes, systems or techniques embodied in the topography

- A topography resulting from the analysis and evaluation of another topography carried out in accordance with item 1 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:

- Consisting of a body of material which includes a layer of semiconducting material

- 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

- 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:

- Representing the three-dimensional pattern of the layers of which a semiconductor product is composed

- 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 and Trade Secrets) 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 or encoded for the first time and shall expire 10 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 15 years from the date on which it was first fixed or encoded.

**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 or her 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 is 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, *ie*, 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:

- 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
- 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
- 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:

- New
- Inventive
- 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:

- An obvious abuse in relation to the applicant
- 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 or her 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 I (Patents) of Book XI (Intellectual Property and Trade Secrets) of the Code of Economic Law.

There are several expected updates on EU level, including:

- Regulation (EU) No 1257/2012 of the European Parliament and of the Council of December 17, 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection
- Council Regulation (EU) No 1260/2012 of December 17, 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection with regard to the applicable translation arrangements
- Agreement on the Unified Patent Court 16351/12 of January 11, 2013

**Institute for Patent Attorneys on the way** – the new law of July 8, 2018 regulates the profession of Patent Attorneys in Belgium. An Institute for Patent Attorneys will be established and everyone who is registered in the register of authorized representatives becomes a member of the institute and will have the right to speak in patent litigation before the Belgian courts. A Royal decree still needs to be issued prior to the law coming into effect.

**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 the inventor’s 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 or her 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 (especially 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:

- 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

- 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

- 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

- 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 10 years starting from the date of filing of the application and renewable for an unlimited number of consecutive 10-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 of 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

A definition has been inserted into Belgian law as a transposition of Directive 2016/943 of the European Parliament and of the Council on the protection of undisclosed know-how and business information (trade secrets) against
their unlawful acquisition, use and disclosure gets implemented, by the Act of July 30, 2018. A new Title 8/1 has been inserted in Book XI of the Code of Economic Law in order to implement the main provisions of Directive 2016/943.

The general definition of a trade secret has been transposed from the Directive into article I.17/1 of the Code of Economic Law:

"Trade secret: information which meets all of the following requirements: (a) it 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; (b) it has commercial value because it is secret; (c) it has been subject to reasonable steps under the circumstances, by the person lawfully in control of the information, to keep it secret."

Under Belgian law, a distinction must also 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 a high bar to clear.

- Section 17 of the Act of July 3, 1978 on Employment Agreements states that employees are obliged, both during and subsequent to the term of the employment contract, to refrain from the unlawful acquisition, use or disclosure (within the meaning of Article XI.332/4 Code of Economic Law) of a trade secret (within the meaning of Article I.17/1(1) Code Economic Law) or secrets related to personal or confidential matters, of which they learn in the performance of their professional activities

The following legislation governs actions against other third parties:

i. Title 8/1 of Book XI of the Code of Economic Law

ii. 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

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

**Duration of right**

Not applicable.

**Ownership / licenses**

As for most European jurisdictions, competition rules prevail over contractual arrangements. Licenses in respect of trade secrets are subject to Commission Regulation (EC) 316/2014 of March 21, 2014 on the application of Article 101(3) of the Treaty on the Functioning of the European Union 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.

The implementation of Directive 2016/943 in Title 8/1 of Book XI of the Code of Economic Law ensures that the competent judicial authorities may, at the request of the trade secret holder, order a number of provisional and precautionary measures against the alleged infringer, such as the cessation of or the prohibition of the use or disclosure of the trade secret on a provisional basis; and/or the prohibition of the production, offering, placing on the market or use of infringing goods, or the importation, export or storage of infringing goods for those purposes; and/or the seizure or delivery up of the suspected infringing goods, including imported goods, so as to prevent their entry into, or circulation on, the market; or, as an alternative to the aforementioned measures, make the continuation of the alleged unlawful use of a trade secret subject to the lodging of guarantees intended to ensure the compensation of the trade secret holder. In addition, in a court proceedings on the merits of the case, a series of injunctive and corrective measures can be sought, as well as damages and dissemination of the information concerning the decision.

**OTHER KEY IP RIGHTS**

**Nature of right**

Not applicable for this jurisdiction.

**Legal framework**

Not applicable for this jurisdiction.

**Duration of right**

Not applicable for this jurisdiction.
Ownership / licenses

Not applicable for this jurisdiction.

Remedies for infringement

Not applicable for this jurisdiction.

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. However, there are some presumptions, such as those regarding the assignment of economic rights in computer programs, that automatically favor employers.

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

Patent

Title 1 (Patents) of the Code of Economic Law provides that the right to a patent shall belong to the inventor or the inventor’s 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 makes 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, ie, the invention that is made during an agreement and by an employee that is hired or instructed by his or her 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 or her 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
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(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.

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 activities of the commissioning party 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 the inventor’s successors in title or in violation of a legal or contractual obligation, the injured party may, in his or her 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

In order to enforce online general terms and conditions (including online or clickwrap terms), (i) the contractual provisions must be made available to the other party in such a way that he or she can store and display them; (ii) the other party must have been aware and have consented to the content of the terms; and (iii) a written mention of the other party accepting the terms can be given by any means which guarantees that the mention came from that party.

Governing law

Subject to the case law of the European Union on the conclusion of cross border online agreements, the Rome I and Recast 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 (corresponding to Articles 1649bis and following of the Civil Code) 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 indemnification

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, willful misconduct, death or personal injury.

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).

Electronic signatures

Until mid-2016, the use of electronic signatures in the European Union was governed by Directive 1999/93 on a Community framework for electronic signatures (E-Signature Directive) as transposed into the national laws of 28 member states of the European Union. In Belgium, the E-Signature Directive was implemented by the Act of July 9, 2001 laying down a legal framework for electronic signatures and certification services.

The Regulation (EU) No 910/2014 on electronic identification and trust services for electronic transactions in the internal market and repealing Directive 1999/93/EC (Regulation) was adopted in July 2014, and has been effective as of July 1, 2016. This Regulation aims to provide more predictable regulatory environment and is directly applicable in all member states of the European Union without having to be transposed in national legislation.
The Regulation has a two-tier approach. This means that all electronic signatures, *ie, “data in electronic form which is attached to or logically associated with other data in electronic form and which is used by the signatory to sign,”* receive some legal recognition, but only so-called "qualified" electronic signatures are automatically assimilated with handwritten signatures. Thus, in case of a dispute, it will be up to the competent court to decide whether a "non-qualified" electronic signature can be assimilated with a handwritten signature. The Regulation does not preclude member states from deciding that, in certain circumstances, only specific types of electronic signatures, such as qualified electronic signatures, can be used.

Under Belgian law, certain types of contracts (such as real estate contracts, certain contracts of suretyship, contracts in the field of family law) cannot be concluded by electronic means.

The new law of February 15, 2018 introduced additional changes to the use of electronic signatures in the field of employment law so as to provide a more flexible regime for concluding employment contracts, in line with the flexibility offered by the Regulation.
INTELLECTUAL PROPERTY FRAMEWORK

Overview

Intellectual property rights are governed by the Federal Constitution and Federal laws.

COMMERCIAL CONTRACT FRAMEWORK

Overview

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 (eg, purchase and sale, donation, services agreement). Some particular contracts are also governed by special laws and regulations (eg, 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 (eg, contracts in Energy and Oil and Gas areas, contracts that involve concessions, public-private partnerships, electronic options and Special System for Public Purchases – RDC).

COPYRIGHTS

Nature of right

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 has 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 and differently foreseen, the term of assignment/license will be of 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 / TOPOGRAPHIES

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 10 years counted 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. Where there is a partial assignment of rights, 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:

1. Inventions that present novelty, inventive activity and industrial use and
2. 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.

**Legal 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.
In case there are royalty payments made from a Brazilian entity to another entity abroad, license agreements should always be recorded before the Instituto Nacional da Propriedade Industrial (INPI). In addition, local taxes deductibility is limited by 5 percent from the revenue from the licensed technology, in accordance with Resolution No. 436/58 from Ministério da Fazenda (Resolution No. 436/58).

**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. Furthermore, interested parties may file a court action requesting a cancelation of the patent before the Federal Court.

**TRADEMARKS**

**Nature of right**

Distinctive signals visually perceptible, not otherwise included within the legal prohibitions, are registerable 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 10 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 of 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.

License agreements should always be recorded before the INPI, in case there are royalty payments made from a Brazilian entity to another entity abroad. In addition, local tax deductibility will be limited by 1 percent as set forth by Resolution No. 436/58.

**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. Interested parties may also file a court action requesting a cancelation of the trademark registration before the Federal Court.

**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 conducts 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).

*Duration of right*

Not applicable for this jurisdiction.

*Ownership / licenses*

Not applicable for this jurisdiction.

*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).

**OTHER KEY IP RIGHTS**

*Nature of right*

Not applicable for this jurisdiction.

*Legal framework*

Not applicable for this jurisdiction.

*Duration of right*

Not applicable for this jurisdiction.
Ownership / licenses

Not applicable for this jurisdiction.

Remedies for infringement

Not applicable for this jurisdiction.

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

Employees

Copyrights

Except for software as mentioned below, the Copyright Law is silent regarding the ownership of works created by employees, which will be decided by the courts on a case by case basis. The concept of "work for hire" is not recognized by the Law.

Software

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

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 or her salary.

Trademarks

There is no legal provision concerning the ownership of trademarks in employment context. The rule is "first to file," if the filing does not infringe any legal provision.

Consultants / contractors

Copyrights
Except for software as mentioned below, the Copyright Law is silent regarding the ownership of works created by consultants/contractors, which will be decided by the courts on a case by case basis. The concept of "work for hire" is not recognized by the Brazilian Law.

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. The rule is "first to file," if the filing does not infringe any legal provision.

Trade secrets

Not applicable for this jurisdiction.

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 and, if applicable, in case of remittance of royalties from Brazil to abroad.

Recognized language of commercial agreements

In general, there is no issue in having contracts executed in another language (eg, 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). Also, Federal Law No. 10,962/2004, modified by Federal Law No. 13,542/2017, establishes rules for price disclosure in e-Commerce (e.g., font size and position of the price).

In 2015, Brazil enacted Federal Law No. 12,965 on Civil Rights Framework for the Internet (*Marco Civil da Internet* and its Decree No. 8,771/16, dated May 11, 2016. This federal law stipulates the following:

- Brazilian law and jurisdiction will be applicable if one of the parties engaged in the relation/service is located in Brazil
- Internet services providers shall be liable for third parties content, if such third party does not comply with a court’s orders (for instance, for removal of content)
- Service/webpage may be shut down, by court order, if it does not comply with the law
- Collection of data must be strictly related to the purposes of the collection and may not be shared or transferred to third parties without prior consent of the individual on this regard or by another applicable legal basis, in accordance with the Brazilian General Personal Data Protection law (Federal Law 13,709/2018)

**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., separately “check a box”) to confirm his or her acceptance to the content and provisions of the agreement. 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. Even if a contract specifies foreign law as the governing law, if the agreement is performed in Brazil, Brazilian law may be applicable and local courts would always have jurisdiction in relation to such contract.

An exception to the above rule are 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.

**KEY COMMERCIAL CONTRACT TERMS**

**Enforceability of warranty disclaimers**

Depending on the services or goods provided, and who the buyer is, the supplier may be subject to mandatory rules regarding warranties.

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 or considered abusive.

**Enforceability of exclusions/limitations of liability indemnification**

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 (eg, caps) and exclude certain liabilities, especially indirect damages (including loss of profit).

**Indemnification**

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).
Electronic signatures

Electronic signatures are generally considered enforceable under Brazilian law. In 2001 Provisional Executive Act 2.200-2 (Electronic Signature Law) established a validity of the digitally signed documents. The Brazilian Public Key Infrastructure (ICP-Brazil) was created in accordance with the Electronic Signature Law. The Electronic Signature Law established the legal validity for ICP-Brazil certificates-based digital signatures, which are based on the use of public and private cryptographic keys. However, valid electronic signatures can be created outside of ICP-Brazil system, if such signatures follow certain minimum parameters of validity (eg, authorship and integrity).

Generally, commercial contracts can be executed electronically as well as in writing or verbally, provided that the essential criteria for formation and validity are met and parties are in accordance with such means of signature. However, certain agreements and transactions still have to be in writing (ie, real estate sales, collateral agreements and family law transactions) and registered within its specific registries.

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INTELLECTUAL PROPERTY FRAMEWORK

Overview

As a general matter intellectual property rights, such as patents and copyrights as well as the registration of trademarks, are governed by federal statutes.

COMMERCIAL CONTRACT FRAMEWORK

Overview

Contracts, whether they concern IP rights or not, 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.

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 and there is no copyright outside the statutory framework.

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:

- The remainder of the calendar year of first publication, and an additional 50 years from that year end
- 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.

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/work to $20,000/work for infringement for commercial gain, and $100/work to $5,000/work for infringement for non-commercial purposes.

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

Criminal penalties are also available.

**MASK WORKS / 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:

- The interconnections, if any, and the elements for the making of an integrated circuit product
- 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**

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

**Duration of right**

The duration of protection for integrated circuit topographies is up to ten years from the filing date of the application for registration. Registration terminates 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 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, provided that the assignment does not dilute the rights of another 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 (as an alternative to damages) and interlocutory or permanent injunctions. Punitive damages awards are rare and require high-handed, egregious and oppressive conduct in carrying out the infringing acts.
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.

The new Combating Counterfeit Products Act (once fully implemented) will 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 TM is used to signify that a mark, whether registered or unregistered, is a trademark, and ® symbolizes a registered trademark.

Canada is in the process of implementing the Madrid Protocol. Canada does not currently require the use of the International Schedule of Classes of Goods and Services, but will in the future.

Duration of right

Trademark registrations are currently valid for a 15-year period, but that will be reduced to 10 years once the pending changes to Canadian trademark law have been fully implemented. A registration 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. Owners may also file a Request For Assistance with the Canada Border Services Agency to help prevent the importation of counterfeit or infringing goods into Canada.

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 Québec, trade secrets are protected by statute by virtue of the Civil Code of Québec.

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.

**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 for theft are not available with respect to the intangible information but may be available with respect to theft of a tangible object that contains confidential information.

### OTHER KEY IP RIGHTS

**Nature of right**

**Industrial designs**

Protection for the aesthetic aspect of a functional object is available under the Industrial Designs Act.

**Legal framework**

**Industrial designs**

Rights are only available by registration under the relevant statute.

**Duration of right**

**Industrial designs**

A 10 year term, subject to maintenance fee payment.

**Ownership / licenses**

**Industrial designs**
Licenses may be granted. Ownership may be assigned. The author of the design is the first proprietor, unless the design is performed for another for good and valuable consideration.

**Remedies for infringement**

**Industrial designs**

Damages (or alternatively the profits of the infringer), an injunction, disposal of the infringing products and punitive damages are available under the statute.

**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 employer 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. A patent assignment is not required to be in writing, whereas a copyright assignment is required by statute to be written.

**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 would be prudent to consider registering because a subsequent purchaser for value without notice may acquire rights that limit or defeat the prior assignee’s or licensee’s rights if a transfer or license is unregistered.

**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 limits the effect of arbitration clauses in consumer contracts, and that permits 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 indemnification**

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 usually 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.

**Electronic signatures**

Many contracts in Canada have no particular signature requirements. Accordingly, written signatures, electronic signatures and secure electronic signatures are all generally enforceable, and no particular form of signature is required. For example, a signature may consist of one or more letters, numbers or other characters.

There may, however, be issues regarding the identity of the signing party, or the integrity of the contract being signed. These issues can often be addressed using secure electronic signatures. Furthermore, the federal government and many provinces have enacted legislation giving recognition to electronic signatures, although in some cases certain documents (such as wills, trusts, powers of attorney and land transfers) cannot be signed electronically.
CHILE

INTELLECTUAL PROPERTY FRAMEWORK

Overview

As a general matter, intellectual property rights are governed by Law No 17,336 of Intellectual Property, and Law 19,039 of Industrial Property. The agency that administers and gives protection to intellectual property rights is National Institute of Industrial Property (INAPI).

COMMERCIAL CONTRACT FRAMEWORK

Overview

Generally speaking, contract law is regulated by the Civil Code, setting forth essential requirements of existence and special requirements depending on the contract. Moreover, it is applied in subsidy to any specific law, including the Commerce Code and Corporations Law that regulates solely the general requirements concerning the incorporation of a company and other commercial issues.

Regarding contract formation, it is possible to identify several prime rules. Firstly, mutual consent shall be expressly and freely declared, further, it needs to be serious and spontaneous, absent of any vice which consists of error, duress and deceit (or malice). Secondly, the contract shall contain a lawful object, that needs to be real and existent and shall be determined or determinable or physically and morally possible if it is an action to be done. Finally, the cause of the contract, meaning the motivation of the act, needs to be real and lawful. The mere beneficence and liberality is sufficient cause.

Pre-contractual documents may also be part of the contract, depending on certain circumstances, through appendixes or additional documents that are understood to be part of one single contract.

Lastly, certain contracts shall be written or another additional formality (such as shares’ transfers, real estate purchases, pledges and mortgages, among others) due to their significance. However, and notwithstanding there is no general requirement to do so, most of contracts that involve relevant amounts are written, in order to ensure the proof of its content.
COPYRIGHTS

Nature of right

In continental law tradition this right is called "author’s right." Author’s right includes Patrimonial rights and also Moral Rights. Moral rights comprehend Paternity, Integrity and Edition rights; there are also connected rights (interpreter).

Author’s rights are available for original works of authorship fixed in a tangible medium of expression. The rights arise at the time the original work of authorship is fixed in a tangible medium of expression, and registration is not required to validate the right.

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

Legal framework


Duration of right

Protection of the right is granted for the author’s entire life, plus 70 years as of date of author’s demise.

Ownership / licenses

Author can grant the right to use, reproduce, distribute, prepare derivative works, publicly perform and publicly display the work, either free of charge or onerously.

Remedies for infringement

Author can choose to prosecute either according to criminal or civil law.

- Author can claim damages, and also a fine of 5-50 Chilean UTM (approx. 360 – 3.600 USD)
- Actual damages can be actual monetary loss suffered by the copyright owner and profits gained by infringer
- Criminal conduct may be sanctioned with fines up to approx. USD 72.861 and reclusion for up to 301 days

MASK WORKS / TOPOGRAPHIES

Nature of right

Law 19,039 of Industrial Property provides legal protection for integrated circuits topography.

Integrated circuit shall be understood as a product, in its final or intermediate form, intended to perform an electronic function, in which the elements, at least one of which must be active, and some or all of the interconnections, are part of the body or surface of a piece of material.
Three-dimensional elements, expressed in any shape, designed for its manufacture shall be understood as tracing schemes or topography of integrated circuits.

Layout designs or topographies of integrated circuits shall be protected as long as they are original.

**Legal framework**

Topographies are protected with the same legal framework as trademarks.

**Duration of right**

Integrated circuits topography shall last 10 years as of filling, and it is nonrenewable.

**Ownership / licenses**

No text yet.

**Remedies for infringement**

No text yet.

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## PATENTS

**Nature of right**

A patent is an exclusive right granted by the State for the protection of an invention, which provides exclusive rights that will allow you to use and exploit your invention and prevent third parties from using it without your consent.

**Legal framework**

Patents are protected with the same legal framework as trademarks.

**Duration of right**

20 years, non-renewable, counted from the filing date of the application in Chile or the filing of the corresponding international application, in the case of foreign applications that have entered Chile via PCT.

**Ownership / licenses**

No text yet.

**Remedies for infringement**

No text yet.
TRADEMARKS

Nature of right

Any sign that is susceptible of graphic representation able to distinguish in the market products, services or industrial or commercial establishments. Such signs may consist of words, including the names of people, letters, numbers, figurative elements such as images, graphics, symbols, combinations of colors, as well as, any combination of these signs. When the signs are not intrinsically distinctive, registration may be granted if they have acquired distinctiveness through use in the market national.

Legal framework

Law 19,039 of Industrial Property provides general legal framework in regard to Trademarks and other Industrial Property rights.

Duration of right

Trademark shall last 10 years as of the date of inscription. They are renewable indefinitely for another 10 years.

Ownership / licenses

Acts performed over Industrial Property rights shall be recorded in a private document, subscribed before a Notary Public, and a note should be included in the respective registry.

Remedies for infringement

Owner of the Industrial Property right can generally require:

- Cease of acts that violate the protected right
- Indemnification of damages
- Implementation of necessary measures to prevent the infringement from continuing

Fines that go from 25 to 1.000 UTM (approx. USD$2,000 – 73,000) may also be enforced.

TRADE SECRETS

Nature of right

Trade Secrets are defined as any knowledge about industrial products or procedures can be considered as an industrial or business secret, whose maintenance in reserve provides its possessor with an improvement, advance or competitive advantage.

Legal framework

The protection of trade secrets is regulated by the Law 19,039 of Industrial Property, as part of the specific
provisions on the protection of confidential information. Trade Secrets are protected with the same legal framework as Trademarks, with the sole difference that for Trade Secrets there is no need for registry.

**Duration of right**

Indefinite, as long as it is kept secret.

**Ownership / licenses**

No text yet.

**Remedies for infringement**

No text yet.

**OTHER KEY IP RIGHTS**

**Nature of right**

**Industrial designs**

Industrial designs are all three-dimensional shape associated or not with colors, and any article industrial or craft that serves as a pattern for manufacture of other units and that is distinguished from its similar, by its shape, geometric configuration, ornamentation or a combination of these, provided that these characteristics give it a special appearance perceptible by sight, in such a way that result a new physiognomy.

Industrial drawings include any provision, set or combination of figures, lines or colors that develop in a plane for its incorporation into an industrial product for purposes of ornamentation and that they give, to that product, a new appearance.

Industrial drawings and designs shall be considered new to the extent that they differ significantly of known industrial drawings or designs or combinations of characteristics of industrial drawings or designs known.

**Legal framework**

**Industrial designs**

Industrial designs / industrial drawings are protected with the same legal framework as trademarks.

**Duration of right**

**Industrial designs**

10 years, non-renewable, counted from the date of its request.

**Ownership / licenses**

Not applicable for this jurisdiction.
Remedies for infringement

Not applicable for this jurisdiction.

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

Employees

According to the law, in employment agreements and provision of services, whose nature is the fulfillment of an activity inventive or creative, the faculty to request registration as well as the eventual industrial property rights belong exclusively to the employer or who commissioned the service, unless otherwise provided.

The employee, not required to perform an inventive or creative function according to his work contract, may request registration, and shall be the owner of the eventual industrial property rights derived from the inventions made by him, which will belong exclusively to them. However, if the knowledge acquired within the company benefited a in an evident manner the invention, such faculties and rights shall belong to the employer, in which case they must grant the worker an additional remuneration to be agreed upon the parties.

It is customary for employees to sign transfers of intellectual property and confidentiality agreements.

Consultants / contractors

The same rule from employment applies in the case of consultant/contractors.
It is customary for consultants and contractors to sign written agreements. In the absence of a written assignment of developments, consultants and contractors may retain ownership of the intellectual property developed by them.

KEY COMMERCIAL CONTRACT CONSIDERATIONS

Registration of commercial agreements

There is no general registration requirement for author’s right. However, registration is required for the protection of trademarks, patents, utility models, plant varieties and topographics of integrated circuits.

Recognized language of commercial agreements

Not applicable for this jurisdiction.

Country-specific issues for online content

Not applicable for this jurisdiction.

Enforceability of online/clickwrap/shrinkwrap terms

Online, clickwrap and shrinkwrap agreements are generally viewed as enforceable if they are conspicuous and
users have an opportunity to review and indicate affirmative assent.

**Governing law**

Governing law and venue for resolution of disputes specified in a commercial contract will generally be accepted and recognized in Chilean Courts.

Dispute resolution is litigation in Chile unless an alternative dispute resolution procedure, such as mediation or arbitration, is specified in the contract.

**KEY COMMERCIAL CONTRACT TERMS**

**Enforceability of warranty disclaimers**

Sellers, in their contracts can disclaim or exclude implied warranties. Disclaimers of warranty are usually enforced.

For contracts with consumers, there are special provisions in this regard, that generally include a forced period of 3 months for liability.

**Enforceability of exclusions/limitations of liability indemnification**

Exclusions and limitations on liability are usually enforced. Exclusions of liability for willful misconduct or gross negligence are not enforceable.

Enforceability of exclusions and limitations of liability against consumers are not allowed.

**Indemnification**

Express indemnities stated in contracts are recognized and generally respected. There are some limits legally established to the amount and indemnification clause may set forth (*lesión enorme*).

**Electronic signatures**

There is no IP regulation regarding electronic signatures.

Law No. 19,799 on electronic documents deems electronic signatures valid, whenever they are issued by certified electronic signatures providers.

According to Chilean Law, there are two valid electronic signature types: Simple Electronic Signature (FES) and Advanced Electronic Signature (FEA). Both of them are valid, and certify the identity of the signatory and other information such as the date or content of the document, depending on the type chosen.
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CHINA

INTELLECTUAL PROPERTY FRAMEWORK

Overview

In China, intellectual property rights are primarily protected under four major intellectual property laws, the Patent Law, the Trademark Law and the Copyright Law, the Anti-Unfair Competition 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 Administration of Market Supervision 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

Overview

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 subsequent 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, the application of the Contract Law with respect to technology contracts, the application of Contract Law in relation to financial leases, sales of goods, house leases and labor disputes.

With respect to the import and export of technology, the Regulations of the People's Republic of China on Administration of Import and Export of Technologies shall be applicable. 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.

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; 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 puts 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, then statutory damages of up to ¥500,000 shall be awarded, according to the circumstances of the case.

**MASK WORKS / TOPOGRAPHIES**

**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 China National Intellectual Property Administration. 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 10 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, whether or not 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 Administration of Market Supervision to handle the matter. When the Intellectual Property Administration Department of the State Administration of Market Supervision 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
- Designs

Patents grant the rights to exclude others, for commercial purposes, from:
• Manufacturing, using, offering to sell, selling or importing the patented goods

• Using the patented method, or using, offering to sell, selling or importing products made directly through use of the patented method

• 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 10 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.

Remedies for infringement

Damages can be calculated based on:

• Lost profits

• Illegal gains by the infringer

• Up to three times the 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.
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 will become effective as of November 1, 2019.

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 10 years, which can be renewed for another 10 years upon each expiration.

Ownership / licenses

A trademark license agreement should be recorded with the China National Intellectual Property Administration. 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 (or up to ¥5 million as of November 1, 2019 under the amended Trademark Law) 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, which was recently amended and became effective as of April 23, 2019, defines a “trade secret” as technical information, operational information or other commercial information with business value; that is not known to the public; 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 (or to facilitate, instigate or otherwise assist others to do the same).

*Legal framework*

Trade secrets are mainly protected under the PRC Anti-Unfair Competition Law. The State Administration of Market Supervision 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 ¥5 million. 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.

**OTHER KEY IP RIGHTS**

*Nature of right*

Not applicable for this jurisdiction.
Legal framework

Not applicable for this jurisdiction.

Duration of right

Not applicable for this jurisdiction.

Ownership / licenses

Not applicable for this jurisdiction.

Remedies for infringement

Not applicable for this jurisdiction.

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 or her 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 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 China National Intellectual Property Administration. 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

Not applicable for this jurisdiction.

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:

- For actions that caused personal injury
- Disclaimers for intentional actions that caused serious property damage or that caused by gross negligence
• Disclaimers in violation of mandatory clauses in the law

**Enforceability of exclusions/limitations of liability indemnification**

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.

**Electronic signatures**

Use and enforcement of electronic signatures are primarily governed by the PRC Electronic Signature Law. As a general principle, electronic signatures can be used in documents in most types of civil activities, and such signatures will not be considered unenforceable solely because they are in electronic form.

China requires electronic signatures to satisfy certain requirements in order to be considered reliable and legally enforceable. In practice, the most common types of electronic signatures that have been held enforceable by the courts include:

• Bank card information and password

• USB key to a bank account and password

• Online platform username and password
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COLOMBIA

INTELLECTUAL PROPERTY FRAMEWORK

Overview

Colombia has a wide regulation on Intellectual Property consisting of international treaties, national laws and decrees, mainly governed by the decisions issued by the Andean Community (CAN). According to article 6 of the National Constitution, the Colombian State has the obligation of protecting Intellectual Property. Article 151 of the Constitution states that the Congress shall dictate the legal regime on industrial property, patents, trademarks and any other intellectual property that may be protected.

Colombian Intellectual Property Regime is regulated by the Decisions 486, 689 and 351 of the CAN and is divided in 2 main groups: copyrights and industrial property. Industrial property protects exclusive rights regarding trademarks, brands, slogans, designations of origin, patents over inventions and utility models, industrial designs and layout-designs of integrated circuits; which are recognized once the national authority on industrial property registers them. Copyrights cover two different rights: moral and economic rights, that may be held by same or different person and are recognized since the creation of an original work (software, literary work, musical work, work of art, audiovisual work, phonograms, beside others).

Two main principles govern intellectual property in Colombia: territoriality and protection against unfair competition. The principle of territoriality states that relevant authorities may grant or recognize rights within the territories where they have competency. Nevertheless, international treaties may extend the protection of such rights to other countries. The principle of protection against unfair competition establishes that a right holder may defend a granted right against third parties, which allows free competition considering that a right holder can prevent unfair practices as acts of confusion, discredit or exploitation of other’s reputation.

COMMERCIAL CONTRACT FRAMEWORK

Overview

The Colombian legal regime on intellectual property does not have a specific law that regulates intellectual property in commercial contracts. However, there are specific laws that may be relevant when negotiating and executing commercial agreements (eg. antitrust laws) and there are some regulations that may apply to specific industries, which in some cases, varies the relevant authority (eg. agricultural patents).
The Commercial Code has dictated the principal provisions applicable to commercial agreements. Nonetheless, intellectual property continues to be governed by Decision 486 and Decision 351 issued by CAN, which set forth the rights and obligations derived from any invention, work or creation.

The interpretation and enforceability of commercial contracts are generally state law matters, but the Andean Court interpretation prevails in intellectual property matters. For this reason, to decide on the interpretation of clauses or provisions that involve intellectual property matters, the national judges request the Andean Court interpretation. If this procedure is not carried out, the decision of the national judge is not enforceable.

COPYRIGHTS

Nature of right

Copyrights protect any literary, artistic and scientific work that may be reproduced or disclosed by any known or future means. Protection is granted regardless of the means by which the work was created.

The person whose name, pseudonym or any other identifying detail is visible on the work is considered the author, but another legal or natural person may have the ownership of the economic rights derived from the work. In this regard, copyright recognizes 2 types of rights: economic and moral rights.

Moral rights

As per Decision 351 dated 1993, moral rights are those that recognize the author. This type of right may not be licensed, transferred, waived or prescribed and empowers the author to:

- Keep the work unpublished
- Claim the authorship of the work
- Object any change, alteration or mutilation of the work that may be harmful to its integrity or that may affect the reputation of the author

Economic rights

The economic right is any economic benefit that is derived from the exploitation or reproduction of a specific copyrighted work. In this regard, Decision 351 of 1993 empowers the author or the person that holds the economic right to authorize or prevent:

- Reproduction of the work by any means, understood as fixing the work in a way that allows it or its copies to be communicated in all or in part. In this regard, the communication implies any act by which 2 or more persons may access the work without a prior distribution of an authorized copy
- Disclosure of the work to the public
- Distribution of copies
- Exportation of any copy that has not been previously authorized
Translation, adaptation or any transformation of the work

Legal framework


Moreover, Colombia is a party of the:

- WIPO Copyright Treaty
- Universal Copyright Convention and
- the Inter-American Convention on Copyright in Literary, Scientific and Artistic Works

Duration of right

Copyrights last for the life of the author plus 80 years from the date of the author’s death. Nonetheless, if the work is co-authored, the 80 year-period will begin from the date on which the last author dies.

- If the rights are assigned, the protection of the acquirers lasts for the life of the author plus 25 years. The author and the acquirer may also agree to a different term, but such agreed term may not be longer than 80 years. For its part, the protection for the author’s heirs, which receive them by means of a succession, will be for the 80 year-term
- If the author does not have heirs, once he or she dies the work will be deemed in the public domain
- When the holder of the right is a legal or public entity the protection will last 30 years from its publication

Ownership / licenses

The ownership of the work and the corresponding rights come into existence upon creation. Registration is not required to validate the copyright, nevertheless it fulfills the publicity requirements and constitute a suitable means of evidence of the right. However, if the economic right has been transferred, such transfer will only be enforceable against third parties once it is registered by the National Right Office, otherwise the rights will remain of the author or the previous registered assignee (Oficina Nacional de Derechos de Autor).

Law 1450 of 2011 states that the transfer of copyrights can be limited regarding the methods of exploitation, the time and the territory as provided in the corresponding agreement. If the agreement does not determine the time and the territory regarding which the transfer is made, the law assumes that it is limited to five years and to the country where the transfer is consummated. Moreover, this kind of agreement shall be executed in writing and any clause that transfers copyrights in whole or in such way that future production is not determinable or compels to restrict it, will not be enforceable.

Joint ownership of copyrights is recognized when the contributions of each author is significant and cannot be determined. Contribution of separate ideas does not constitute a collaborative work. Joint ownership implies that the right of repentance and the right to modify the work must be exercised jointly by the authors. Thus, authors
must agree on the changes that will be introduced to the work.

**Remedies for infringement**

Copyrights may be protected under Colombian law by a Colombian judge. Nevertheless, the Colombian judge will request the Andean Court of Justice of the CAN to provide an opinion on the case, which will be applied and considered by the Colombian judge in his or her decision.

Moreover, article 56 of the Decision 351 states that the judge may order the following precautionary measures:

- immediate cessation of the unlawful activities
- the attachment, sequestration, confiscation or preventive seizure, as appropriate, of the copies produced in violation of any of the rights recognized by this Decision
- the attachment, seizure, confiscation or sequestration of the apparatus or materials used for the commission of the unlawful act

Additionally, within the judgment, the court may decide and order:

- payment, to the owner of the infringed rights, of adequate compensation or indemnification for damages sustained as a result of the infringement
- that the offender shall bear the cost of the proceedings that he has caused the owner of the infringed right to institute
- the permanent removal from distribution channels of the copies constituting the infringement of rights
- criminal sanctions equivalent to those applicable to offenses of comparable gravity

Finally, copyrights are also protected by the criminal law. Therefore, the infringements might be investigated by the General Prosecutor and penalized by the criminal courts with fines between 26,66 and 1,500 monthly minimum legal wages (US$7,359 and US$424,058 approximately) and prison sentences from 4 to 7 years.

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Note: Colombia’s judicial Branch is divided in the following jurisdictions: Ordinary Jurisdiction (*Jurisdicción Ordinaria*), Administrative Jurisdiction (*Jurisdicción de lo Contencioso Administrativo*), Constitutional Jurisdiction and other Special Jurisdictions. The Ordinary Jurisdiction rules on matters related to civil, labor, criminal and agrarian law.

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**MASK WORKS / TOPOGRAPHIES**

**Nature of right**

According to article 86 of the Decision 486, an integrated circuit is
"(…) a product, in its final or an intermediate form, in which the elements, at least one of which is an active element, and some or all of interconnections are an integral part of the body or surface of a piece of material, and which is intended to perform an electronic function." Layout-design, in turns, "(…) is three-dimensional disposition, however expressed, of the elements, at least one of which is an active element, and the interconnections of an integrated circuit, or such a three-dimensional disposition prepared for an integrated circuit intended for manufacture."

Mask works, also called layout-designs of integrated circuits, may be protected by each state if they are original, which means they are a result of an intellectual effort of the creator and are not commonplace in the integrated circuit industry. For this purpose, a designer or an entitled person has to register the layout-design of integrate circuits with the Superintendence of Commerce (SIC).

Registration of layout-designs of integrated circuits grants a designer/creator the right to prohibit third parties from reproducing, commercializing or importing it. However, the protection conferred extends just to the layout-design itself and not to any concept, process, system or technique that is incorporated in the layout-design.

Rights granted by the registration may only be asserted against acts that have industrial or commercial purpose. Nonetheless, a third-party may engage commercial or industrial acts to exploit a layout-design of integrated circuits, if it is a result of the evaluation or analysis of the protected layout-design and meet the originality requirement.

**Legal framework**

Layout-designs of integrated circuits are governed by Resolution 486 of 2000 issued by the CAN. Moreover, Colombia became party to Paris Convention for the protection of Industrial Property, Agreement on Trade-Related Aspects of Intellectual Property Rights, Locarno Agreement and the Convention on Industrial Property executed by and between Colombia and France.

**Duration of right**

Layout-designs of integrated circuits have a term of protection of ten years beginning from the earliest to occur of the following:

- last day of the year in which it was exploited for the first time in Colombia or abroad or
- the date in which the registration request was made before the competent authority in Colombia

Protection is granted for ten years and can be renewed for equal periods, but the relevant authority may no longer protect the product when it does not comply with the specifications set forth in Resolution 486.

In any case, protection for the layout-design of an integrated circuit will not be enforceable for more than 15 years.
from the last day of the year in which it was created.

Nonetheless, the layout-design of an integrated circuit that has not been commercially exploited anywhere in the world may only be registered if the application is filed within a period of 15 years from the last day of the year in which the layout-design was created.

Ownership / licenses

The designer of a layout-design of an integrated circuit may transfer the registry of the layout-designs or grant a license, but both the transfer and the license must be in writing. Nevertheless, in order for the transfer or license to be enforceable it must be registered by the SIC.

Moreover, the Colombian legal regime on intellectual property does not require that protected layout-design of integrate circuits be exploited, but when a layout design is not exploited when national emergencies, public sanity, prevent anti-trust practices demands it, the relevant authority may order that:

- The layout-design of integrated circuits can be used or exploited by third parties with commercial or industrial purposes or
- The layout-design of integrate circuits must be licensed to a third-party if the third party has requested it

Finally, when the layout-designs of an integrated circuit has been commercially exploited abroad, request for registration shall be submitted within two years from the date it was first exploited.

Remedies for infringement

The designer or owner of the rights over a layout-design of an integrated circuit may claim its rights with the ordinary jurisdiction of its country. Nevertheless, the judge shall request that the Andean Court of Jurisdiction of the CAN provide an opinion on the case prior to the taking of the decision, which shall apply and consider the opinion of the Andean judge.

Finally, layout-designs of integrate circuits are protected by the criminal law. Therefore, the infringements might be investigated by the General Prosecutor and penalized by the criminal courts.

PATENTS

Nature of right

Resolution 486 of 2000 states that a patent is a right granted to an inventor to exclusively exploit the claimed invention, preventing any third party from manufacturing, selling or using such invention without the inventor’s prior consent. Any legal or natural person may file for a patent and if different people made the same invention
jointly, the right to the patent will be common to all people involved.

Additionally, an invention is an innovative object, technic or procedure. For an invention to be patented it must:

- Be innovative, meaning that the invention is not known, verbally or in writing, exploited or commercialized within the current state of the art before the request is filed
- Have a certain level of inventiveness, meaning that the invention is not obvious or clearly derived from the current state of art
- Have an industrial application, meaning the invention shall be used in any industry

**Utility models**

According to article 81 of Resolution 486, a utility of model

"is any new shape, configuration or arrangement of components of any device, tool, implement, mechanism or other object, or any part thereof, that makes for improved or different operation, use or manufacture of the object incorporating on it, or which endows it with any usefulness, advantage or technical effect that it did not have previously..."

Patents protect utility models, which means that the provisions for patents of inventions are applicable to them. In this regard, the State grants the inventor the right to exclusively exploit of the utility model.

**Legal framework**


**Duration of right**

Patents have a term of protection of 20 years from the filing date of the application on which the patent was granted. Nevertheless, in order to maintain it in force, it is necessary to pay in advance annual fees on the last day of the month in which the application was filed. If such fees are not paid, the patent is no longer enforceable, which means that the product or process becomes of public domain.

**Utility models**

Patents of a utility model have a term of protection of ten years from the filing date. Nevertheless, in order to maintain it in force, it is necessary to pay an annual fee, as requested for any patent in general.

**Ownership / licenses**

The owner of a granted or pending patent may license the patent rights to one or more third parties, but the
license must be registered before the SIC. If the license is not registered, it will be unenforceable against third parties.

Articles 59 and 60 of Resolution 486 establish that the owner of the patent shall exploit the patented invention either directly or through an authorized person. For this purpose, exploiting the patent is understood as:

- the industrial manufacture of the patented product or the full use of the patented process in a manner sufficient to meet the needs of the market and
- the import of the patented product, including distribution and marketing, where it is done on a scale sufficient to meet the needs of the market

On the expiry of a period of three years following the day the patent was granted, or four years following the application for the patent, whichever is longer, an interested third party may request that the SIC grant a compulsory license for the industrial manufacture of the patented product or for the full use of the patented process, if at the time of such request the patent has not been exploited or the exploitation has been suspended for more than a year. In any case, the owner of the patent might provide legitimate explanations for the non-exploitation, including force majeure and fortuitous events.

Nonetheless, as per article 66 of the Resolution 486:

"a compulsory license shall only be granted where the person who requests it has previously attempted to obtain a contractual license from the owner of the patent on reasonable commercial terms and conditions, and where that attempt has not had any effect within a reasonable time."

Utility models

The rules regarding ownership and licenses of patents of inventions are applicable to patents of utility models.

**Remedies for infringement**

Resolution 486 establishes different mechanisms to protect the patent or its validity. Firstly, any interested third party or the SIC *ex officio* may decree the absolute invalidity of the patent in compliance with the causes defined by law. Moreover, the SIC may cancel a patent when it has been granted to a person not entitled to such grant. The action for cancellation may only be brought by the person to whom the right to the patent belongs.

The owner of the patent may claim its right before the ordinary jurisdiction of its country. Nevertheless, the judge must request that the Andean Court of Jurisdiction of the CAN provide its opinion on the case prior to the taking of the decision, which shall apply and consider the opinion of the Andean judge.

Finally, patents are protected by criminal law. For this reason, these situations may be investigated by the General Prosecutor and penalized by the criminal courts.

Utility models

The rules regarding remedies for infringement of patents of inventions are applicable to patents of utility models.
TRADEMARKS

Nature of right

As per Resolution 486 of 2000, a trademark is any sign that identifies goods or services on the market. In this regard, signs that may be represented on graphics might be registered as trademarks, as well as words, images, letters, numbers, combination of colors or any combination of the signs.

In order to register the trademark, the request has to meet the following requirements:

- File the request
- If possible, replicate the trademark
- Pay the corresponding fees
- If applicable, submit the certificate of registration in other countries and
- Fulfill other requirements established by the Colombian Law, regarding the procedure with the SIC

Ways to lose the right over the trademark

- **Cancelation of registration**: The national office will cancel the registration when the trademark has not been used by at least one of the authorized officers or by the owner during the three years following the registration. Nonetheless, the owner has the possibility to prove a force majeure or an unforeseen circumstance that explains the non-use of the trademark. Moreover, the registration will be canceled when the trademark identifies more than one good or service.

- **Waiver of registration**: The owner has option to waive the registry of its trademark. This right may be exercised at any time and may lie on the entire registry or on a part of it, as a single good or service represented.

- **Invalidity of registration**: The national office shall invalidate the registration when:
  - it has been granted without the essential requirements
  - the sign does not fulfil the necessary conditions and
  - when it has been registered without taking into account third-party’s interest

- **Expiration of registry**: Registry of a trademark expires when the owner does not file the request for renewal or does not pay the corresponding fees on time

Types of trademarks

- **Regular trademarks**: As mentioned above and according to Resolution 486 of the CAN, this trademark
applies to any sign that identifies goods or services on the market. In this regard, signs that may be represented on graphics might be registered as trademarks, as well as words, images, letters, numbers, combination of colors or any combination of the signs. The regular trademarks are regulated as mentioned above.

- **Collective trademarks**: According to Resolution 486 of the CAN, a collective trademark is: “(...) any sign that serves to distinguish the origin or any other common characteristic of goods or services from different firms that use the sign under the owner’s control.” Legally established associations may register collective marks to distinguish on the market the goods and services of its members. The Collective trademarks may be transferred or licensed in accordance with the rules established for these purposes by the association. In any other matter, the regulation for regular trademarks shall apply to collective trademarks.

- **Certification marks**: As per Resolution 486 of 2000, a certificate mark is "sign intended to be applied to goods or services which quality or other features have been certified by the trademark owner." The registration of the certification mark shall include the code of use. For this reason, the SIC must be informed of any change of the rules for its usage. Such changes will be enforceable against third parties once the owner registers them on the corresponding registry. In any other matter, the regulation for regular trademarks shall apply to collective trademarks.

Certification marks may be transferred or licensed only in accordance with the rules established in the code of use.

**Legal framework**

Trademarks are governed by Resolution 486 of 2000 issued by CAN. Colombia became party to the Paris Convention for the Protection of Industrial Property, Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks and Trademark Law Treaty (TLT).

**Duration of right**

Trademarks have a term of protection of 10 years from the grant date and may be renewed for successive 10-year periods. However, the renewal must be requested from the SIC at least 6 months before the initial term expires and it will have the same terms and conditions of the initial right.

**Ownership / licenses**

The Resolution foresees the impossibility of registering identical or similar trademarks representing the same goods or services when the owners enter into an agreement that allows the existence of trademarks in the same register. Such agreement is executed to prevent the confusion among the public and duly inform the consumers.

The registration of trademarks may be licensed but it has to be done in writing and registered with the SIC. In this regard, the owner may authorize third parties to use and exploit the registered trademark.

The registration of the trademark does not grant the right to the owner to prohibit third parties from using the trademark for publicity or comparative advertising, provided that it is used in good faith.
If the contact details of the owner change during the license, the SIC must be informed of the change.

**Remedies for infringement**

The owner may initiate action against any third party that without his consent:

- Uses the trademark to distinguish similar goods and services
- Removes or alters the trademark for commercial purposes
- Commercializes or advertises products that include the registered trademarks
- Uses an identical or similar sign to identify other goods or services that may lead to confusion
- Uses a similar trademark that may cause any economic or commercial harm to the owner
- Makes public use of the trademark and such use causes a negative impact on the owner’s prestige

For these purposes, the owner of a trademark may claim its right with the ordinary jurisdiction of the country in which its right has been recognized and the infringement has taken place. The Judge will request the opinion of the Andean Court of Jurisdiction of the CAN on the case prior to the taking of the decision, and will apply and consider the opinion of the Andean judge.

Trademarks are protected by the criminal law. For this reason, they can be investigated by General Prosecutor and penalized by criminal courts.

**TRADE SECRETS**

**Nature of right**

Article 260 of Resolution 486 establishes that a trade secret is any non-disclosed information held by any person (legal or natural) that can be used in any productive, industrial or commercial activity, that can be transmitted to a third party as long as such information has the following features:

- It is a secret, which means that it is not known or accessible to those who usually handle it
- It has a commercial value due to its secrecy
- It is protected by reasonable measures in order to keep it secret

Information disclosed by virtue of a legal provision or by a court order is not considered a trade secret. Information provided to an authority is not considered as such when a person supplies it to obtain license, permit, authorization, registration or any other official enactment.

The Colombian Legal Regime does not determine a specific manner for the transference of the secret protection. For this reason, the owner must take steps to protect secret information in accordance with its features, such as:
confidentiality policies

• training programs for employees

• limit access to secret information and

• follow procedures used to maintain information private

Legal framework

Trade Secrets are governed by Resolution 486 of 2000 issued by CAN.

Duration of right

Trade Secrets may be protected as long as they comply with the conditions established in article 260 of Resolution 486. Consequently, the duration of the protection might be perpetual as long as the information remains being a trade secret. Nonetheless, the duration of the right is limited to the fact that the information becomes public, as a consequence of an act attributable to the owner, or as a consequence of a legal order.

Ownership / licenses

The owner or who has control over the trade secret is protected by virtue of law. This person has a duty to authorize and restrict access to the confidential information. For this reason, if the information is disclosed to a third party it is important to execute an agreement that requires such third party to maintain its confidentiality.

Without limitation to the foregoing, the information may be disclosed to protect public order, and prior request made by a competent authority. In this case, it loses the nature of trade secret.

Remedies for infringement

Resolution 486 states that the mechanisms to protect trade secrets are actions that tend to condemn Unfair Competition, which are contained in article 20 of the Law 256 dated 1996. In this regard, the owner is allowed to claim its rights and seek for the corresponding indemnification against those, who disclose the information without prior authorization, and use it on unfair competition acts.

Attorney General may initiate an unfair competition action ex officio if the action affects the public order. Finally, the owner may claim the protection of its right before the Andean Court of Jurisdiction of the CAN, in the event in which the national authorities do not provide such protection.

OTHER KEY IP RIGHTS

Nature of right

Industrial designs

According to Resolution 486 an industrial design grants the right to exclusively exploit the appearance of a specific product without changing its purpose. In this regard, an industrial design makes the product more attractive to
customers. For this reason, rights over an the industrial design protects the aesthetic features of the product and not its technical aspects. Any legal or natural person has the right to prevent any third-party from exploiting its design without prior consent.

The registry of industrial designs does not include:

- industrial designs that are contrary to public order or morals
- industrial designs that are related to technical features or technical functions, without entailing any arbitrary involvement of the designer and
- if industrial design is the only manner in which the product may be mechanically pieced or connected

**Legal framework**

**Industrial designs**

Resolution 486 dated 2000 issued by CAN governs industrial designs. Moreover, Colombia became party to Paris Convention for Protection of Industrial Property, Agreement on Trade-Related Aspects of Intellectual Property Rights, Locarno Agreement and to the Convention on Industrial Property executed by and between Colombia and France.

**Duration of right**

**Industrial designs**

Industrial designs have a term of protection of 10 years from the filing date. Nevertheless, in order to maintain it in force, it is necessary to pay an annual fee. If such fees are not paid, the registry of the industrial design is no longer enforceable.

**Ownership / licenses**

**Industrial designs**

The designer may transfer the registry of the industrial design or grant a license, but both the transfer and the license shall be made and granted in writing and registered before the SIC. If 2 or more persons create an industrial design jointly, the right to register it will belong jointly to all of them. Nonetheless, according to article 114, "where two or more persons create the same industrial design independently, registration shall be granted to the one, or to the successor in title, who files the first application in relation to it or who claims the earliest priority."

**Remedies for infringement**

**Industrial designs**

The designer or owner of industrial design may claim the protection of its right with the ordinary jurisdiction of its country. The judge must request an opinion on the case from the Andean Court of Jurisdiction of the CAN prior to the taking of the decision and shall apply and consider the opinion of the Andean Judge in the decision.
Industrial designs are protected by the criminal law. Any infringement may be investigated by General Prosecutor and penalized by criminal courts.

**INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT**

**Employees**

In Colombia, the same provisions that govern employment agreements govern the intellectual property in service agreements.

Per article 8 of the Resolution 85 of 1974 issued by CAN, economic rights derived from the inventions created by an employee hired to research belong to the employer, unless it is otherwise provided in an employment agreement.

The employee will be the owner of the patent of an invention or a copyright of a work and own the rights derived from it, provided that within its functions he or she does not have access to secret or confidential research. Notwithstanding the above, according to the general rule of Law 1450, rights derived from industrial property are transferred to the employer unless it is otherwise provided in the employment agreement. However, an employee will always have a right to be recognized as the creator of the invention or author of a work.

The author (employee) is the owner of the moral and economic rights in regard to copyrights. Nonetheless, law presumes that an employee transfers economic rights to its employer to the extent that it is necessary to carry out the usual activities of the employer at the time the work was created.

The abovementioned provisions will only apply to written agreements and will also govern services agreements.

**Consultants / contractors**

The same rules used for employees are applied to contacts with consultants and contractors.

**Public officers**

Law 23 of 1982 and Law 44 of 1993 determine that economic rights derived from works created by public officers when complying with their legal and constitutional functions are presumed to transfer to the state. Public officers will hold the moral rights, provided that it is not contrary to the rights and obligations of the corresponding legal entity. In any case, public interest will prevail.

**Intellectual Property in projects financed by the state**

The Law 1753 of 2015 established that in research projects or in projects for development of science, technology and innovation or communications and information technologies financed with public resources, the state may assign, free of charge the intellectual property rights that it holds, provided that it does not affect national security or defense. In addition, the state may authorize the transfer of such rights to the developer of the project.

The terms and conditions of the assignment and transfer will be set forth in the corresponding agreement.

**KEY COMMERCIAL CONTRACT CONSIDERATIONS**
**Registration of commercial agreements**

Any agreement that transfers or assigns an intellectual property right shall be registered before the competent authority.

**Recognized language of commercial agreements**

As per Resolution 486 and 351, the filing with the relevant authority to register intellectual property rights must be in Spanish. Nonetheless, if the documents or agreements are in a different language they will be accepted provided that they are translated to Spanish.

**Country-specific issues for online content**

Colombia has a robust legislation on data privacy which means that any internet interaction shall comply with the current regime on date privacy, which means that the website shall request the authorization of data subjects for their data process and shall implement a privacy policy and an information security policy.

Law 1450 of 2011 has recognized the principle of neutrality, which dictates that users may use, send, receive and offer content, services or apps that are not illicit. In this regard, the Resolution 3502 of 2011 of the Ministry of Telecommunications (MINTIC) determines that internet contents are governed by four principles:

- **Free Choice:** the user may use, send, receive or offer any content, unless they are forbidden by the law or by the order of a judicial authority

- **No Discrimination:** the network providers shall provide equal treatment to the content, apps and services, without any arbitrary discrimination

- **Transparency:** the network providers shall reveal their users traffic management policies and the providers who may access their network

- **Information:** the network providers shall provide to users the information regarding the services provided

Without limiting the aforementioned, Colombia does not have a specific regulation regarding intellectual property protection online and thus, the applicable law for the online content issues is the one that governs intellectual property in general as well as data privacy and the infringement of the right to intimacy and to a good name. In any case, the information and contents shared on the internet may not infringe the law.

**Enforceability of online/clickwrap/shrinkwrap terms**

Online, clickwrap and shrink-wrap agreements are generally recognized by Colombian law and are enforceable if they are conspicuous and users have an opportunity to review and indicate affirmative assent.

**Governing law**

As a rule, the law governing intellectual property is the Colombian law and the Decisions of the CAN. Nonetheless, it is desirable that parties include a mechanism for resolution of disputes, such as arbitration, especially in cross-border transactions, in which case parties may choose the governing law applicable to their
KEY COMMERCIAL CONTRACT TERMS

Enforceability of warranty disclaimers

Warranty disclaimers are recognized and enforceable if they are made known to the parties and/or are conspicuous.

According to Law 1480 of 2011, warranty disclaimers are not enforceable against consumers unless the product defect is derived from force majeure, a third-party fault, misuse of the product or the fact that consumer did not follow the instructions for the installation, use or maintenance of the product.

Enforceability of exclusions/limitations of liability indemnification

Parties shall establish the extent and scope of rights granted and limitations of liability. Even though such limitations are usually recognized, limitations and exclusions of liability for gross negligence, fraud or bad faith and not enforceable.

Indemnification

Express indemnities stated in agreements are recognized, respected and generally have three obligations:

- **defend**
- **indemnify** (pay for the damages caused) and
- **hold harmless** (indemnify party does not have any other liability arising out of the claim)

The indemnification clauses may extend to third parties.

Electronic signatures

Decree 2364 dated 2012 establishes that an electronic signature is any method that allows identification of a person regarding a data message, provided that it is reliable and appropriate for the purposes it is going to be used.

The electronic signature is reliable when:

- the data that created the signature exclusively corresponds to the signatory and
- it is possible to detect any unauthorized modification to the data message after it has been signed

An electronic signature is enforceable and has the same effect as an original signature if it is reliable and complies with the purpose for which it is being used.
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INTELLECTUAL PROPERTY FRAMEWORK

Overview

Czech law belongs to the continental system of law (or civil law, as opposed to common law). Regulations covering intellectual property rights are primarily set out in various statutes issued by Czech Parliament.

The most important statutes are the following (each of them as amended from time to time):

- Act No. 121/2000 Coll. on Rights Related to Copyright (Copyright Act)
- Act No. 527/1990 Coll. on Inventions and Improvement Proposals (Patents Act)
- Act No. 441/2003 Coll. on Trademarks (Trademarks Act)
- Act No. 207/2000 Coll. on Protection of Industrial Designs (Industrial Designs Act)
- Act No. 529/1991 Coll. on Protection of Topographies of Semiconductor Products (Topographies of Semiconductor Products Act)
- Act No. 206/2000 Coll. on Protection of Biotechnological Inventions
- Act No. 408/2000 Coll. on Protection of Plant Variety Rights
- Act No. 452/2001 Coll. Protection of Designations of Origin and Geographical Indications
- Act No. 221/2006 Coll. on Enforcement of Industrial Property Rights
- Act No. 89/2012 Coll. Civil Code (Civil Code), providing general framework of civil law and regulating trade secrets

Many of these pieces of legislation are in compliance with relevant EU legislation, as the Czech Republic is a
member country of the European Union.

**COMMERCIAL CONTRACT FRAMEWORK**

*Overview*

Commercial contracts are governed by the Civil Code.

Other pieces of legislation may be relevant to certain commercial arrangements (eg, antitrust laws, Act No. 143/2001, as amended, on Protection of Economic Competition) and there may be industry-specific regulations that may be applicable to contracts in particular industries.

**COPYRIGHTS**

*Nature of right*

Copyright is available for original works of authorship in any objectively perceivable manner, including in electronic form, permanent or temporary, irrespective of its scope, purpose or significance. A computer program shall also be considered an authorship work if it is original in the sense that it is the author’s own intellectual creation. Registration is not required (nor even possible) for valid copyright rights and the copyright shall apply to the work in its entirety, to its individual stages of development and to parts of the work, including its title and the names of its characters, if any of these meet the definition elements of an authorship work set out above.

Copyright holders have the exclusive right to decide to publish their work, claim the authorship and the right to the inviolability of their work (moral rights). They also have the exclusive rights to use, reproduce, distribute, rent, loan, publicly display and publicly perform their works of authorship.

*Legal framework*

Copyright, including both economic and moral rights related to it, is governed by the Copyright Act.

*Duration of right*

Copyright protection for economic rights lasts for the life of the author plus an additional 70 years. For an anonymous work or a pseudonymous work, the copyright lasts for a term of 70 years from the year of its first publication. The moral rights expire with the death of the author (but post-mortem protection is available to a certain extent for relatives and associations of authors).

*Ownership / licenses*

Joint ownership of copyrights is recognized; the co-author’s share of the profit can be modified by an agreement between the co-authors. Statutory and implied licenses are recognized.

*Remedies for infringement*

Copyright registration is not required in order to claim damages for infringement. It is possible to seek preventing
importation of infringing.

Injunctive relief is also a possible remedy.

Criminal penalties are possible.

**MASK WORKS / TOPOGRAPHIES**

**Nature of right**

Protection for original mask works fixed in semiconductor chip products.

Mask works are defined as a series of related images, no matter in what manner fixed or encoded mutually connected, representing the three-dimensional permanent pattern of the layers of a semiconductor chip product.

**Legal framework**

Mask works are governed by the Topographies of Semiconductor Products Act.

**Duration of right**

10 years from registration (ends at end of 10th calendar year) or from the first open commercial exploitation.

**Ownership / licenses**

Not applicable.

**Remedies for infringement**

Possibility to claim actual damages for infringement.

Possible to seek preventing importation of infringing.

Injunctive relief is also a possible remedy.

Criminal penalties are possible.

**PATENTS**

**Nature of right**

Patents grant the exclusive right to use the invention, to authorize others to use the invention or to assign the patent to others.

**Legal framework**

Patents are governed by the Patents Act.
**Duration of right**

20 years from filing date of application.

**Ownership / licenses**

Joint ownership is permissible; license cannot be granted by one joint owner without consent of the other joint owner(s). The relationship between the co-owners can be amended by an agreement. Implied licenses are recognized.

A compulsory license may be imposed.

**Remedies for infringement**

Possibility to claim actual damages for infringement.

Possible to seek preventing importation of goods that are infringing.

Injunctive relief is also a possible remedy.

Criminal penalties are possible.

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**TRADEMARKS**

**Nature of right**

Trademark may consist of any sign, including personal names, colors, designs, letters, numerals, the shape of goods or their packaging, gestures, musical trademarks etc., provided that such sign is capable of distinguishing goods or services from other goods or services.

**Legal framework**

Trademarks are governed by the Trademarks Act.

**Duration of right**

10 years from filing date of application and renewable repeatedly on request of the owner for another 10 years.

**Ownership / licenses**

Joint ownership is permissible; license cannot be granted by one joint owner without consent of the other joint owner(s). The relationship between the co-owners can be amended by an agreement.

**Remedies for infringement**

Possibility to claim actual damages for infringement.
Possible to seek preventing importation of infringing goods.

Injunctive relief is also a possible remedy.

Criminal penalties are possible.

**TRADE SECRETS**

*Nature of right*

Trade secrets are regarded as technical or operational information that is valuable to the business, not known to the public or in relevant business circles, that confers identifiable competitive value and whose owner ensures in his or her own interest its secrecy.

*Legal framework*

Trade secrets are governed by the Civil Code.

*Duration of right*

Unlimited (as long as all definition elements are fulfilled).

*Ownership / licenses*

Joint ownership is possible. A trade secret is an intangible asset under Civil Code.

*Remedies for infringement*

Damages can include actual loss and unjust enrichment caused by misappropriation.

Injunctive relief is also a possible remedy.

Criminal penalties are possible.

**OTHER KEY IP RIGHTS**

*Nature of right*

Not applicable for this jurisdiction.

*Legal framework*

Not applicable for this jurisdiction.

*Duration of right*

Not applicable for this jurisdiction.
Ownership / licenses

Not applicable for this jurisdiction.

Remedies for infringement

Not applicable for this jurisdiction.

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

Employees

Unless otherwise agreed, the author's economic rights to a work created by the author in fulfilling his duties arising from the employment or civil service contract with the employer shall be exercised by the employer in his or her own name and on his or her own account (i.e., generally as if owned by the employer, similar to common law "work made for hire" regime). The employer may only assign the exercise of the right pursuant to this paragraph to a third party with the author's consent, unless this occurs when the employer's enterprise or its part is sold as a going concern.

Consultants / contractors

Customary for consultants and contractors to sign written agreements providing license to the other party.

KEY COMMERCIAL CONTRACT CONSIDERATIONS

Registration of commercial agreements

No general registration requirement.

Registration of licenses for intellectual property (other than copyright and trade secrets, which are not registrable) in the respective register is generally possible and it enables to make the licenses enforceable against third parties by such registration.

Recognized language of commercial agreements

Czech law does not set any language requirement. However, commercial agreements should be comprehensible to both parties. Authorities generally require translations to Czech. Most commercial agreements are in Czech. At the same time use of English is very common (typically when one of the parties is a foreign entity or English language template is used to avoid translation costs).

Country-specific issues for online content

Not applicable for this jurisdiction.

Enforceability of online/clickwrap/shrinkwrap terms
Generally viewed as enforceable if conspicuous and users have an opportunity to review and indicate affirmative assent (eg, 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 courts.

Dispute resolution is litigation before state courts, unless agreed otherwise which typically would be an arbitration before an established or ad hoc arbitral tribunal.

**KEY COMMERCIAL CONTRACT TERMS**

**Enforceability of warranty disclaimers**

Disclaimers of statutory warranty are acceptable, unless it is disadvantageous for the weaker party, ie, consumer.

**Enforceability of exclusions/limitations of liability indemnification**

The liability can be excluded or limited, with consent of both parties. This does not apply in respect of liability for damages caused willfully or in gross negligence, liability for interference in natural rights of a human individual (life, health, general personality right) or liability incurred by a weaker party, such as a consumer – none of these can be limited or waived in advance.

**Indemnification**

Express indemnities stated in contracts are recognized and generally respected though relevant case law is lacking.

The "promise of indemnity" set out as a contractual type in the Civil Code includes the element of indemnification (payment of damages) only. In contracts, also the other distinct obligations are often included, ie, defense and holding harmless (indemnifying party responsible for any other liability arising out of the claim) and this contractual arrangement should be considered valid and enforceable.

Caps on liability under indemnification provisions can be enforceable.

**Electronic signatures**

Electronic signatures are regulated by the Act No. 297/2016 Coll. On Services Creating Confidence for Electronic Transactions, which implements the EU Directive No. 910/2014/EC.

An advanced electronic signature (or "qualified electronic signature") is based on a qualified certification issued by an accredited certification services provider. Advanced electronic signature must be accepted by public administration bodies in the Czech Republic as the equivalent of a person’s handwritten signature.

A document (deed) in the electronic form that bears a qualified electronic signature is fully valid and enforceable and complies with all requirements imposed by the Czech Civil Code on the written form of a legal act.
Some Czech scholars believe that the written form is satisfied in case of a plain email, without an advanced or qualified electronic signature, and that such agreements are valid and enforceable. Such scholars note that under Section 562 of the Civil Code, the written form is preserved when an act is made in an electronic form or other technical form enabling (i) capturing the subject matter of the act and (ii) determination of the person acting. However, this position is not generally accepted.

In 2009, Czech authorities introduced the use of a data box for electronic communication between public authorities and individual users (that is, all Czech corporations and all individuals licensed to operate a business activity). A data box is a specific electronic site (uniquely allocated to a respective public authority, individual or corporate entity and password protected), which public authorities must use for delivery of all their communications addressed to those who have their own data boxes, instead of using traditional mail delivery in paper form. Individuals are generally free to decide whether they will send their communications with public authorities using data boxes or by mail/personal filing of paper documents. A document sent through a data box is presumed to be sent by the relevant data box holder and validity and enforceability consequently exist in respect of such communications.

Data boxes are an information system for electronic delivery, allowing for unambiguously identified and authenticated users to deliver a data message including attachments (any digital document) to the recipient and certify that the message has been received and the recipient has read it. The system of data boxes places a great emphasis on the user authentication. This system offers a state-guaranteed secure channel for communication between all users of data boxes, providing far higher quality security than the traditional email communication.
DENMARK

INTELLECTUAL PROPERTY FRAMEWORK

Overview
In general, intellectual property rights are governed by EU regulations and directives as well as by Danish law.

COMMERCIAL CONTRACT FRAMEWORK

Overview
The interpretation and enforceability of commercial contracts are widely governed by principles and practice. The content of the agreement is primarily determined by what has been agreed between the parties. However, there are several acts, including the Contracts Act, the Sale of Goods Act and the Credit Agreement Act, that govern transactions in goods (e.g., buying and selling), security interests, letters of credit and other commercial transactions.

Furthermore, there may be other acts that are relevant to certain commercial arrangements (e.g., antitrust laws) and there may be industry specific regulations applicable to contracts in particular industries.

Mandatory provisions apply in business-to-consumer transactions.

COPYRIGHTS

Nature of right
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.
Besides the actual copyright rights, Danish law protects neighboring rights such as the right to a recording.

Moral rights are recognized.

**Legal framework**

Copyrights are governed by the Danish Act of Copyright (LBK 1144 23/10/2014).

Denmark is a party to several international conventions and treaties such as the Berne Convention, the Rome Convention, the TRIPS Agreement, the WIPO Copyright Treaty and the WIPO Performances and Phonograms Treaty.

**Duration of right**

Copyright protection lasts for the life of the author plus an additional 70 years. For an anonymous work, the copyright lasts for 70 years from the year of its publication or if it has not been published, 70 years from its creation.

In general, the copyright protection of neighboring rights lasts for 50 years but the duration runs from various dates depending on the neighboring right in question.

**Ownership / licenses**

The author owns the work. Joint ownership of copyrights is recognized. The copyright of the author can be transferred via license.

Ideal rights, the right to compensation in relation to commercial transfer of works and the right to compensation in relation to commercial rental of recordings of sound or video, cannot be transferred.

**Remedies for infringement**

Remedies for copyright infringement include equitable and reasonable compensation for use, as well as compensation for losses and further injuries caused by negligent or willful infringement.

It is possible to obtain a court order for destruction of infringing products. An optional initial step is to obtain a preliminary court order for the confiscation of infringing products and equipment used in the manufacture thereof.

Criminal penalties are possible.

**MASK WORKS / TOPOGRAPHIES**

**Nature of right**

The right to semiconductor topographies under Danish law requires that an application be sent to the Danish Patent and Trademark Authority within two years from the day of first commercial exploitation.

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
Semiconductor topographies are protected under the Protection of Topographies for Semiconductor Products Act (LBK 222 26/02/2017).

Duration of right
The right lasts for 10 years from the year following the creation of the right, Section 5(3).

Ownership / licenses
The right is granted to the individual or legal person who submits the application after having created or gained exclusive rights to the semiconductor topography.

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.

It is possible to obtain a court order for destruction of infringing products. An initial step can be to obtain a preliminary court order for the confiscation of infringing products and equipment used in the manufacture thereof.

Criminal penalties are possible.

PATENTS

Nature of right
Statutory right granted consistent with mandate in the Danish Patent Act. The invention has to be new and differ significantly 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.

Utility models can be considered as an alternative to protection of industrial rights.

Legal framework
Patents are governed by the Danish Patent Act (LBK 221 26/02/2017).


Denmark has also signed the Trade Related Aspects of Intellectual Property Rights (TRIPS), the Strasbourg Agreement and the Budapest Treaty.

Regulation (EU) No 1257/2012 on implementing enhanced cooperation in the area of unitary patent protection
makes a type of European patent called the unitary patent possible. The unitary patent is expected to enter into force in the first half of 2019.

**Duration of right**

20 years from filing date of application. Denmark has a "first to file" system.

**Ownership / licenses**

The inventor owns the patent. Joint ownership is permissible and in case of joint ownership, the parties must receive consent of each joint owner to each significant transaction, unless the parties contractually agree to waive the duty to account to other joint owners.

Contractual license and compulsory license can be granted.

**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 obtain a court order for destruction of infringing products. An initial step can be to obtain a preliminary court order for the confiscation of infringing products and equipment used in the manufacture thereof.

Criminal penalties are possible.

**TRADemarks**

**Nature of right**

Trademarks cover any sign capable of being represented appropriately by use of commonly known technology, particularly words, phrases, letters, numbers, figures, illustrations, the shape of goods or of their equipment or packaging and sounds provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

**Legal framework**

Trademarks are governed by:

- The Trademark Act (LBK 223 26/02/2017) based on the EU Directive 2008/95/EC. The Act allows a trademark right to be obtained through registration or use.

- The Act concerning amendment of the Trademark Act and various other Acts and termination of the Act on Standardization Marks (LOV 1533 18/12/2018).

The Regulation only allows a trademark right to be obtained through registration


Denmark signed the Paris Convention in 1894.

Denmark has also signed the Trade Related Aspects of Intellectual Property Rights (TRIPS), the Trademark Law Treaty, the Nice Arrangement and the Madrid Agreement and Protocol.

**Duration of right**

Registered trademarks are in effect for a period of 10 years from the date of application. The registration may be renewed for further periods of 10 years ad infinitum.

Trademarks obtained through use are in effect as long as the trademark is in use.

Registered Community trademarks are in effect for 10 years from the date of application and are renewable indefinitely.

**Ownership / licenses**

Any natural or legal person can apply for and own a trademark or obtain a trademark through use.

Owners may grant an exclusive or non-exclusive license to a registered mark for some or all of the goods or services for which it is registered and for the whole part or part of the country.

Licenses may be registered in the Danish trademark registry or in the European Union Intellectual Property Office EUIPO’s register over European Union trademarks. However, registration of licenses regarding Danish trademarks is not compulsory and does not affect their validity (registration is necessary in relation to EU-trademarks).

**Remedies for infringement**

An interim injunction can be granted.

An equitable remuneration for the use of the mark and further damages can be awarded. The equitable remuneration is usually estimated to a reasonable royalty, and in case of no established license practice, it is based on an estimate. The damages are estimated on the basis of loss of sale, market disruption and internal losses. The assessment of damages is usually based on an estimate and the courts usually estimate a total amount covering both the equitable remuneration and damages.

Compensation for non-economic damages can be awarded.

A fine can be imposed in case of intent or gross negligence, and imprisonment can be sentenced in case of intent and special circumstances.

**TRADE SECRETS**
Nature of right

Trade secrets are defined in the Act on Protection of Trade Secrets (LOV 309 25/04/2018), Section 2. The definition of "trade secrets" is information which is secret by nature, has a market value due to the information being secret and which under the specific circumstances are subject to fair measures imposed by the person(s) controlling the information, to maintain the secrecy.

Trade secrets are not considered intellectual property rights in Danish law.

Legal framework


Duration of right

The duration of a trade secret is for as long as the trade secret meets the definition of a trade secret under the Act on Protection of Trade Secrets.

Ownership / licenses

The company owns its trade secrets.

Remedies for infringement

An interim injunction can be granted.

An equitable remuneration for illegal acquisition, use or passing on of a trade secret can be awarded. The equitable remuneration may be based both on the loss incurred by the owner of the trade secret and on the profit of the offending party.

Compensation for non-economic damages can be awarded.

The damages are intended to compensate for the injury.

Criminal penalties are possible.

OTHER KEY IP RIGHTS

Nature of right

Designs

The appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colors, shape, texture and/or materials of the product itself and/or its ornamentation.
A design must fulfill the requirements of being "new" and having "individual character."

A design is "new" if no identical design has been made available to the public before the date of filing for registration or before the first launch of an unregistered design.

A design has "individual character" if the overall impression that the design produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public prior to the date of filing/or priority date for registered designs or prior to the date the design was made available to the public for unregistered designs. If the design application is filed less than 12 months after the design was first made available to the public, it is still considered new and deemed to have individual character.

**Legal framework**

**Designs**

Designs are governed by:


- European Council Regulation No. 06/2002 12/12/2001 on the Community Design. The Regulation allows Design rights to be obtained through registration or through use, and use in this context means making the design available to the public.

**Duration of right**

**Designs**

Registered designs are in effect for up to 25 years (15 years for spare parts) from the date of filing and must be renewed every 5 years to a maximum of 25 years (15 years for spare parts).

Unregistered EU designs are valid for up to 3 years from the date of first being made available to the public.

**Ownership / licenses**

**Designs**

Any legal or natural person may apply for and own a design or obtain design right through use.

Owners may grant third parties a license to use the registered design.

Licenses may be registered in the Danish Design register and for registered EU designs with the EUIPO. In Denmark registration of licensees is not mandatory but for EU designs the registration is mandatory to obtain validity.

**Remedies for infringement**

**Designs**
Interim injunctions may be granted.

An equitable remuneration may be granted for the unauthorized use of the design and further damages may be granted if the design owner can prove a loss due to less quantities sold, market disturbance or other relevant loss caused by the infringement.

Compensation for non-economic damages can be awarded.

A fine or imprisonment can be ordered by the court in cases of bad faith intent, or gross negligence under more severe circumstances.

**INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT**

*Employees*

Danish Act on Employees’ inventions grants IP-rights to the company as a general rule (LBK 014 24/01/2012).

Danish Copyright Act grants all IP rights to software developed by an employer as part of his or her job to the employer.

*Consultants / contractors*

Consultants and contractors own the intellectual property developed by them, unless they have signed a written agreement saying otherwise.

**KEY COMMERCIAL CONTRACT CONSIDERATIONS**

*Registration of commercial agreements*

There is no general registration requirement for commercial contracts.

Agreements regarding transfer of EU trademarks and designs protected by the EU design regulation need to be registered.

*Recognized language of commercial agreements*

Commercial contracts in a business-to-business transaction are often in English, although Danish is the most common language.

In a business-to-consumer contract, Danish is preferable. In addition, Danish consumer law requires that specific compulsory information is provided in Danish.

*Country-specific issues for online content*

As a main rule, service providers will not be held liable for intellectual property right infringements due to their transmitting, routing or providing of connection to infringing content. However, certain requirements have to be fulfilled.
Service providers can be subject to interim injunctions if they are providing connection to infringing content.

**Enforceability of online/clickwrap/shrinkwrap terms**

Online terms are generally viewed as enforceable if conspicuous and users have an opportunity to review.

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 of E-commerce (227 22/04/2002).

In business-to-consumer relations, specific rules apply.

**Governing law**

The parties have contractual freedom in relation to the choice of law. Governing law and venue for resolution of disputes specified in a commercial contract will generally be accepted and recognized by Danish courts.

In business-to-consumer relations, specific rules may apply.

District courts have jurisdiction over disputes unless an alternative dispute resolution procedure, such as arbitration, is specified in the contract. Arbitration is only enforceable in business-to-consumer relations if the consumer consents after the conflict has arisen.

**KEY COMMERCIAL CONTRACT TERMS**

**Enforceability of warranty disclaimers**

Disclaimers of warranty are usually enforced unless they are unconscionable, unclear or not conspicuous.

Warranty disclaimers against consumers are covered by mandatory provisions to protect the consumer. An unclear contract term must be interpreted in favor of the consumer.

**Enforceability of exclusions/limitations of liability indemnification**

Exclusions and limitations on liability may be enforced, provided there are fair, clear and obvious. In addition, they should often be well-reasoned. In case of gross negligence, exclusions and limitations are usually not accepted.

In agreements with consumers, limitations and exclusions are in most cases contrary to mandatory provisions.

**Indemnification**

Indemnification clauses of contracts are generally enforceable, unless they are unfair.

**Electronic signatures**

It is possible to sign legally binding documents electronically by use of NemID. NemID is a personal digital signature that can be obtained by all people above the age of 15 who have a Danish social security number.
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FINLAND

INTELLECTUAL PROPERTY FRAMEWORK

Overview

The Finnish intellectual property legislation is largely impacted by European Union (EU) directives and regulations. Some of the national legislation has been jointly drafted with other Nordic countries. In addition to specific IPR legislation, the law relating to unfair business practices is also relevant between commercial entities. For cases of deliberate or grossly negligent infringement, criminal law provisions may also apply.

COMMERCIAL CONTRACT FRAMEWORK

Overview

Finnish contract law is based on the principles of freedom of contract and the legal validity of contracts (pacta sunt servanda).

Some of the general principles of Finnish contract law are codified in the Contracts Act, but many of the general principles are not codified. The Contracts Act contains general principles on contracting, validity of contracts and contracting via a representative. Highly biased and unconscionable contracts can be either amended into a more reasonable form or nullified under Section 36 of the Contracts Act. This section is, however, very rarely applied to business entities.

Consumer legislation sets certain mandatory limitations to contracting in B2C environment. The parties cannot agree otherwise in a contract with consumers.

The contracts by entities in dominant position may also be subject to EU competition law scrutiny.

COPYRIGHTS

Nature of right

Copyright protection is given to independent and original literary or artistic works. Copyright is considered to
consist of moral and economical rights to the work, of which the latter can be freely transferred or licensed. Copyrights are not registered. The Copyright Act grants the Copyright holder the exclusive right to reproduce, display, distribute and commercially exploit the work. Limitations apply in regard to this exclusivity, such as the right to use copyrighted works for the purposes of quoting, teaching or parody.

**Legal framework**


Finland has signed the Berne Copyright Convention.

As a member of the European Union, Finland has implemented the following copyright directives:

i. Directive 2017/1564/EU on the use of certain copyright protected work to the benefit of persons who are blind, visually impaired or otherwise print-disabled

ii. Directive 2001/29/EC on the harmonization of certain aspects of copyright and related rights in the information society

iii. Directive 96/9/EC on the legal protection of databases


**Duration of right**

Copyright protection lasts for 70 years after the death of the creator.

For works with a joint copyright, the term of 70 years is calculated from the death of the last surviving creator.

The Copyrights Act also protects neighbouring rights of performing artists, producers, photographers, certain media organizations and databases. Neighbouring right protection also covers those literary or artistic works, which are not original enough to be covered by copyright (eg, generic photographs). In most cases the protection term for neighbouring rights is 50 years from the publication.

**Ownership / licenses**

Copyright is considered to consist of moral and economical rights to the work, of which the latter can be freely transferred or licensed, wholly or partially. Moral rights such as authorship cannot be transferred. Joint ownership of copyrights is recognized.

**Remedies for infringement**

Compensation for copyright infringement includes a reasonable, non-punitive compensation for the use of the copyright, typically calculated on the basis of what an applicable license would have cost. In case of negligence, compensation for other damages may also be awarded. Reasonable legal costs can also be demanded from the infringing party.
Injunction can be granted by a court in infringement cases, as well as destruction of infringing goods. Criminal penalties such as fines and even imprisonment are possible.

The Finnish Copyright Council gives legally non-binding statements on copyright issues upon request. The council opinions are free of charge and available to both companies and individuals.

**MASK WORKS / TOPOGRAPHIES**

**Nature of right**

Topography right is given to an independent and original topography (similar to copyright).

The exclusive right to a topography includes the right to produce integrated circuit or piece of circuit design of the topography, the right to distribute the topography by making it available to the public for sale, hire, lend or otherwise, and to import the topography for purposes of such distribution. As the distribution right is not limited to physical components, the exclusive right includes also the right to distribute the topography via information network.

In practice, very few circuit topographies have been registered in Finland.

**Legal framework**


**Duration of right**

Topographies can be registered for an exclusive term of 10 years.

**Ownership / licenses**

Right to topography can be licensed or transferred. Transferring physical piece(s) of topography does not constitute transfer of the rights to the topography.

**Remedies for infringement**

Compensation for topography infringement includes a reasonable, non-punitive compensation for the use of the topography. In case of negligence, compensation for other damages may also be awarded. Reasonable legal costs can also be demanded from the infringing party.

Injunction can be granted by a court in infringement cases, as well as destruction of infringing goods. Criminal penalties such as fines and even imprisonment are possible.

**PATENTS**
**Nature of right**

Patent protection is offered for inventions that are new and industrially applicable. It is required that the invention significantly differs from what was known at the date of filing.

**Legal framework**

Patents are regulated on both a national and an international level. The Finnish Patents Act and the Finnish Patents Decree govern the national patent system, while the European Patent Convention (EPC) pertains to the protection of European patents. Finland is a signatory of the Patent Cooperation Treaty (PCT) and has ratified the Patent Law Treaty (PLT).

Finland has signed in January 2016 the Agreement on a Unified Patent Court (UPC) which is part of the legislative package aiming to establish the European Patent with Unitary Effect. At the end of 2018, the process of establishing the European Patent with Unitary Effect is still pending. However, the start of the new Unitary Patent system is currently expected for the first half of 2019.

For inventions that do not meet the full criteria of a patenting "petty patents" can be registered as utility models. The registration of utility models is governed by the Act on Utility Model Rights.

The Finnish Penal Code governs also patent infringement crimes.

**Duration of right**

Patents have a duration of 20 years, calculated from the filing date of the application. The patent system in Finland is based on a "first to file" system.

**Ownership / licenses**

Patent rights are granted to the inventor or to the entity to which the inventor has transferred his rights. Patents can be freely transferred or licensed, wholly or partially. Joint ownership is granted for inventions with multiple inventors.

**Remedies for infringement**

Remedies for patent infringement include a reasonable, non-punitive compensation for the use of the patent, typically calculated on the basis of what an applicable license would have cost. In case of negligence, compensation for other damages may also be awarded. Reasonable legal costs can also be demanded from the infringing party. Injunction can be granted by a court in patent infringement cases, as well as the destruction of infringing goods. Criminal penalties such as fines and even imprisonment are possible.

**TRADEMARKS**

**Nature of right**

A trademark can be registered for any sign, which can be represented in a graphical form. Examples of such signs include words and names, designs, the shapes of goods or of their packaging, and in some cases distinctive shades
of colour. In all cases it is required that the sign is original and capable of distinguishing the commercial origin of
the goods or services. The Nice Classification system for goods and services is used in the Finnish trademark
system.

The owner of a trademark has the exclusive right to use the trademark commercially for the duration of the
registration term. In practice, a successful infringement claim requires that a likelihood of confusion can be proven
between the trademark and the infringing mark.

**Legal framework**

The Finnish Trademark Act and the Finnish Trademarks Decree govern the protection of both unregistered and
registered national trademarks. An unregistered trademark is protected only if it can be considered widely known
among the relevant consumer group at which it is directed.

The Finnish Trademark Act is currently under revision and a Government Proposal has been given for the new
amended Trademark Act in October 2018. The objective of the revision is to implement the amendments
required by the EU Trademark Directive 2015/2436. In addition, the objective is the ratification of the Singapore
Treaty on the Laws of Trademarks.

The Finnish Penal Code governs also trademark infringement crimes

The European Council Regulation on the European Community trademark governs the use and registration of
European Community trademarks.

Finland is a member of the Madrid Protocol, Trademark Law Treaty and Singapore Treaty on the Law of
Trademarks as well as a signatory of the Paris Convention, TRIPS Agreement and the Nice Agreement.

**Duration of right**

National trademark registrations are valid for a term of 10 years from the date of registration, after which they
can be renewed indefinitely. Unregistered trademarks receive protection for as long as they can be considered
well-known to the relevant consumers. Registered Community trademarks remain in effect for 10 years from the
date of application and can be renewed indefinitely.

**Ownership / licenses**

Any natural or legal person can register a trademark. The registration owner has the exclusive right to use,
transfer or license the trademark.

**Remedies for infringement**

Remedies for trademark infringement include a reasonable, non-punitive compensation for the use of the
trademark, typically calculated on the basis of what an applicable license would have cost. In case of negligence,
compensation for other damages may also be awarded. Reasonable legal costs can also be demanded from the
infringing party. An injunction can be granted by a court in infringement cases, as well as the destruction of
infringing goods. Criminal penalties such as fines and even imprisonment are possible.
TRADE SECRETS

Nature of right

In Finland, trade secrets are protected under the Trade Secret Act, as well as through criminal law provisions in the Finnish Penal Code on the misappropriation of trade secrets. Employment legislation also includes provisions requiring the employee to refrain from disclosing confidential information of the employer.

Legal framework

Misappropriation of trade secrets or attempting such is forbidden in Sections 3 and 4 of the Trade Secret Act. The Trade Secret Act entered into force in August 2018 and it implements the EU directive on Trade Secrets. The Finnish Penal Code includes provisions on the unauthorized disclosure of a trade secret and trade secret misappropriation.

Duration of right

There is no maximum term for protection. As long as the secret has commercial value, it is not generally known by the public and the holder of the secret has used reasonable measures in order to protect the secret, the secret will be protected by law.

Ownership / licenses

Trade secrets can be licensed or transferred.

Remedies for infringement

In case of an infringement, the owner of the trade secret may proceed by either claiming for damages or injunction based on the Trade Secrets Act, or by filing a criminal claim regarding trade secret misappropriation.

Information regarding trade secrets can be removed from public court documents and the access of public audiences can be limited to public proceedings if it is required for the sake of ensuring secrecy.

OTHER KEY IP RIGHTS

Nature of right

Not applicable.

Legal framework

Not applicable.

Duration of right

Not applicable.
Ownership / licenses

Not applicable.

Remedies for infringement

Not applicable.

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

Employees

The Finnish Copyright Act does not specifically address the issue of IP rights in an employment context, apart from the copyrights to computer programs, which are by default to be considered to be transferred to the employer. Other copyrighted works created by an employee remain the property of the employee, unless otherwise agreed or clearly implied, eg, in case the employee has specifically been hired to create content for the company.

In respect of patentable inventions, the Act of an Employee's Inventions governs the right of an employer to acquire the invention made by the employee, given that the invention has been made as part of the employee's tasks. Employees are entitled to a mandatory, reasonable compensation for such transfer.

According to the Act on the Protection of Semiconductor Topographies, employer has the right to acquire and register the rights to the topography, given that the topography has been made as a part of the employee's tasks and that the parties have not agreed otherwise.

It is common and recommended to include provisions regarding IP rights and confidentiality in employment contracts.

Consultants / contractors

In order for intellectual property ownership to transfer from a consultant to the customer, parties must have specifically agreed to do so. If such transfer of rights has not been agreed, the ownership to the intellectual property will in most cases remain property of the consultant.

It is common and recommended to include provisions regarding IP rights and confidentiality in consultant contracts.

KEY COMMERCIAL CONTRACT CONSIDERATIONS

Registration of commercial agreements

There is no 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 are possible but not required.
Recognized language of commercial agreements

There are generally no language requirements for commercial agreements. Most B2B agreements are drafted in English or Finnish.

Country-specific issues for online content

Not applicable.

Enforceability of online/clickwrap/shrinkwrap terms

In B2B context, online terms are generally considered enforceable, provided that they have been accepted and available to the other party upon contracting. Even a link to applicable online terms may suffice to make them enforceable, provided that the other contracting party has had a sufficient and actual chance to become acquainted with the terms upon contracting and that these online terms do not include surprising and strict terms or conditions. If the online terms include surprising and/or strict terms or conditions, these strict terms or conditions need to be separately specified and informed to the other party.

In the B2C context, several limitations apply due to consumer protection legislation.

Governing law

Clauses regarding choice of jurisdiction are generally considered binding between business parties, even in the case of shrinkwrap online terms.

In the B2C context, however, consumers are always granted access to the local legal system regardless of the governing law specified in the contract.

KEY COMMERCIAL CONTRACT TERMS

Enforceability of warranty disclaimers

In a B2B relationships, warranty disclaimers are enforced, however they do not properly serve as effective limitations of liability for defects. It is therefore recommended that the limitations to the liability of a party in respect of defects are expressed precisely instead of relying on general "no warranty" disclaimers.

Special consumer legislation provisions apply in the B2C context.

Enforceability of exclusions/limitations of liability indemnification

In B2B relationships, exclusions and limitations of liability are common and enforceable. However, exclusions and limitations of liability do not apply if the breach or damage results from gross negligence or willful misconduct. Highly biased and unconscionable exclusions and limitations of liability provisions can be either amended into a more reasonable form or nullified under Section 36 of the Contracts Act. This section is, however, very rarely applied to B2B contracts.

In the B2C context, several limitations apply to enforceability of exclusions and limitations of liability due to
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consumer protection legislation.

**Indemnification**

Indemnification clauses are usually enforceable and relatively common in B2B contracts.

**Electronic signatures**

Electronic signatures are generally considered enforceable and equal to traditional hand-written signatures, provided that they have been made using a sufficiently secure and verified generation device or qualified certificate as stated in the Finnish legislation. As a rule, the generation device or qualified certificate is considered sufficiently secure, if it is in accordance with recognized European Union standards or an EEA located authority appointed for assessing the security requirements has approved it.

The Act on Strong Electronic Identification and Electronic Signatures regulates the requirements and acceptability set for electronic signatures in Finland.

Finnish legislation sets forth certain requirements on strong electronic identification methods (eg, bank identifiers, mobile certificates) that are accepted in public officials and not all international electronic identification services fulfill these requirements. However, multiple private service providers operating within Finland do fulfill the requirements set forth by the applicable legislation.

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FRANCE

INTELLECTUAL PROPERTY FRAMEWORK

Overview

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

Overview

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:

- The French Civil Code, which contains (i) most provisions on contract law, including rules regarding contracts in general (contract formation, validity, term, performance, enforceability, assignment, termination, liability and remedies) and rules regarding specific contracts, eg, sales, statutory warranties, agency, lease, loan, escrow, guarantees; and (ii) provisions on tort liability

- The French Commercial Code, which contains some specific rules applicable in business to business agreements (eg, payment terms, interest for late payment, general terms and conditions, distribution, commercial agency, commissionaire, commercial leases agreements)

- The French Intellectual Property Code, for contract terms relating to intellectual property rights

- The French Consumer Code, which contains important rules that professionals must comply with when dealing with consumers, but which may also have to be taken into account when contracting with another business when the end-user is a consumer or in all cases when contracting with another business (eg, the prohibition of misleading commercial practices is also applicable to business transactions)

- The Judicial Organization Code, which contains rules on the jurisdiction of intellectual property
This list is not exhaustive, and specific provisions may be implicated by certain types of commercial contracts (eg, Transport Code; Law on Subcontracting; Data Protection Law; Law on Confidence in the Digital Economy).

**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 (ie, on paper, in a computer program or in an electronic document) (mere ideas are not protected) and

ii. The work must be original (ie, it must be endowed with the personality of its author)

**Legal framework**


The revised Audiovisual Media Services Directive has entered into force on December 18, 2018 and awaits local transposition. Video-sharing platforms will now be submitted to this regulation.

**Duration of right**

The economic rights of the author last for 70 years after his or her death. The 70 years are calculated from January 1 of the civil year following the death of the author. 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 personal, perpetual, inalienable and not subject to statutes of limitations.

**Ownership / licenses**

There are no formal requirements for copyright protection.

Copyright cannot be registered in France, 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 by the author 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 (eg, right of reproduction, right of representation and communication, adaptation or translation) together with their associated scope and span.

**Remedies for infringement**

The author is entitled to enforce copyright.

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

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

However, as an alternative and by request of the author, the court can set the damages as a lump sum. The lump sum must be greater than the royalties or rights that would have been owed if the infringer had asked for the authorization to exercise the right that has been violated. This amount is not exclusive of compensation for moral harm caused to the author.

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).

Before the criminal courts, an infringer faces a fine of up to €300,000 (or €750,000 in certain circumstances) and imprisonment for up to 3 years (7 years in certain circumstances).

**MASK WORKS / TOPOGRAPHIES**

**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: it must result from its creator’s own intellectual effort and 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 2 years of the first commercial exploitation or more than 15 years after it has been fixed or coded for the first time – in case it has never been exploited.

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


Duration of right

Protection is granted as from the earlier of the following dates: the filing of the application or the first act of commercial exploitation. Protection is granted until the end of the 10th 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

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).

Note that in case of topographies infringement, it is not possible to bring an action before the criminal courts.

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 they will only apply from the date of entry into force of the UPC Agreement).

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 paediatric 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.

There is a right of pre-emption 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 (ie, 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

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.

Before the criminal courts, an infringer faces a fine of up to €300,000 (or €750,000 in certain circumstances) and imprisonment for up to 3 years (7 years in certain circumstances).
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. Law No. 64-1360 on Trademarks and Services Marks, dated December 31, 1964 and Law No. 91-7 on Trademarks and Services Marks, dated January 4, 1991 and Law No. 2014-315 Reinforcing the Fight Against Counterfeiting, dated March 11, 2014


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 10 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 (eg, 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 wilful.

French law prohibits both direct infringement and contributory infringement.

Trademark infringement actions may be brought before specialized courts (Paris courts having exclusive jurisdiction for EUTM’s), 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

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

As an alternative and on request by the trademark owner, the court can set the damages as a lump sum. The lump sum must be greater than the royalties that would have been owed if the infringer had sought a licence. This amount is not exclusive of compensation for moral harm caused to the trademark owner.

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).

Before the criminal courts, an infringer faces a fine of up to €300,000 (or €750,000 in certain circumstances) and imprisonment for up to 3 years (7 years in certain circumstances).

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**

As defined by EU Directive 2016/943 on Trade Secrets of June 8, 2016, 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

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

**Legal framework**
Trade Secrets are governed by the following legal framework:

- Decree No. 2018-1126 on Trade Secrets dated December 11, 2018

It is completed by Article 39 of the TRIPS Agreement.

Article L. 621-1 of the French Intellectual Property Code is specifically related to the disclosure of secret manufacturing processes by directors and/or employees.

**Duration of right**

As long as secrecy is preserved.

**Ownership / licenses**

Ownership and licenses require appropriate identification of the trade secrets at stake.

Articles L. 151-7 et seq of the French Code of Commerce provide exceptions to the trade secret protection (eg, legal obligation to communicate, legal proceedings).

**Remedies for infringement**

Following transposition of the Directive, several remedies for trade secret infringement are available under French law, namely the incurring of the civil liability of the trade secret infringer. The French Commercial Code now contains a series of corrective measures (eg, injunction banning or ordering to cease the use and or disclosure of trade secrets), provisional and protective measures, publication measures and compensation. Those measures can be sought by way of an action on merits or by way of a summary action, namely in case of imminent infringement.

Remedies may include banning the manufacturing, marketing and/or use of the goods which significantly result from a trade secret infringement or the import, export or storage of such products, as well as the partial or total destruction of any document, object or file containing the infringed trade secret.

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

- The negative or detrimental economic consequences of infringement, including lost gains and losses suffered by the trade secret holder, inclusive of loss of opportunity
- The moral harm suffered by the trade secret holder
- 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 trade secret holder, French courts may set the damages as a lump sum. This amount is not exclusive of compensation for moral harm caused to the rights holder.

In case of dilatory or abusive actions, French courts can order the trade secret holder to pay a civil fine and/or even be liable for damages for dilatory or abusive actions.

**OTHER KEY IP RIGHTS**

**Nature of right**

**Registered designs**

An industrial design is the ornamental or aesthetic aspect of an article. The design can consist of three-dimensional features, such as the shape or surface of an article, or of two-dimensional features, such as patterns, lines or colours.

To be protected, an industrial design must be non-functional.

The design must not consist of features solely determined by the object's technical function. This means that an industrial design is primarily of an aesthetic nature and any technical features of the article to which it is applied are not protected.

In order to be able to register a design, the design must:

- be new if no identical design is known to have existed before. Designs must be considered to be identical if their features differ only in immaterial details

- have an "individual character" if the overall visual impression it produces on the informed observer differs from that produced by any design or model disclosed before the date of the filing of the application for registration or before the date of priority claimed.

**Databases**

A database is defined as a collection of independent works, data or other materials arranged in a systematic or methodical way and individually accessible by electronic or other means.

Databases can be protected through copyright and/or a *sui generis* right.

Additionally, copyright protection may be awarded to the structure of a database if fulfilling the criteria for such copyright protection (fixation in a material form and originality).

*Sui generis* rights apply to the benefit of the database producer is there were qualitatively and/or quantitatively substantial investments, whether related to the collection, verification or presentation of the content of the database.

The *sui generis* protection lies on an economic vision and does not include moral rights.

**Legal framework**
Registered designs

Registered designs are governed by Part V of the French Intellectual Property Code.

Databases

Databases are governed by:

- Articles L. 111-1 et seq. and R. 111-1 et seq. for copyright protection
- Part V of the French Intellectual Property Code (Articles L. 341-1 et seq. and R. 341-1 et seq.) for the sui generis protection, which implements the EU Directive 96/9/EC of March 11, 1996 in France

Duration of right

Registered designs

A registered French design can be protected for a maximum of 25 years. The initial term of protection is five years, which can be renewed by 4 consecutive 5-year periods.

Databases

For the duration of copyright, when applicable, see the Copyrights section.

The sui generis protection is granted for 15 years, starting from the date of completion of the database. It expires 15 years following the first of January of the year following the date of completion of the database.

If the database is made available to the public within this 15-year time period, protection runs until 15 years following the first of January of the year following the date of publication.

If the database is subject to new substantive investment, then in that case the 15-year period of protection starts following the first of January of the year following the date of this new investment.

Ownership / licenses

Registered designs

The protection of the design is acquired by the registration of the owner.

The author of the application for registration is, unless proven otherwise, regard as the beneficiary of this protection.

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

Databases

There are no formal requirements for sui generis protection.

Under the sui generis protection, a database producer, ie, a natural person or a legal entity initiating and supporting
the investment, is free to transfer or license any and all of its rights under the database to a third party.

**Remedies for infringement**

**Registered designs**

A design infringement lawsuit can be brought by the recorded owner of the registered design whose rights have been infringed, or by the exclusive licensee duly recorded with the INPI, before either the criminal or civil courts.

The unauthorized use of a registered design constitutes infringement.

In assessing infringement, the French courts take into account the overall visual impression that the design created for the informed observer, setting aside insignificant differences.

French courts take the following into consideration when determining the amount of compensatory damages to award:

- The negative or detrimental economic consequences of infringement, including lost gains and losses suffered by the rights holder
- The moral harm suffered by the rights holder
- The profits earned by the infringer, including intellectual, tangible and promotional investments saved or not incurred by the infringer.

As for patents and trademarks, as an alternative and on request of the registered design owner, the court can set the damages as a lump sum. The lump 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 registered design owner.

Before the criminal courts, an infringer faces a fine of up to €300,000 (or €750,000 in certain circumstances) and imprisonment for up to 3 years (7 years in certain circumstances).

**Databases**

For Copyright-grounded remedies, see the [Copyrights section](#).

Under the sui generis protection, the database producer can prevent extraction and/or re-utilization of the whole or of a substantial part of the database, evaluated qualitatively and/or quantitatively, of the content of that database. The database maker can also prevent repeated and systematic extraction or re-utilization of non-substantial parts of the database, when such operations exceed the normal conditions of use of the database.

Before the criminal court, an infringer faces a fine of up to €300,000 (or €750,000 in certain circumstances) and imprisonment for up to 3 years (7 years in certain circumstances).

**INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT**

**Employees**
There is no work for hire under French law, except for copyright on software and related documentation, and patents, to a certain extent and provided that certain conditions be met.

For a work made by an employee within the course of his or her 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 a 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), 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 (ie, 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 (eg, 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 indemnification**

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, provided that the limitation liability clause does not empty the essential obligation from its substance. Indemnification clauses are generally...
unenforceable against consumers, provided that such clause is not considered as unfair pursuant to consumer law provisions and does not create significant imbalance between the rights and obligations of the parties for standard, non-negotiated contracts.

Electronic signatures

Under French law, an electronic signature has the same status as the handwritten signature provided that the technology utilized contains reliable means of identification and guarantees the link between the electronic signature and the act to which it is attached.

The reliability of this means shall be presumed when an electronic signature is created, when the identity of the signatory is assured and when the integrity of the act is guaranteed, under the conditions laid down by decree. This is a rebuttable presumption. The French decree 2001-272 dated March 30, 2001 defines three conditions of reliability:

- A secure electronic signature
- Created by a secure signature creation device
- The signature verification shall be based on the use of a qualified electronic certificate

The choice of an electronic signature solution shall therefore take into consideration both technical and legal aspects of the relevant jurisdictions.

The European Parliament and the Council adopted Regulation (EU) No. 910/2014 on electronic identification and trust services for electronic transactions in the internal market (eIDAS Regulation) on July 23, 2014. This eIDAS Regulation – which creates a directly applicable and comprehensive legal framework for both electronic identification and authentication services – is in force since July 1, 2016. It abrogates and replaces the former directive on E-Signature, dated 1993, which had been the basis for the construction of the French law on electronic signature, via a complex set of legal texts.

In terms of inputs, the Regulation notably introduces a distinction between three types of signatures: "basic/standard", "advanced" and "qualified" signature. Clarification is however still expected as to the interrelation of these new types of signature with the pre-existing French definition of e-signature.
GERMANY

INTELLECTUAL PROPERTY FRAMEWORK

Overview

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

Overview

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 (eg, Copyright Act, Patent Act, Utility Model Act) contain further provisions on licensing agreements.

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, the right to recognition of authorship and the right to prohibit the distortion or any other derogatory of his work, as well as exploitation rights, which include the right of 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).

**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 (exploitation right). An exploitation right may be granted as a non-exclusive right or as an exclusive right. A transfer or termination of an exploitation right does not affect the effectiveness of a thereof derived exploitation right. In joint ownership, exploitation rights may be granted only with the consent of other rights holders.

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 or the lost profit of the copyright owner. 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. In order to calculate damages, the rights holder can ask for rendering of accounts.

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

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

**MASK WORKS / TOPOGRAPHIES**

*Nature of right*

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.

*Legal framework*

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

*Duration of right*

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 / 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 be granted only with the consent of other rights holders.

*Remedies for infringement*

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, the rights holder can ask for a rendering of 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:

- As a patent which is examined by the German Patent and Trademark Office or the European Patent Office before grant

- As a utility model that is not specifically examined before registration

Irrespective of whether the patent is filed with the German Patent and Trademark Office or the European Patent Office, the patent is handled as a national patent and therefore only grants protection for Germany (if Germany is one of the designated contracting states of the respective European patent). The same teaching can only be claimed in one patent, since "double patenting" of the same teaching is permitted.

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*


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, the rights holder can ask for a rendering of accounts.

Rights holders or exclusive licensees may make a claim for recall 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 amongst others 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 Union Trademarks exist in parallel. Union Trademarks must be registered with the European Intellectual Property Office (EUIPO, formerly 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) governs national trademarks and Union Trademark Regulation
governs Union 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 additional ten year periods (by paying the renewal fee) indefinitely.

**Ownership / licenses**

Ownership can be transferred by contractual agreement. Joint ownership is possible. A transfer of ownership does generally 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 situations, licenses may generally only be granted with the consent of the other co-owners. Licenses may be granted for a certain part of the registered goods or services or, in case of Union Trademarks, 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, the rights holder can ask for a rendering of accounts.

Besides that, rights holder or exclusive licensee may make a claim for recall and destruction of infringing products. Customs seizure is available to stop import into 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**

Trade Secrets do not enjoy the same protection as IP rights. Their legal nature is unclear, and protection is only granted against unlawful acquisition, use or disclosure. Trade secrets are therefore not protected for their content as such, but only against an "unfair" manner of obtaining them.

**Legal framework**

Germany was under an obligation to implement the European Directive (EU) 2016/943 on the protection of undisclosed know-how and business information (trade secrets) against their unlawful acquisition, use and disclosure (Trade Secret Directive) by July 2018. As of the date of this guide, this has not been done, but only a
draft act on trade secrets was published, which is closely oriented at the Trade Secret Directive and which is expected to be passed as a law in mid-2019. Until then, the current legislation must be interpreted to be compliant with the Trade Secret Directive.

Most importantly, the definition of "trade secret" from the Trade Secret Directive (and the draft act) is to be applied. According to this, "trade secret" means any information which meets all of the following requirements:

- It 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

- It has commercial value because it is secret

- It has been subject to reasonable steps under the circumstances, by the person lawfully in control of the information, to keep it secret

As the definition of the Directive holds some changes compared to the definition worked out by the German judicial practice in the past, trade secret owners need to account for these changes. Especially, it is now mandatory to have adequate protection measures in place (which was not required previously under German law). Trade secrets can include, for example, business plans, price calculations, financial information, investment plans, business strategies, customer lists and similar information.

Trade secrets are protected against their unfair acquisition, use and disclosure. Such is considered unfair especially where access has been obtained unlawfully; documents, data or materials have been copied without authorization, or where acts against honest commercial practice have been committed. Independent developments, such as through reverse engineering, are not unlawful.

**Duration of right**

Information is protectable as a trade secret as long as the information qualifies as trade secret, i.e., especially as long as it is not commonly known.

**Ownership / licenses**

A trade secret owner is any natural or legal person that is lawfully controlling a trade secret. Joint ownership is possible.

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

**Remedies for infringement**

Remedies foreseen by the draft act include injunction and damage claims. Damage claims may – similar to most other IP Rights in Germany – be calculated as adequate license fees, infringer’s profits or lost profits of the rights holder. In order to calculate damages, the rights holder can ask for a rendering of accounts.

Besides that, trade secret owners may make a claim for recall and destruction of "infringing products," i.e., of goods which significantly benefits from trade secrets unlawfully acquired, used or disclosed.
Statutory costs for legal prosecution (court costs and attorney fees) are recoverable up to a cap established by the German law.

Beside the consequences under civil law, the unlawful acquisition, use or disclosure of a trade secret might incur criminal liability.

**OTHER KEY IP RIGHTS**

*Nature of right*

Not applicable for this jurisdiction.

*Legal framework*

Not applicable for this jurisdiction.

*Duration of right*

Not applicable for this jurisdiction.

*Ownership / licenses*

Not applicable for this jurisdiction.

*Remedies for infringement*

Not applicable for this jurisdiction.

**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 in general that by virtue of the employment contract, the employer is implicitly granted sufficient and exclusive exploitation of work of the expressly delegated tasks. However, the scope of such right of use is always limited by the purpose of the employment agreement. Thus, it can also not be excluded that the employer’s right of use might terminate as soon as the employment agreement is terminated. Therefore, 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 models made by employees. Employees are required to immediately notify their employers of any job-related inventions in writing. The employer may claim ownership of such invention within four months of the notification date. Until a law reform in 2009, the employer had to actively claim the invention during this four-months-period, otherwise it remained with the employee. However, as a result of the reform, the employer is now deemed to have claimed the invention, unless it specifically releases the invention to the employee in writing within four months of the notification. If the employer claims an 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.

Furthermore, the Act on Inventions of Employees provides for an obligation of the employee to inform the employer of any other inventions made during the employment relationship but which are not job-related. Prior to any other exploitation of such an invention in relation to third parties, the employee is also obligated to offer the employer at least a non-exclusive right of use under reasonable conditions.

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 concluded in any language that both parties understand. The recognized language basically depends on the language used by the contracting parties prior to the conclusion of the contract. In particular towards consumers, companies may specify the applicable language before conclusion of the contract. If for example information on the company homepage in relation to products/services was displayed in German, the contract with the consumer (including related terms and conditions) must also be in German.

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

The incorporation of online and click-wrap general terms and conditions into a contract is generally possible. However, it is debated whether shrink-wrap terms and conditions can validly be incorporated. It seems to be quite clear that the purchaser does not have an opportunity to take note of the contract text and the terms before the contract is concluded and the protective cover is opened.
**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) in case of disputes before the courts within the European Union sets out the principles relating to law applicable in the absence of choice of law of the parties. As a general rule, as regards consumers, contracts are governed by the law of the country where the consumer has his/her habitual residence if the business party pursues its commercial or professional activities in that country or where the business party directs such activities to and the relevant contract falls within the scope of such activities.

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. In case of consumer contracts such a choice may not, however, have the result of depriving the consumer of the protection afforded to him by provisions that cannot be derogated from by agreement by virtue of the law which, in the absence of choice, would have been applicable (Art. 6 ROME I Regulation).

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 if individually negotiated. The Civil Code contains restrictions on enforceability for certain circumstances (e.g., damages caused by intent). Further and quite extensive limitations apply in general terms and conditions (B2C and B2B), as well as generally in contracts involving consumers.

**Enforceability of exclusions/limitations of liability indemnification**

As a general rule, limitations on liability can be enforced to a broad extent if individually negotiated (unless damages are due to willful intent). The ability to validly limit liability in general terms in conditions is, however, very restricted (B2C and B2B).

Damage claims under (unrestricted) statutory law generally include indirect and even unforeseeable damages. Thus, it is – at least in individually negotiated contracts – quite usual to agree on a liability cap caused by slight and gross negligence. Claims directly based on the specific Product Liability Act (Produkthaftungsgesetz) cannot be excluded or restricted.

**Indemnification**

While the obligation to indemnify is generally part of the damage claim (claims by third parties as damage), parties may agree on specific indemnification provisions, e.g., for breach of IP rights. Restrictions apply in general terms and conditions, for example an indemnification regardless of fault, will generally be invalid.
Electronic signatures

As a general rule, electronic signatures are legal, admissible and enforceable under German law. There are no formal requirements for a contract to be valid, unless explicitly mandated by law or agreed between the parties. If written form is prescribed by law, the document must be signed by the issuer with his handwritten signature pursuant to section 126 of the German Civil Code (Bürgerliches Gesetzbuch, BGB). The written form may be replaced by electronic form, unless the law explicitly requires the written form (see section 126 (3) BGB). If the written form shall be replaced by electronic form, the issuer must add his name to such declaration and provide the electronic document with a qualified electronic signature (QES) in accordance with the Regulation (EU) No. 910/2014 of 23 July 2014 on electronic identification and trust services for electronic transactions in the internal market (eIDAS Regulation) and the German Act on Trust Services (Vertrauensdienstegesetz, VDG). Thus, the QES is a specific category of electronic signatures that have a specific legal effect in accordance with European electronic signature rules. In fact, the eIDAS Regulation, which has repealed the former Directive 1999/93/EC and, as a regulation, is directly applicable in all Member States, mainly differentiates between two forms of electronic signatures: the advanced electronic signature and the QES, subject to stricter legal requirements and highest technical security standards. Article 25 (2) of the eIDAS Regulation explicitly states that a QES shall have the equivalent legal effect of a handwritten signature whereas this is not the case for advanced electronic signatures. Furthermore, according to section 371a (1) of the German Code of Civil Procedure (Zivilprozessordnung, ZPO) private electronic documents that are provided with a QES dispose of the same probative value in legal proceedings as private documents.

To become QES, electronic signatures require qualified certificates that are created by specifically certified devices (so-called qualified electronic signature creation devices) that need to be certified by appropriate public or private bodies (qualified trust service providers).

However, when German law does not impose the written form or any other specific form of signature, any type of signature can be used, ie, even a simple electronic signature as regularly used in business e-mail correspondence.

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HONG KONG

INTELLECTUAL PROPERTY FRAMEWORK

Overview

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

Overview

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.

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 the 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.

Ownership / 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 / TOPOGRAPHIES

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 (referred to below) 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 or her layout-design (topography) without his or her 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 10 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 - 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.

In 2016, the Hong Kong Legislative Council passed the Patents (Amendment) Bill 2015 (which has been enacted as the Patents (Amendment) Ordinance 2016) to amend existing patent legislation in Hong Kong. A new "original grant" patent (OGP) system for standard patents will be introduced, while retaining the current "re-registration" system. Applicants will be able to file applications for standard patents without first obtaining a patent in a designated patent office outside Hong Kong. Further amendments include introducing substantive examination for short-term patents, increasing the maximum number of independent claims allowed in an application and introducing regulatory measures for patent agencies. The revised patent system is expected to enter into force in 2018.
**Duration of right**

The duration of protection is 20 years for a standard patent; and 8 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 or her 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. Following a consultation which ended in February 2015, the Intellectual Property Department proposed a roadmap in February 2017 for implementing the Madrid System in Hong Kong through the Madrid Protocol. Changes to the Trade Marks Ordinance and its subsidiary legislation will have to be made for the Madrid System, which is expected to be fully implemented in Hong Kong in 2022.

**Duration of right**

The duration of protection is 10 years from the date of registration and renewable for an additional 10-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 trademark 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.

Trade secrets and undisclosed commercial information protection last until the information becomes public
knowledge. However, there is no exclusive right for the owner of trade secrets. Competitors are free to
independently invent an identical product or exploit the same ideas.

In an employment contract, in the absence of express terms, there will generally be an implied term that an
employee should not disclose or use to the detriment of the employer any information obtained in confidence in
the course of or by reason of his or her employment.

**Duration of right**

Trade secrets can be protected as long as they remain confidential, potentially in perpetuity.

**Ownership / licenses**

A plaintiff who asserts that he or she is the owner of trade secrets shall have to prove the same on a balance of
probabilities. To be protected by the common law, the owner has to show that the release of trade secrets and
undisclosed commercial information would be detrimental to the owner or advantageous to his or her
competitors or others.
As trade secrets are a species of property, joint ownership and grant of license are permissible. It is common to see licenses of trade secrets, typically in conjunction with licenses of patent rights.

**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.

**OTHER KEY IP RIGHTS**

**Nature of right**

Not applicable for this jurisdiction.

**Legal framework**

Not applicable for this jurisdiction.

**Duration of right**

Not applicable for this jurisdiction.

**Ownership / licenses**

Not applicable for this jurisdiction.

**Remedies for infringement**

Not applicable for this jurisdiction.

**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 employer's and 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 registerable. 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 usual language for commercial contracts. Consumer-facing agreements and terms are often provided in dual language (English and Traditional Chinese).

**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.

**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 (eg, 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 indemnification

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.

Electronic signatures
Electronic signatures are, in most circumstances, recognized and enforceable in Hong Kong. The Electronic Transactions Ordinance (Cap. 553) recognizes the validity of contracts which have been concluded electronically, with some exceptions (such as wills, negotiable instruments and contracts relating to land). Where a signature is required under law, as long as the method used is reliable and appropriate, and provided the parties agree to concluding the contract electronically, then a contract concluded electronically will have the same effect as a contract signed by hand. There are specific restrictions for contracts being entered into with government entities.

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INTELLECTUAL PROPERTY FRAMEWORK

Overview

Intellectual property rights are governed by individual state acts. In questions not specified by these acts, the Hungarian Civil Code (Act 5 of 2013 of the Hungarian Civil Code) is applicable.

Since Hungary is a member of the European Union, each intellectual property act shall be in line with the respective EU directives and regulations. In addition, certain EU regulations apply directly.

COMMERICAL CONTRACT FRAMEWORK

Overview

General contract law and the rules governing specific commercial contracts are set forth in the Hungarian Civil Code.

In general, the parties may freely agree on the contract terms and they are free to define the content of a contract.

The Civil Code sets out general rules (eg, for termination of a contract and rules for the event of breach of a contract) that are applicable for a contract if the parties do not agree otherwise.

Among the provisions on special contracts, the Civil Code regulates the following main commercial contract types: transfer of property (eg, buying and selling), contracts for professional services (including research contracts), commission contracts, lease agreements, deposit contracts, distribution and franchise agreements, credit and account agreements, security (guarantee) agreements, insurance agreements.

The acts on intellectual property rights lay down particular provisions on license agreements concerning artworks, trademarks, patents and designs.

There are special provisions with respect to contracts concluded by electronic means in Act 108 of 2001 on Electronic Commerce and on Information Society Services. For instance, the party using general terms and
conditions and providing for an electronic way for concluding the contracts must make its general terms and conditions available in a way that the other party will be able to store and open them anytime.

The Government Regulation No. 45/2014 (II. 26.) contains provisions on the particular rules of contracts with consumers. This regulation also sets forth the rules on contracts between distant parties.

COPYRIGHTS

Nature of right

All literary, scientific and artistic work are entitled to copyright protection on the basis of its individual and original character deriving from the intellectual creating activity of the author.

Copyright protection arises automatically and no application or registration is needed. Registration is only optional and serves as proof for authorship in possible contentious cases.

The copyright owner is entitled to moral and economic rights. The economic rights of the copyright holder include the exclusive right to use (e.g., reproduce, distribute, communicate to the public, broadcast, exhibit, perform) and to authorize others to use his work, or part of it in any material or non-material form.

Under the moral rights of the author, the author is entitled to the right of first publication, the indication of his/her name on the work as the author of the work. The author also has a right for the protection of the integrity of the work.

Legal framework

Act 76 of 1999 on Copyright. Hungary became signatory to Berne Convention in 1922. Today the version of 1971 of the Convention is implemented. As a member of the EU, Hungary has implemented several directives into its Copyright Act.

Duration of right

Copyright generally lasts during the life of the author and for 70 years after the date of death of the author. The duration of protection for related rights is usually 50 years, although in certain works (e.g., sound recordings) the term lasts for 70 years.

Ownership / licenses

According to the Hungarian Copyright Act, a work protected by copyright may have several authors. There are three categories for joint works:

- Joint works (when the parts of such work cannot be used independently)
- Connected works (if the parts of a joint work can be used independently)
- Jointly created works (the right holder of such work is a natural person or legal entity who initiated and coordinated the creative process of a work where the authors’ contribution to the work and their rights
respectively cannot be separated from each other)

**Remedies for infringement**

No prior registration required whatsoever for recourse to remedies in the event of copyright infringement.

The Copyright Act contains specific remedies – eg, the following can be requested from the court: establishing the infringement, claim for cease and desist, amendment declaration, providing information on the infringement, termination of the injurious situation and restoration of the situation preceding the infringement, and among others confiscating or destroying the products affected by the infringement and also the tools and materials used for the infringement.

In regards to financial remedies, compensation for damages according to the civil law and restitution of the economic gains achieved through the infringement can be requested. According to the actual court practice the minimum of the economic gains achieved with the infringement is the amount of the unpaid royalty.

Attorneys’ fees of the copyright holder in a copyright infringement suit are recoverable although the court has the power to reduce such fees.

It is also possible to prevent importation and distribution of goods that are infringing.

Injunctive relief is also a possible remedy that can be requested before initiating a lawsuit. Ex parte injunctive relief can also be requested.

Criminal penalties available.

**MASK WORKS / TOPOGRAPHIES**

**Nature of right**

Microelectronic semiconductor topographies qualify for legal protection if they are original.

A topography is original if it is a result of an independent and intellectual creative effort and at the time of its creation it is not a commonplace in the industry. A topography consisting of standard elements may be registered if the combination of such elements is original.

A registration is required.

A topography shall mean the three dimensional combination in any form of the elements (of which at least one is active), and connections or parts thereof of a microelectronic semiconductor product, or such a three dimensional combination created for a semiconductor product to be manufactured.

The right owners have the exclusive right to exploit the topography and to authorize the exploitation thereof. Exploitation shall mean the reproduction, importation and distribution of the topography for commercial purposes.

The moral rights of the right holder are stipulated in the Hungarian Patent Act (see Patents).
Legal framework


Duration of right

The protection lasts for 10 years either from the first day of commercial exploitation anywhere in the world or from the day of filing the application for registration with the competent authority.

Must register within 2 years of first commercial exploitation.

Ownership / licenses

If the topography was created by several persons, they shall be entitled to the protection jointly.

Remedies for infringement

In the event of infringement the remedies set forth in the Hungarian Patent Act (see Patents) can be exercised.

PATENTS

Nature of right

An invention is patentable if it is capable of industrial application, is new and involves an inventive step. An invention is new if it does not pertain to the state of technical knowledge. An inventive step shall mean an activity that is nonobvious to an expert in the view of the state of technical knowledge. An invention is deemed susceptible of industrial application if it can be produced or used in any branch of industry or agriculture.

Registration is required. Patent protection commences upon publication of the application, with retroactive effect to the date of application.

The patent holder has the exclusive right to exploit the invention. In the frame of this, the patent holder may prohibit, among others:

- To manufacture, use, distribute, offer to distribute, store, or import the patented product
- To use the patented method, or to offer it for use
- To manufacture, use, distribute, offer to distribute, store, import, the product created with the patented method

In relation to the moral rights, the inventor has the exclusive right to publish its invention before the filing of the patent application. The inventor is also entitled to be informed of the invention’s documentation as the inventor thereof.

Legal framework
Act 33 of 1995 on the Patent Protection of Inventions. The relevant EU directives have been duly implemented.

**Duration of right**

The term of the definitive patent protection shall be 20 years from the date of application. A yearly renewal fee shall be paid.

**Ownership / licenses**

The right to a patent belongs to the inventor or his legal successor.

If two or more persons have jointly created an invention, the respective share of authorship of the inventors shall be deemed equal, failing any indication originally filed in the patent application to the contrary.

If two or more persons have jointly created an invention, entitlement for patent protection shall be vested jointly in them or their respective successors in title. Where entitlement is vested in two or more persons, their respective share in patent rights shall be deemed equal, failing any indication to the contrary.

If the patent has more than one owner, each co-owner may freely dispose of his or her own share. In respect of the share of any co-owner the other co-owners shall have pre-emption right vis-á-vis third persons.

The patent may be exploited by any of the co-owners individually, however, they must pay appropriate royalties to the other co-owners in proportion to their respective shares.

**Remedies for infringement**

Article 35 of the Patent Act contains special remedies, eg, the following can be requested from the court: establishing the infringement, claim for cease and desist, amendment declaration by the infringer, providing information on the infringement, among others confiscating or destroying the products affected by the infringement.

In regards to financial remedies, compensation for damages according to the civil law and restitution of the economic gains achieved through the infringement can be requested. According to the court practice the amount of such economic gain can be equal to the unpaid license fee, or with the net income (after the deduction of the costs) achieved through the infringement. In each case, the proportion of the patented part within the infringing product shall be taken into account.

Attorneys’ fees can be recovered, although the court has the power to reduce such fees, should they be excessive.

Injunctive relief is also a possible remedy even before initiating a lawsuit. Ex parte injunctive relief can be requested as well.

**TRADEMARKS**

**Nature of right**

Any sign that (i) can be represented in a way that the subject of the trademark can be precisely defined, and (ii) is
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capable of distinguishing goods or services from goods or services of others can be registered as a trademark.

Trademark protection grants exclusive right for the trademark owner to use the trademark.

On the basis of this exclusive right of use, the owner may initiate proceedings against any party who, without his or her consent, uses in its business operations in connection with goods or services:

- A sign identical to the trademark in connection with goods and services which are identical to those specified in the specification of goods for which the trademark is registered

- Any sign that consumers may confuse with the trademark due to the identity or similarity of the sign and the trademark, or due to the identity or similarity of the goods or services in question

- Any sign identical or similar to the trademark, regardless of whether the goods or services that are listed in the specification of goods for which the trademark is registered are identical or not with the goods or services in connection to which the sign is used, to the extent that such trademark has a good reputation in the domestic market and the use of the sign without due cause would be detrimental to or unfairly exploit the trademark’s distinctive character or reputation

Legal framework


As a result of its membership of the European Union, the following law applies in Hungary:

i. The Trademark Directive

Duration of right

Ten years, renewable for successive periods of ten years.

Ownership / licenses

Any and all legal or natural persons are entitled to obtain trademark protection irrespective of whether they carry out business activity. It is also possible to obtain trademark protection jointly.

In case more persons apply for the application of a trademark jointly, the trademark protection belongs to them – unless otherwise indicated – in equal proportions.

In case more persons are entitled to a trademark, they are entitled to dispose over their portion individually. Co-owners are entitled to pre-emption rights regarding the portion of another party towards third persons.

Remedies for infringement

Article 27 of the Trademark Act contains special remedies, eg, the following can be requested from the court: establishing the infringement, claim for cease and desist, amendment declaration, providing information on the infringement, and among others confiscating or destroying the products affected by the infringement and also the tools and materials used for the infringement.
In regards to financial remedies, compensation for damages according to the civil law and restitution of the economic gains achieved through the infringement can be requested.

Attorneys’ fees can be recovered, although the court has the power to reduce such fees, should they be excessive.

Injunctive relief is also a possible remedy even before initiating a lawsuit. Ex parte injunctive relief can be also requested.

**TRADE SECRETS**

*Nature of right*

As a general rule, Act LIV of 2018 on the Protection of Trade Secrets provides protection for the trade secret that is being exchanged during the execution of an agreement, in case the parties fail to agree on such a provision of confidentiality themselves.

Trade secrets include any confidential fact, information and other data, or a compilation thereof, connected to economic activities, which are not publicly known in whole or in the complexity of its elements, or which are not easily accessible to other operators pursuing the same economic activities, where the proprietor of the secret has taken reasonable efforts that may be expected in the given circumstances to keep such information confidential.

*Legal framework*

Act LIV of 2018 on the Protection of Trade Secrets.

Act 100 of 2012 on the Criminal Code.

*Duration of right*

Potentially perpetual, as long as it does not become part of the public domain.

*Ownership / licenses*

No special provisions applicable. Joint ownership is possible.

*Remedies for infringement*

According to Hungarian law it is a criminal offense if a person illegally acquires, uses, or discloses a business secret for financial gain or advantage, or makes it available to others or publishes such information, causing pecuniary injury to others.

Act LIV of 2018 on the Protection of Trade Secrets also contains special remedies, eg, a person whose trade secrets have been violated, among others, shall have the right to demand:

- A court ruling establishing that there has been an infringement of rights
- The cessation of or the prohibition of the use or disclosure of the trade secret
• Destruction of the infringing goods or their withdrawal from the market

• The termination of the injurious situation and the restoration of the previous state

• Restitution of the economic gains achieved through infringement

In the event of infringement of the right to trade secrecy, the proprietor of the trade secret may also demand compensation in accordance with the provisions of civil liability.

It is also common in Hungary to include a chapter into the contracts stipulating a confidentiality agreement, which would set out the amount of compensation (penalty) the breaching party has to pay in case of violation.

**OTHER KEY IP RIGHTS**

**Nature of right**

Not applicable for this jurisdiction.

**Legal framework**

Not applicable for this jurisdiction.

**Duration of right**

Not applicable for this jurisdiction.

**Ownership / licenses**

Not applicable for this jurisdiction.

**Remedies for infringement**

Not applicable for this jurisdiction.

**INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT**

**Employees**

All acts related to intellectual property (Patent Protection Act, Copyright Act, etc.) regulate generally when a work is made in the frame of an employment relationship.

Under the Copyright Act, the employer, as the legal successor of the author, automatically obtains economic rights once a work is handed over, if the preparation of the work was the author’s obligation within the scope of his/her employment, in the absence of any agreement to the contrary ("work for hire" doctrine).

The Patent Protection Act distinguishes the "service invention" and "invention of employee." "Service invention"
means any invention created by a person in the execution of his duties stemming from employment that includes to work out solutions within the domain of the invention. “Employee invention” means any invention created by a person who is not required to do so under his contract of employment, however, the exploitation of such invention falls within the sphere of activities of his employer.

In case of service inventions, patent rights shall be vested in the employer, as the inventor's successor in title. In case of employee inventions, patent rights shall be vested in the inventor; the employer, however, is entitled to exploit the invention. The employer's right of exploitation is non-exclusive; the employer shall not grant a license of exploitation. Special rules apply to the consideration to be paid to the employees for service inventions and employee inventions.

**Consultants / contractors**

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. Please note that under Hungarian copyright laws – as a main rule (with software and films being the main exceptions) – only a license can be acquired from the author, and the copyright itself cannot be transferred in its entirety.

**KEY COMMERCIAL CONTRACT CONSIDERATIONS**

**Registration of commercial agreements**

No general registration required.

Registration of licenses for patents, trademarks and designs are possible but not obligatory.

**Recognized language of commercial agreements**

There is no limitation in connection with the language of license agreements. Both parties shall be aware of the language of such agreements. If, however, the signatory of a contract does not speak the language in which the contract is executed, the contract might be null and void.

**Country-specific issues for online content**

There are special provisions on the liability of intermediary service providers for the transmitted illegal content. In given circumstances they shall not be liable. This in many cases includes complying with notice and takedown requests from rights holders.

**Enforceability of online/clickwrap/shrinkwrap terms**

Generally viewed as enforceable if conspicuous, users have an opportunity to review and indicate affirmative assent (eg, check a box).

**Governing law**

Governing law and venue for resolution of disputes specified in a commercial contract will generally be accepted
and recognized. As a member of the EU the regulations on applicable law (Rome I, 593/2008/EC and Rome II, 864/2007/EC) and jurisdiction (1215/2012/EU) shall be applicable.

Dispute resolution is litigation in 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**

As a principal rule stipulated in the Civil Code, warranty cannot be disclaimed in consumer contracts.

In license contracts, the licensor warrants according to the general rules that the subject matter of the license agreement is appropriate for the contractual use or exploitation.


In the event a license agreement qualifies as a consumer contract warranty cannot be validly disclaimed. In other cases, the warranty disclaimers are enforceable, although given the fact that the new Hungarian Civil Code entered into force in 2014, there is no court practice to corroborate this.

The one-year term of statutory warranty can be reduced, but not in the context of consumer contracts.

**Enforceability of exclusions/limitations of liability indemnification**

Any contractual term limiting or excluding liability for deliberate non-performance of an obligation resulting in loss of life, or harm to physical integrity or health shall be null and void, so such terms are not enforceable.

**Indemnification**

Considering that no special indemnification rules regulate commercial contracts, the general contractual rules of the Civil Code shall apply to them.

Indemnities stated in contracts are recognized and 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).

Caps on liability under indemnification provisions can be enforceable.

**Electronic signatures**

Act 222 of 2015 sets out the General Rules for Trust Services and Electronic Transactions (hereinafter referred to as Trust Services and Electronic Transaction Act).

Further procedural acts regulate the enforceability of electronic signatures, such as Act CXXX of 2016 on the Code of Civil Procedure.
Electronic documents shall be considered to be valid if an electric signature or stamp is placed on such document in accordance with the Trust Services and Electronic Transaction Act. In line with the e-IDAS Regulation (Regulation 910/2014/EU) the electronic signature can be either:

- Advanced electronic signature or
- Qualified electronic signature

Advanced electronic signature shall mean an electronic signature that meets the following requirements:

i. It is capable of identifying the signatory

ii. It is uniquely linked to the signatory

iii. It is created using electronic signature creation data that the signatory can, with a high level of confidence, use under his or her sole control

iv. It is linked to the data signed therewith in such a way that any subsequent change in the data is detectable

A qualified electronic signature shall mean an advanced electronic signature that is created by a qualified electronic signature creation device, and which is based on a qualified certificate for electronic signatures.

It shall be noted that in family and succession law cases the exclusive use of electronic signatures and documents is not permitted.

Under the Code of Civil Procedure, when an electronic document is signed by an advanced or qualified electronic signature or stamp, that shall mean that such document corresponds with the requirements of written form and shall be considered not forged. If a private electronic document is signed by a qualified or advanced electronic signature or stamp, such document shall be considered a private document providing full evidence.

An electronic document made on a public document in a specific form by a body authorized to draft public document within its sphere of authority and executed by a qualified or advanced electronic signature or seal, and – if so prescribed by the relevant legislation – a time stamp shall have same probative force as the original paper-based public document.

If the electronic signature placed on the electronic document fulfills the above detailed requirements then it is valid and enforceable. In a court procedure an electronic document signed with a qualified electronic signature has the same probative value as a paper-based private document with full probative value.
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INDIA

INTELLECTUAL PROPERTY FRAMEWORK

Overview

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

Overview

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).

COPYRIGHTS

Nature of right

Copyright protection is available for original works of authorship expressed in a tangible form. Registration is 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:

- Claim authorship of the work
- 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 (including photographs) 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 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 5 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 fines that are not less than INR50,000 and up to INR200,000. The Copyright Act also provides for enhanced penalties in case of second or subsequent convictions. It states that a person convicted of an offense for the second time, or for every subsequent time, faces imprisonment for a term not less than one year, extendable to three years, and a fine of not less than INR100,000, extendable up to INR200,000.
MASK WORKS / TOPOGRAPHIES

Nature of right

The Semiconductor Integrated Circuits-Layout Design Act 2000 (SICLD) protects the intellectual property of the creator 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. India is also party to the Washington Treaty on Intellectual Property in Respect of Integrated Circuits (1989), although the same is not yet enforced in India.

Duration of right

The registration of a layout-design continues for a period of 10 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 3 years or a fine not less than INR 50,000 and up to INR 1 million or both. Further, where a person is convicted of an offense of infringement, the court convicting him or her 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

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 (PCT) and Paris Convention. The federal legislation in India that grants statutory right to patents is the Patents Act. India is also party to the Budapest Treaty on the International Recognition of the Deposit of Micro-organisms for the Purpose of Patent Procedure (2001). The same is in force in India.

Duration of right

Patents have a duration of 20 years from the date of filing a patent application either in India or internationally under the PCT. India follows a “first-to-file” system.

Ownership / licenses

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.

Remedies for infringement

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 in respect of patent infringement claims.

**TRADEMARKS**

*Nature of right*

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.

*Legal framework*

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

*Duration of right*

Trademark protection is effective for 10 years from registration and thereafter renewable on payment of fees (in
effect, perpetual, subject to payment of renewal fees).

*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 INR 50,000, and up to INR 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.

India is party to the Trade Related Aspects of Intellectual Property Rights (TRIPS Agreement) (1994), which addresses the concept of Trade Secrets, in Article 39. However, India does not currently have any statute or legislation that protects trade secrets. Thus, trade secrets need to be contractually protected.

Duration of right

Trade secrets can be protected as long as contractually agreed between the concerned parties. However, any trade secret that is:

- Known by a receiving party prior to receiving the trade secret from the disclosing party
- Becomes rightfully known to the receiving party from a third-party source, through no fault of the receiving party
- Or becomes publicly available through no fault of or failure to act by the receiving party in breach of this Agreement
- Required to be disclosed in a judicial or administrative proceeding, or is otherwise requested or required to be disclosed by law or regulation
- 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.

OTHER KEY IP RIGHTS

Nature of right
Not applicable for this jurisdiction.

Legal framework
Not applicable for this jurisdiction.

Duration of right
Not applicable for this jurisdiction.

Ownership / licenses
Not applicable for this jurisdiction.

Remedies for infringement
Not applicable for this jurisdiction.

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" appears 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 (eg, check a box) to contractual terms.

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 arises 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 indemnification**

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:

- As may fairly and reasonably be considered as arising naturally, according to the usual course of things, from such breach itself
- 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 if, in bringing or defending it, he did not contravene any orders of the promisor; and acted as would be prudent for him to act in the absence of a contract of indemnity; or if the promisor authorized him to bring or defend the suit

iii. All sums which he may have paid under the terms of any compromise of any such suit, if the compromise was not contrary to the orders of the promisor, or was prudent to be made in the absence of a contract of indemnity or is authorized by the promisor

**Electronic signatures**

The Information Technology Act, 2000 (IT Act) and the Indian Evidence Act, 1872 (Evidence Act) recognize the validity of electronic signatures. While under the IT Act a valid and enforceable digital signature is required to be issued by an approved certifying authority, in the manner prescribed under the Information Technology (Certifying Authorities) Rules, 2000 (Certifying Authority Rules), in practice, as long as the following conditions are met, an electronic signature would be considered valid and secure:

i. It is unique to the signatory

ii. It can identify the signatory

iii. It is created in a manner or using a means that is under the exclusive control of the signatory

iv. It is linked to the electronic record to which it relates in such a manner that if the electronic record were altered, the digital signature would be invalidated

v. The information or matter to which it relates is rendered or made available in an electronic form

vi. The information or matter should be accessible so as to be usable for a subsequent reference

Section 10A of the IT Act clearly states that contracts formed through electronic means are valid and enforceable before a court of law in India. It provides that where in a contract formation, the communication of proposals, the acceptance of proposals, the revocation of proposals and acceptances, are expressed in electronic form or by means of an electronic record, such contract will not be deemed to be unenforceable solely on the ground that such electronic form or means was used for that purpose.
However, there are certain categories of contracts or documents that cannot be attested electronically. In accordance with the IT Act, the following contracts cannot be signed electronically:

i. A negotiable instrument (other than a cheque)

ii. A power of attorney

iii. A trust deed

iv. A will or other testamentary documents

v. Any contract for the sale, conveyance or interest of an immovable property

**KEY CONTACTS**

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INDONESIA

INTELLECTUAL PROPERTY FRAMEWORK

Overview

The intellectual property framework consists of the following laws:

- Law Number 28 of 2014 on Copyrights
- Law Number 13 of 2016 on Patents
- Law Number 20 of 2016 on Trademarks and Geographical Indications
- Law Number 30 of 2000 on Trade Secrets
- Law Number 31 of 2000 on Industrial Designs
- Law Number 32 of 2000 on Layout Designs of Integrated Circuits
- Law Number 29 of 2000 on Plant Variety Protection

The government body who has responsibility 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. The Minister of Law and Human Rights finally issued the Regulation of Minister of Law and Human Rights Number 8 of 2016 regarding Requirements and Procedure of Recording of Intellectual Property Licenses (Minister Regulation No 8) on February 24, 2016.

COMMERCIAL CONTRACT FRAMEWORK

Overview

Most of the provisions regarding law on contracts are contained in Book III of the Indonesian Civil Code.
COPYRIGHTS

Nature of right

The creator or a copyright holder has the exclusive right that contains moral rights and economic rights to gain economic benefits such as to publish and/or reproduce the creation subject to the copyright, and to grant permission for third parties to publish and/or reproduce that creation.

Legal framework


Duration of right

The copyright on written works, choreographic works, forms of art, music, architecture, performances, discourse, educational and scientific visual aids and maps are valid for the life of the creator plus 70 years after the creator’s death.

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

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

Ownership / licenses

Copyright law regulates provision regarding collective management institutions. Collective management institutions must obtain operational license from the government. Copyright law regulates the copyright can become the object of fiduciary security.

A copyright holder has the right to give a license to a third party based on a licensing agreement to publish and/or reproduce the creation subject to the copyright, and to grant permission for third parties to publish and/or reproduce that creation. Based on Minister Regulation No. 8, copyright license agreement can be duly recorded and the application for recording can be made electronically or in paper format. The recording is valid for a duration of 5 years and can be renewed. Minister Regulation No. 8 requires that copy of the copyright license agreement, proof of ownership of copyright, original of special power of attorney and proof of payment to be submitted. Applicant is also required to provide a statement letter stating that the object of the license agreement is still valid, will not cause any losses to the national economy interest, will not inhibit the development of technology and not in conflict with the laws and regulations, morality and public order.

Remedies for infringement

Compensation, injunction or a combination of the two may be ordered by the Commercial Court as remedies for infringement. Criminal sanctions are in the form of imprisonment and/or fine may also apply for criminal act of the Copyright Law.
MASK WORKS / TOPOGRAPHIES

Nature of right

Layout design is a creation in the form of a three dimensional layout design formed by various elements, at least one of which is active, of which parts of or all of the interconnections in an integrated circuit and the three dimensional layout is meant for the preparation of making an integrated circuit. Integrated circuit is a finished or half-finished product that contains various elements, at least one of which is active, which are partly or entirely interconnected and integrated in a semiconductor to produce electronic functions.

A right to layout design of integrated circuits is an exclusive right granted by the Government to a designer for his creation, for a given period to personally exploit his or her creation, or to give permission to other parties to exploit the right.

Legal framework

Law Number 32 of 2000 on Layout Designs of Integrated Circuits (Lawout Design Law) 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.

According to Minister Regulation No. 8 then layout design of integrated circuits license agreement can be duly recorded and the application for recording can be made electronically or in paper format. Recording is valid for a duration of five years and can be renewed. Minister Regulation No. 8 requires that a copy of the license agreement of the layout design of integrated circuits, copy of the registration certificate of layout design of integrated circuits, original power of attorney and proof of payment to be submitted. Applicant is also required to provide a statement letter stating that the object of the license agreement is still valid, shall not cause any losses to the national economy interest, shall not inhibit the development of technology and not in conflict with the laws and regulations, morality and public order.

Remedies for infringement

Compensation, injunction, or a combination of the two may be ordered by the Commercial Court as remedies for infringement. Criminal sanctions are in the form of imprisonment and/or fine. There are four criminal provisions under the Layout Design Law.

PATENTS
**Nature of right**

Patent may be granted for an invention that is novel, involves inventive steps and can be applied in an industry. Simple patent may be granted for an invention that is novel, development result from an existing process or product, and can be applied in an 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 13 of 2016 on Patents (Patent Law) 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**

Patent law acknowledges the priority right as long the applicant has filled the patent application in the country which is a member of Paris Convention for the Protection of Industrial Property or Agreement Establishing the World Trade Organization. Patent law regulates the right on the patent can become the object of fiduciary security.

A patent holder may grant a license to a third party to use and gain economic benefits of the patent under a license agreement. Based on Minister Regulation No. 8, patent license agreement can be duly recorded and the application for recording can be made electronically or in paper format. Recording is valid for a duration of 5 years and can be renewed. Minister Regulation No. 8 requires that copy of the patent license agreement, copy of the patent registration certificate, original power of attorney and proof of payment to be submitted. Applicant is also required to provide a statement letter stating that the object of the license agreement is still valid, shall not cause any losses to the national economy interest, shall not inhibit the development of technology and not in conflict with the laws and regulations, morality and public order.

**Remedies for infringement**

Compensation, injunction or a combination of the two may be ordered by the Commercial Court as remedies for infringement. Criminal sanctions are in the form of imprisonment and/or fine. There are five criminal provisions under the Patent Law.

**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 20 of 2016 on Trademarks and Geographical Indication 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**

Trademark law acknowledges the priority right as long the applicant has filled the trademark application in the country which is a member of Paris Convention for the Protection of Industrial Property or Agreement Establishing the World Trade Organization. The holder of the trademark may grant a license permitting a third party to use the mark under a license agreement. The law stipulates that all licenses granted by the holder of the trademark must be recorded in the General Register of Marks and published in the Official Gazette of Marks.

Trademark license agreement can be duly recorded and the application for recording can be made electronically or in paper format. Recording is valid for a duration of 5 years and can be renewed. Minister Regulation No. 8 requires that copy of the trademark license agreement, copy of the trademark registration certificate, original power of attorney and proof of payment to be submitted. Applicant is also required to provide a statement letter stating that the object of the license agreement is still valid, shall not cause any losses to the national economy, shall not inhibit the development of technology and not in conflict with the laws and regulations, morality and public order.

**Remedies for infringement**

Compensation, injunction or a combination of the two may be ordered by the Commercial Court as remedies for infringement. Criminal sanctions are in the form of imprisonment and/or fine.

**TRADE SECRETS**

**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:

- Unknown to the public
- Has economic value due to its role in commerce
- 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:

- The information remains confidential
- The information has economic value
- 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.

Based on Minister Regulation No. 8, trade secret license agreement can be duly recorded and the application for recording can be made electronically or in paper format. Recording is valid for a duration of 5 years and can be renewed.

Minister Regulation No. 8 requires that copy of the trade secret license agreement, proof of ownership of trade secret, original power of attorney and proof of payment to be submitted. Applicant is also required to provide a statement letter stating that the object of the license agreement is still valid, will not cause any losses to the national economy interest, will not inhibit the development of technology and not in conflict with the laws and regulations, morality and public order.

**Remedies for infringement**

Compensation, injunction or a combination of the two may be ordered by the District Court as remedies for infringement. Criminal sanctions are in the form of imprisonment and/or fine. There is only one criminal provision under the Trade Secret Law.

**OTHER KEY IP RIGHTS**

**Nature of right**

**Industrial design**

An industrial design is a creation on the shape, configuration, or the composition of lines or colors, or lines and colors, or the combination thereof in a two or three dimensional form which gives an aesthetic impression and can be realized in a two or three dimensional pattern and used to produce a product, goods or an industrial commodity and a handy craft. Industrial design right is a government license to a designer for his or her creation for a given period to exploit his or her creation or to give permission to another party to do so.

**Legal framework**

**Industrial designs**
Law Number 31 of 2000 on Industrial Design (Industrial Design Law) is the governing statute for industrial design in Indonesia.

**Duration of right**

**Industrial designs**

An industrial design right is granted for ten years from the date of filing and cannot be extended.

**Ownership / licenses**

**Industrial design**

The holder of industrial design right may grant a license permitting a third party to use the industrial design under a license agreement. The law stipulates that all licenses granted by the holder of industrial design right must be recorded in the General Register of Industrial Design and published in the Official Gazette of Industrial Design.

Based on Minister Regulation No. 8, industrial design license agreement can now be duly recorded and the application for recording can be made electronically or in paper format. Recording is valid for a duration of 5 years and can be renewed. Minister Regulation No. 8 requires that copy of the industrial design license agreement, copy of the industrial design registration certificate, original power of attorney and proof of payment to be submitted. Applicant is also required to provide a statement letter stating that the object of the license agreement is still valid, will not cause any losses to the national economy interest, will not inhibit the development of technology and not in conflict with the laws and regulations, morality and public order.

**Remedies for infringement**

**Industrial design**

Compensation, injunction or a combination of the two may be ordered by the Commercial Court as remedies for infringement. Criminal sanctions are in the form of imprisonment and/or fine.

**INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT**

**Employees**

Copyright Law provides that the creator of a creation shall be the creator and copyright holder, for creations created under an employment relationship or based on an order.

Patent Law provides 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 practically common 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**
Copyright Law provides that if a creation is created in an employment relationship or based on an order, then the party that creates such creation will be deemed as the creator and copyright holder unless agreed otherwise between the parties.

Furthermore, Copyright Law stipulates that if the creation is designed by someone and is manifested and is conducted by other person under the lead of the person who designed such creation, the designer will be deemed as the creator.

Patent Law 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 Article 31 of Law Number 24 of 2009 on Flag, Language, State Emblem and National Anthem, Indonesian language must be used in any memorandum of understanding or any agreement entered with state institution, Indonesian government institution, Indonesian private entity or Indonesian citizen. Such memorandum of understanding or agreement that involves foreign party may also be made in the national language of the foreign party and/or in English.

**Country-specific issues for online content**

Indonesia has adopted Budapest Convention on Cybercrime through Law Number 11 of 2008 on Electronic Information and Transaction as amended by Law Number 19 of 2016 on the Amendment of Law Number 11 of 2008 (EIT Law).
**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" based on Article 1338 of the Indonesian Civil Code.

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 foreign court judgment to be enforced in Indonesia.

If the parties intend to apply foreign law as the governing law of the contract, then the better alternative is to use such foreign law and to elect a foreign arbitration as the dispute resolution mechanism. Indonesia has ratified the New York Convention (Convention on the Recognition and Enforcement of Foreign Arbitral Awards). Accordingly, Law Number 30 of 1999 on Arbitration and Alternative of Dispute Resolution (Arbitration Law) facilitates the enforcement of foreign awards in Indonesia, provided they meet certain conditions, being:

- The international arbitration award must be made by an arbitrator or panel of arbitrators in a country which is bound by agreement with Indonesia, either bilateral or multilateral, on the acknowledgment and enforcement of international arbitration awards
- The international arbitration award in paragraph (a) is limited to awards which pursuant to Indonesian law is in the scope of commercial law
- The international arbitration award as referred to in paragraph (a) can only be enforced in Indonesia if it is not contrary to public policy
- The international arbitration award can only be enforced in Indonesia after obtaining an execution judgment from the Head of the Central Jakarta District Court and
- The international arbitration award in paragraph (a) involving the State of the Republic of Indonesia as a party in the dispute, can only be enforced after obtaining an execution judgment from the Supreme Court of the Republic of Indonesia which is further assigned to the Central Jakarta District Court.

For its enforcement in Indonesia, a foreign award must be registered at the Central Jakarta District Court (CJDC). To enforce an international arbitration award, the Head of CJDC must recognize the foreign arbitration award and issue an execution enforcement judgment. If the Head of CJDC recognizes the foreign arbitration award through its judgment then the judgment becomes final and binding. If the Head of CJDC does not recognize the foreign arbitration award through its judgment the judgment still may be appealed to the Supreme Court. The judgment of the Supreme Court is a final and binding judgment.

**KEY COMMERCIAL CONTRACT TERMS**
Enforceability of warranty disclaimers

Express warranty disclaimers are recognized and generally respected.

Enforceability of exclusions/limitations of liability indemnification

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

Indemnification

Express indemnities stated in contracts are recognized and generally respected.

Electronic signatures


Article 1 paragraph (12) of EIT Law defines electronic signature as a signature that contains electronic information that is attached, associated or related with other electronic information that is used for means of verification and authentication. Article 52 of the GR 82/2012 stipulates that the function of electronic signatures is to authenticate and verify:

- The completeness and authenticity of the electronic information
- Identity of the signatory

Furthermore, Article 53 of GR 82/2012 stipulates that electronic signatures in Indonesia will have legal force and legal effect to the extent satisfying the following requirements:

- The electronic signature formation data shall be associated only with the signatories
- The electronic signature formation data at the time of signing shall only be under the authority of the signatory
- Any alterations to the electronic signature occurring after the signing can be known
- Any alterations to the electronic information related to the electronic signature occurring after the signing can be known
- There are certain methods adopted to verify the identity of the signatory
- There are certain methods to demonstrate that signatory has granted its consent to the associated electronic information

Pursuant to Article 54 of GR 82/2012, there are two types of electronic signature recognized in Indonesia, being:

- The certificated electronic signature (made by using electronic certification service provider and can be


proven with electronic certificate) and

- The non-certificated electronic signature (made without using electronic certification service provider)

Article 58 of GR 82/2012 also provides that in Indonesia, before an electronic signature is used, the electronic signature operator shall be obligated to verify the identity of the signatory, by way of:

- The signatory providing its identity to the electronic signature provider;
- Signatory registers with the operator or supporting service of the electronic signature and
- If necessary, the electronic signature operator may discreetly transfer the identity of the signatory to the other operators or supporting service of the electronic signature with signatory’s consent
IRELAND

INTELLECTUAL PROPERTY FRAMEWORK

Overview

The intellectual property regime in Ireland is primarily based on a modern legislative framework. There are some intellectual property rights that are governed by common law.

COMMERCIAL CONTRACT FRAMEWORK

Overview

For the most part, commercial contracts are governed by common law in Ireland. There are some industry specific and other legislation and regulation that apply to business-to-business commercial contracts. There is also a wide variety of primary and secondary legislative provisions that apply to business-to-consumer contracts.

COPYRIGHTS

Nature of right

Copyright is a property right. It gives protection to a range of works where the work is original, namely:

- Literary works including computer software
- Dramatic works
- Films
- Cable programs
- Broadcasts
- Musical or artistic works
Sound recordings

The typographical arrangement of a published edition and

An original database

There is no registration regime in Ireland for copyright works; it is not a pre-condition of the protection afforded to the work under copyright law. Copyright will arise at the time that the original work of authorship is recorded or fixed.

An owner of a work that is protected by copyright has a number of specific, exclusive rights in relation to that work including:

- To reproduce

- To make available to the public (and this includes the right to perform or display their work to the public) and

- To adapt

The copyright owner has the sole authority to permit others to do any such acts.

Under Irish law, there is also protection available for database rights, performance rights and rental and lending rights.

The Copyright and Related Rights Acts 2000 (as amended) recognises the concept of moral rights. The 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 of a person not to have a work falsely attributed to him/her) and

- The right to privacy in photographs and film where commissioned for private / domestic use

Importantly, it is not possible, as a matter of law, to assign moral rights. However, moral rights can be waived by the individual entitled to such rights.

Legal framework

The Copyright and Related Rights Act 2000 (as amended) governs copyright in Ireland. This statutory framework will be amended by the EU Directive on Copyright in the Digital Single Market, once transposed into Irish law. Ireland is a party to the Berne Convention of 1927.

Duration of right
There are different periods of protection for works under Irish copyright law, depending on the nature of the work.

For literary, dramatic, musical, artistic works or an original database, copyright will expire 70 years after the death of the author. If the musical work with lyrics is co-written, then copyright will expire on the death of the last author. The period of copyright protection applies regardless of the date on which these work was first made available to the public. However:

- For works that are computer generated, copyright will expire 70 years after the work is first lawfully made available to the public
- For cable programmes, copyright will expire 50 years after the cable programme was first lawfully included in a cable programme service
- For typographical arrangements of a published edition, copyright will expire 50 years after the date on which it was first lawfully made available to the public and
- For broadcast or sound recordings, copyright will expire 50 years after the date on which it was first lawfully made available to the public

There are specific provisions in relation to the duration of copyright in relation to films. Copyright in a film will expire 70 years after the last of the following people dies:

- The director
- The author of the music specifically composed for use in the film and
- The author of the screenplay or dialogue

Ownership / licenses

Under Irish law, copyright may be held jointly between two or more authors or creators.

There are no restrictions on assignment (transfer) or licensing of copyright works under Irish law. However there are a number of formalities set out in copyright law which must be adhered to.

Remedies for infringement

The primary remedies available to a copyright holder in relation to infringement are:

- Injunctive relief
- Damages
- An account of profits and/or
- Delivery up of the infringing material, seizure and destruction
In some circumstances, criminal penalties such as fines and imprisonment may be imposed for copyright infringement. Additionally, a copyright holder has rights to inform customs authorities of infringement thereby putting them on notice of counterfeit goods with a view to preventing importation of infringing materials.

**MASK WORKS / TOPOGRAPHIES**

**Nature of right**

Irish law recognises the concept of a "topography right" which protects the integrated circuit layout of electrical circuits used in semiconductor products. As with copyright law generally, there is no registration pre-condition or system in Ireland in relation to such rights.

**Legal framework**

The Irish European Communities (Protection of Topographies of Semiconductor Products) Regulations 1988 (as amended) gives effect to the Directive on the Legal Protection of Topographies of Semiconductor Products (87/54/EEC).

**Duration of right**

The topography right will commence on the date when it is first encoded or fixed (or in some cases, when first commercially exploited anywhere in the world). The topography right will expire 10 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 it is first encoded or fixed.

**Ownership / licenses**

Under Irish law, topography rights may be held jointly between two or more authors or creators.

**Remedies for infringement**

The primary remedies available to a topography right holder in relation to infringement are:

- Injunctive relief
- Damages
- An account of profits and/or
- Delivery up of the infringing material, seizure and destruction

**PATENTS**

**Nature of right**

Patents are a statutory right in Ireland.
The following conditions must be met in order to obtain patent protection for an invention:

- It must be new
- It must be capable of industrial application
- It must involve an inventive step (being an invention that is not obvious to a person skilled in the particular area of technology, having regard to the state of the art) and
- It must not be the subject of an excluded category (including discoveries, scientific theories, mathematical methods, aesthetic creations, business method, computer programs and the presentation of information)

In general, it is not possible to get a patent for software. However, there may be scope to obtain patent protection for an invention requiring use of software if the software used provides a technical solution to a technical problem.

The owner of a patent has exclusive rights to exploit the patented invention. Any person who makes, uses, sells or imports the patented invention must first obtain the consent of the patent holder.

The protection granted under Irish patent law is territorial. A patent granting protection in Ireland can be obtained from the Irish Patents Office, through the European Patent Convention (a centralised process for granting a suite of independent, nationally enforceable patents in Europe) or under the Patent Co-Operation Treaty.

Patents are a statutory right in Ireland.

The following conditions must be met in order to obtain patent protection for an invention:

- It must be new
- It must be capable of industrial application
- It must involve an inventive step (being an invention that is not obvious to a person skilled in the particular area of technology, having regard to the state of the art) and
- It must not be the subject of an excluded category (including discoveries, scientific theories, mathematical methods, aesthetic creations, business method, computer programs and the presentation of information)

In general, it is not possible to get a patent for software. However, there may be scope to obtain patent protection for an invention requiring use of software if the software used provides a technical solution to a technical problem.

The owner of a patent has exclusive rights to exploit the patented invention. Any person who makes, uses, sells or imports the patented invention must first obtain the consent of the patent holder.

The protection granted under Irish patent law is territorial. A patent granting protection in Ireland can be obtained from the Irish Patents Office, through the European Patent Convention (a centralised process for granting a suite of independent, nationally enforceable patents in Europe) or under the Patent Co-Operation Treaty.
Treaty.

**Legal framework**


**Duration of right**

Patent protection will last for 20 years. It is possible to obtain supplementary protection certificates for individual medicinal and plant protection products disclosed in a patent. If secured, these extend the protection by a further 5 years.

It is also possible to obtain a short-term patent.

The continuation of registered patent protection is conditional on annual renewal fees be paid each year from the third year from grant.

**Ownership / licenses**

A patent may be registered to one individual or jointly among a number of persons.

It is possible to assign and/or licence patents. There are certain formalities to be observed, depending on the nature of the license.

**Remedies for infringement**

The primary remedies available to a patent holder in relation to infringement are:

- Injunctive relief
- Damages
- An account of profits
- Delivery up of the infringing product and/or
- A declaration that the patent is valid and has been infringed

**TRADEMARKS**

**Nature of right**

A trade mark enables its owner to identify its goods or services and to distinguish them from other goods and services in the relevant market.

It is possible to obtain trade mark protection for words, phrases, symbols, designs, logos, letters, numerals, shapes,
colors, packaging and sounds or a combination, which differentiate the origin of the goods or services of one party from the goods or services of another.

A registered trade mark owner can, subject to certain limitations, claim exclusivity in the trade mark and prevent unauthorised use of the trade mark.

**Legal framework**

In Ireland:

- Irish registered trade marks are governed by the Trade Marks Act 1996 (as amended) and
- European Union Trade Marks are governed by Regulation EU/2017/1001

Ireland ratified the Madrid protocol in 2001 and became a signatory to the Trademark Law Treaty in 1999.

Accordingly, trade marks can be registered nationally in Ireland or at a European level, which affords the registered owner protection on a pan-European basis.

For unregistered trade marks and logos, it is possible to obtain legal protection under the common law tort of passing off.

**Duration of right**

A trade mark registration survives for ten years. It is possible to renew a trade mark registration for additional ten-year periods.

**Ownership / licenses**

Joint ownership of trade marks is permitted. It is possible to licence trade marks on either an exclusive or non-exclusive basis.

There are some recordal requirements in relation to assignments, licences and certain other instruments affecting registered trademarks under Irish trade mark law.

**Remedies for infringement**

The primary remedies available to a trade mark owner in relation to infringement are:

- Injunctive relief
- Damages
- An account of profits
- Order for erasure, removal or obliteration of the offending sign from the infringing goods, articles or
• An order for delivery up of the infringing goods, articles or materials

The European Union Trade Mark Regulations 2018 amended the Trade Marks Act 1996. These regulations entitle a trade mark owner to seek to stop counterfeit goods passing through Ireland and to stop infringing goods earlier in the supply chain, for example, where there is a risk that a trade mark is being used for ancillary or preparatory infringing acts (e.g., being affixed on packaging, labels or tags for counterfeit goods).

TRADE SECRETS

Nature of right

The regulation of trade secrets protects commercially valuable undisclosed know-how and business information.

A trade secret is information that:

• Is secret (in the sense that it is not generally known or readily accessible to persons within circles that deal with such information)

• Has commercial value because it is secret and

• Has been subject to reasonable steps by the person lawfully in control of the information to keep it a secret

Confidential information may be protected under and subject to a number of tests in common law.

Legal framework

The Trade Secrets Directive (EU) 2016/943 has been implemented in Ireland by the European Union (Protection of Trade Secrets) Regulations 2018. These regulations protect undisclosed know-how and business information (trade secrets) against unlawful acquisition, use and disclosure.

The disclosure of confidential information is governed by common law and/or, where applicable, may be governed by contract.

Duration of right

Trade secret and confidential information protection has a potentially indefinite term provided the quality of confidence is maintained.

Ownership / licenses

It is possible to have joint rights in confidential information and to limit use of such confidential information by licence or otherwise under contract.

Remedies for infringement
The primary remedies available to in relation to trade secrets for infringement:

- An order restraining any relevant person from disclosing any trade secret or alleged trade secret
- An order implementing measures to preserve confidentiality of any trade secret or alleged trade secret
- A compensation order for damages and/or
- An order for cessation, prohibition or destruction

Criminal fines and penalties are also possible in certain cases.

**OTHER KEY IP RIGHTS**

**Nature of right**

**Designs**

Design rights protect the appearance of a product which may include any industrial or handicraft item, including parts to be assembled into a complex product, packaging, get-up, graphic symbols and typographical type faces. Computer programs cannot be subject to design right protection.

A design must have a new and individual character in order to qualify for protection.

The registered proprietor of a design right has the exclusive right to use or authorise others to use the design including the rights of making, offering, putting on the market, importing, exporting or use of a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes.

Infringement of a unregistered design right can only arise where there is intentional copying of the protected design.

**Legal framework**

**Designs**

The Industrial Designs Act 2001, supplemented by the Industrial Designs Regulations 2002 (as amended) govern the protection of national designs in Ireland. The Community Design Regulations No. 6/2002 govern pan European registered design rights and introduced the concept of an unregistered design right into Irish law.

Accordingly, design rights can arise from a national registered design right or as part of a European registered or unregistered design right.

**Duration of right**

**Designs**

A registered design right (whether a national or community design) survives for 5 years from the date of first
registration. It is possible to apply to renew the registration for additional 5 year periods up to a maximum of 25 years.

Unregistered design protection survives for a period of 3 years from the date on which the design was first made available to the public.

Ownership / licenses

Designs

It is possible to have joint ownership in a design. It is also possible to transfer and/or licence design rights. There are certain formalities in relation to the recordal of exclusive and non-exclusive design rights.

Remedies for infringement

Designs

The primary remedies available to a trade mark owner in relation to infringement are:

- Injunctive relief
- Damages
- An account of profits and/or
- An order for seizure, forfeiture, destruction or delivery up of the infringing product

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

Employees

In general, works created by employees in the course of employment will be considered to be the intellectual property of the employer. However, this is not always the case if the work was created in the employee’s own time and in a way that did not rely on the time or information of the employer or otherwise relate to the day to day duties of the employee. This is not always clear-cut and so employment contracts will typically include provisions that seek to give certainty to the intellectual property rights as between the employer and the employee.

Consultants / contractors

The position regarding works done by persons who are independent contractors or consultants is different to the employer/employee relationship. Where the works are created as a result of and/or in the course of provision of the services by the independent contractor or consultant, typically the resulting intellectual property rights will be owned by the independent contractor or consultant.

Therefore it is necessary to ensure that appropriate provisions are included in the contract between the person commissioning the works or services and the independent contractor or consultant, to set out the intended
position regarding ownership, transfer and licensing rights in relation to the resulting works. Such provisions should include appropriate terms providing for the waiver of moral rights where applicable.

KEY COMMERCIAL CONTRACT CONSIDERATIONS

Registration of commercial agreements

There is no requirement to register commercial agreements in Ireland.

Recognized language of commercial agreements

English is the recognized language for commercial contracts in Ireland. There are some specific provisions in consumer protection law in Ireland which inform not just the content of business to consumer commercial agreements but also the style of English used, encouraging clear and intelligible language to be used for the benefit of the consumer.

Country-specific issues for online content

The statutory regime governing online content in Ireland generally derives from European law.

Enforceability of online/clickwrap/shrinkwrap terms

The enforceability of online terms is determined in Ireland by their compliance with normal principles of contract and consumer law, rather than by their medium.

The Unfair Contract Terms Directive, 1993/13/EEC was implemented in Ireland under the the European Communities (Unfair Terms in Consumer Contracts) Regulations, S.I. No. 27 of 1995 (as amended). This applies to the content of online/ click wrap/ shrinkwrap contracts in a business to consumer context and contains provisions in particular in respect of the types of contract terms which may be regarded as being unfair. A contract which contains unfair terms risks being unenforceable against the consumer.

In addition, the European Union (Consumer Information, Cancellation and Other Rights) Regulations 2013 require that certain minimum content is included in order for the contract to be enforceable.

Governing law

The Irish courts will generally recognize the governing law and venue for resolution of disputes (including arbitration) specified in a commercial contract. Specific rules apply to consumer contracts.

It is a specific requirement that business-to-consumer traders must include a link on their website to the European Commission’s Online Dispute Resolution platform.

KEY COMMERCIAL CONTRACT TERMS

Enforceability of warranty disclaimers
While in general, warranty disclaimers will be enforceable under Irish law for business to business contracts, it is not possible to exclude the implied condition of title in a contract of sale.

The Sale of Goods Act 1893 (as amended by the Sale of Goods and Supply of Services Act 1980) contains certain implied terms relating to the quality of any goods. These cannot be excluded when supplying to consumers. There are other implied terms relating to the provision of services which can be excluded when supplying to consumers, subject to ensuring such exclusionary terms are fair and reasonable in the circumstances and are brought to the attention of the consumer.

A warranty disclaimer in a business to consumer contract may be unenforceable against the consumer where it is unfair, having regard to the European Communities (Unfair Terms in Consumer Contracts) Regulations, S.I. No. 27 of 1995 (as amended). A term may be considered unfair and unreasonable where it causes a significant imbalance in the parties’ rights to the detriment of the consumer having regard to the nature of the services, the circumstances surrounding the conclusion of the contract and the other terms of the contract.

**Enforceability of exclusions/limitations of liability indemnification**

Generally, liability can be subject to limitation (in the form of a financial cap) and exclusions (of certain heads of loss) in both consumer (subject to the fair and reasonableness requirements referred to above) and in business contracts. Exclusions of liability for fraud or death and personal injury caused by negligence and for certain implied warranties will not be enforceable in a consumer contract. Current Irish case law indicates that it may not be possible to exclude liability for a fundamental breach.

**Indemnification**

Indemnity clauses in contracts typically fall into two categories:

- Clauses where one party agrees to indemnify the other against liability which that other may have towards him/her and
- 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

Indemnities are generally respected and recognized. Indemnification provisions are generally enforceable unless they involve indemnification of conduct that has been declared unenforceable by statutes or the courts (such as fraud, wilful injury to persons or property and any other future or past unlawful acts) or are contrary to public policy.

It is not unusual to see limitations and exclusions of liability applying to indemnities. In general, these will be enforceable under Irish law.

**Electronic signatures**

The Electronic Commerce Act 2000 governs the use of electronic signatures in Ireland.

An electronic signature may be used provided the person or body to whom the signature is addressed consents to the use of the electronic signature. Where a signature to a document needs to be witnessed or where a seal is required to be affixed to a document, certain additional requirements apply including the requirement that an
advanced electronic signature is used. Where the recipient is a public body, any information technology or procedural requirements imposed by that body must be complied with. There are also a number of exceptions under Irish law where an electronic signature may not be used such as:

- Wills
- Codicils
- Trusts
- Enduring powers of attorney
- Documents under which an interest in real property is created, acquired, disposed of or registered, sworn affidavits and
- Documents requiring a “wet ink” signature under law (such as prescriptions)

Under contract law, electronic signatures may have legal effect and be admissible as evidence in legal proceedings and are recognized as the functional equivalent of handwritten signatures.

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ISRAEL

INTELLECTUAL PROPERTY FRAMEWORK

Overview

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

Overview

In general, contractual engagements are regulated under the Contracts Law (General Part), 5733-1973. 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.

COPYRIGHTS

Nature of right

Copyright protects authors’ economic and moral rights. According to Section 4(a) of the Copyright Act 2007, 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 or her 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 or her death.

Records are protected for 70 years from creation or, if published within two years of creation, for 70 years from the publication date. Where an insufficient number of copies is made available to the public, the record will be protected for 50 years from creation or publication, respectively.

Fonts are protected under copyright for a term of 70 years following publication.

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. The employer is the first owner of copyright in a work created by an employee during and as a result of his or her employment.

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 tort. 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:

- Actual damages and recovery of profits gained by the infringer
- 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 ILS 100,000 (approximately US$27,500))

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 / TOPOGRAPHIES
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:

- 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
- 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:

- Its creator, on the date of creation, is a citizen or a resident of Israel
- 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:

- The end of 10 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
- At the end of 15 years from the date of creation of the layout-design

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

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 or her 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; rights in unregistered trademarks may also be enforced by means of the tort of passing off under the Commercial Torts Law 1999.

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 both 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 or her 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 ILS 100,000 (approximately US$27,500) without having to prove that damages were caused.

OTHER KEY IP RIGHTS

Nature of right

Designs

The Designs Law grants protection to registered and unregistered designs. A design is eligible for registration if it is novel and unique (creates a different general impression among informed users in comparison with existing designs/products of any kind and of the same kind). An unregistered design which is eligible for registration is entitled to partial protection, mainly with regard to commercial manufacturing.

Legal framework

Designs

The Designs Law 2017 (Designs Law) governs the protection of designs from August 7, 2018.

Until such time the protection of designs was governed by the Patent and Designs Ordinance.

Duration of right

Designs

Section 39 of the Designs Law sets the term of registered design protection at 25 years commencing from the date of the registration. Section 65 sets the term of unregistered design protection at three years commencing from the date of first publication.

There is a 12 month grace period from the first publication of a design to apply for its registration.

A design registered under the Patent and Designs Ordinance, which grants protection for a total term of 15 years, can be further extended by an additional three years under the new Designs Law (thus, 18 years in total).

Ownership / licenses

Designs

The designer is the first owner of a design. The employer is the first owner of a design made by an employee carrying out his or her tasks or as a result of making substantial use of the employer’s resources, unless otherwise agreed. A design made to order is owned by the person who ordered it, unless otherwise agreed.

Licenses can be granted by the owner of the rights and by licensees authorized to grant sub-licenses. An exclusive license or a transfer of rights in a design must be in writing and are required to be recorded on the designs registry.
**Remedies for infringement**

**Designs**

An infringement of rights under the Designs Law constitutes a tort and the Torts Ordinance [New Version] shall apply to it, subject to the specific provisions of the Design Law. 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 US$27,500).

In case of design rights infringement, the claimant is presumptively entitled to injunctive relief, unless the court finds grounds that justify not ordering such relief.

**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), Section 134 of 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 be noted that a series of cases since 2010 have considered the question of an employee’s right to royalties on service inventions as a separate question from the issue of ownership of the right (which vests in the employer). Furthermore, Committee for Compensation and Royalties (Committee) established in its decision under Chapter Six of the Patents Law that it is possible to waive this right and that a general waiver of rights by the employee suffices for this purpose, with no specific reference to royalties under the Patent Law being required (*Barazani v. Iskar*). The High Court of Justice stated that the Committee’s determination that the right to royalties on service inventions is not a protective labor law right and may thus be overridden by contract seems to be appropriate. The High Court of Justice recommended regulating the matter of royalties for service inventions (whether by way of legislation or through a voluntary arrangement in the relevant industries).

**Consultants / contractors**
The author is the first owner of the copyright in a commissioned work, unless the parties agree otherwise, either expressly or implicitly (note that this is not the case where the commissioned work is a design).

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 or her service.

Therefore, in agreements with consultants/contractors, one should include a covenant in which the consultant/contractor assigns all intellectual property rights that he or she may have to the company, as otherwise, such rights may 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.

Recognized language of commercial agreements

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, entering into a transaction with a consumer by exploiting the consumer’s lack of knowledge of the specific language of the transaction is considered as an unfair influence by the dealer which is prohibited. 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 or she understands its contents; however, such presumption, of course, can be rebutted.

Country-specific issues for online content

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 Standard Contracts Law (ie, 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:

- A condition denying or limiting a right or remedy available to the customer (“a person to whom a supplier offers an engagement to which a standard contract applies, whether such customer is the receiver or the giver of anything”) under law
A condition imposing the burden of proof on a person who would not have to bear it but for that condition

A condition which denies or limits the customer’s right to make certain pleas before judicial authorities or that determines that any dispute between the supplier and the customer will be settled in arbitration

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

A condition which requires a customer to confirm that the customer read the contract, or to declare that he/she has committed any act, or to approve the customer’s knowledge concerning a certain matter or fact, excluding information provided by the customer to the supplier in the contract

**Enforceability of online/clickwrap/shrinkwrap terms**

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 or her consent to the agreement (such consent should be retrievable for evidentiary purposes), subject to the restrictions set forth in the Standard Contracts Law, as further discussed above.

It should be noted that in some decisions of the Israeli district courts (which are not binding case law, but rather guidance for lower courts), it has been ruled that the courts’ tendency will be to revalidate online agreements when the signer provided active consent (clickwrap agreements), as opposed to shrinkwrap (or browserwrap) agreements, where the active consent of the signer is not required.

**Governing law**

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).

It should be noted that in some recent decisions of the Israeli district courts (which are not binding case law, but rather guidance for lower courts), it has been ruled that with respect to standard contracts entered into between multi-national corporations and numerous Israelis, with respect to services provided to or targeting Israelis, that determine a foreign jurisdiction and foreign governing law, Israeli courts will apply Israeli jurisdiction and law, on the basis that such determination of foreign jurisdiction and law is considered a prejudicial term in a standard contract. In addition, the Supreme Court ruled in May 2018, in a case relating to a major technology company, that notwithstanding the agreement between the parties (which constituted a standard contract), Israeli courts would have jurisdiction but the governing law would be the contractually agreed foreign law, as the plaintiff had failed to demonstrate that such law was unfairly prejudicial. This decision constitutes a binding precedent.

**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 indemnification

Under Israeli law, parties are free to enter into an agreement which sets out exclusion or 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 if such exclusion/limitation of liability is of a supplier in a standard contract (and thus such exclusion/limitation might be regarded as an unfairly prejudicial term contained within a standard contract) 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.

Electronic signatures

Generally, Israeli law recognizes electronic signatures, except for certain inheritance-related documents that cannot be electronically signed. The Electronic Signature Law, 5761-2001 (Law) amended in February 2018 expressly states that a signature will not be deemed inadmissible solely because it is an electronic signature – in other words, simple electronic signatures, such as copied and pasted PDF signatures or click-through consents, are now prima facie acceptable for evidentiary purposes (for the sake of clarity, they have always been sufficient for contractual purposes). Until this amendment, the Law only recognized the admissibility of two types of electronic signatures, both of which are required to comply with fairly stringent technological and bureaucratic standards: secure and certified, as detailed below.

An electronic signature is defined as a signature that is electronic data or an electronic sign that is attached to or associated with an electronic message.

A secure electronic signature should comply with the following requirements:

i. It is unique to the owner of the signing device (ie, a unique software, unique object or unique information required for producing a secure electronic signature)
ii. It allows apparent identification of the owner of the signing device

iii. It has been created using a signing device that is under the sole control of the owner of the signing device

iv. It allows detection of any change to the electronic message subsequent to signing

A certified electronic signature is a secure electronic signature where the signing device used to produce it has been verified by a registered certification authority (there are two certification authorities in Israel:

- Personal ID Ltd. (www.personalid.co.il)
- Comsign Ltd. (www.comsign.co.il)

Prior to the 2018 amendment, any signature that was required by law had to be either a manual signature or a Certified Electronic Signature. The amended Law now allows the use of simple or Secure Electronic Signatures in almost all cases where a document is required to be signed, provided the type of signature used is adequate to fulfill, to a sufficient degree of certainty, the purposes of such requirement. This somewhat vague standard will need to be fleshed out by the courts.

The Law deals with the evidentiary aspects of electronic signatures in Israel, but it is not the only piece of legislation dealing with the use of electronically signed documents and there is no comprehensive list of such items. Various rules and regulations govern specific uses of electronically signed documents, including rules pertaining to Companies Registry filings and rules pertaining to tax filings; most government agencies will not accept electronically signed documents.

As a general rule, documents that are required to be filed with various registries and governmental authorities are required to be manually signed, while those that apply only between the parties to the transaction can be electronically signed.

In addition, from a practical point of view the use of electronic signatures is impossible or inadvisable in the following instances:

i. Some companies and organizations, such as insurance companies, express a strong preference for manual signatures and may not accept electronic signatures

   ○ This would be determined by the internal policy of the specific entity in question

ii. If the other party to the contract to be signed is known to be problematic for some reason (for instance, is known to have challenged contracts in the past), or if the ability to prove the validity of the contractual undertaking is of particular importance, it would be advisable to obtain a manual signature despite the fact that electronic signatures are acceptable, to prevent disputes as to whether or not the document has been properly signed
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ITALY

INTELLECTUAL PROPERTY FRAMEWORK

Overview

As a general matter, intellectual property rights are governed by the Industrial Property Code (Legislative Decree No. 30/2005) the Italian Copyright Law (Law No. 633/1941) the Civil Code and ad hoc legislation.

COMMERCIAL CONTRACT FRAMEWORK

Overview

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. 206/2005 (the "Consumer Code") is also applicable.

The Consumer Code provides for detailed provisions on E-Commerce, which were recently amended by the Legislative Decree No. 21/2014 (implementing the EU Directive 2011/83/EU). With specific regard to E-Commerce, Legislative Decree No. 70/2003 (implementing the EU Directive 2000/31/EU) should also be taken into account.

COPYRIGHTS

Nature of right

Copyright protection is available to works having a creative character and pertaining to every field of human creations, including 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 her/his work and in case of an anonymous work, the right to reveal her/his identity, to object to any distortion, defacing or any other modification of her/his work that could be prejudicial to her/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.

AGCOM (Autorità per le garanzie nelle comunicazioni, the Italian Communication Authority) Regulation on Copyright Protection on Electronic Communication Networks (Resolution No. 680/13/CONS dated December 12, 2013) as further amended also applies.

Italy is 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 is automatic and originates from the mere creation of the copyrightable work.

The 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.

With regards to neighboring rights, phonographic producers’ rights last 50 years from the fixation of the phonogram. However, Legislative Decree No. 22/2014 (implementing the EU Directive 2011/77/EU of September 27, 2011) provides that, should the phonogram be lawfully published or communicated to the public, the protection would be extended to 70 years from the date of first lawful publication or communication to the public.

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.

Software is protected as copyrighted work; the Italian Copyright Law provides for some specific provisions in relation to this type of works.
Databases may be protected as copyrighted works in case they represent creative works resulting from the intellectual activity of the author, with consequent application of the relevant rules on copyright. Should the database lack such characteristics, the creator of the database would be granted a sui generis right against full reproduction or material extraction of content lasting 15 years from the first January of the year subsequent to its completion or publication.

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.

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**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.

**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, including 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 / TOPOGRAPHIES**


**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, including injunction and damages.

**PATENTS**

**Nature of right**

Patent protection is available to inventions that are deemed to be new, to involve an inventive step and are suitable for industrial application.

From the publication of the patent application, 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
Novel solutions capable to significantly improve existing products may be awarded protection as utility models.

_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, including the European Patent Convention. Italy also joined the Unitary Patent and Unified Patent Court system, but it is not in force yet.

**Duration of right**

Patent protection lasts for 20 years for inventions and 10 years for utility models, starting from the filing date of the patent application.

**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 Intellectual Property Code, 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, including injunction and damages.

Injunctions can be granted also as preliminary measures, by way of a summary proceedings, which could stop the infringement within 3-9 months from the petition date. The court may also order the seizure of the products and of all matters constituting an infringement of the patent.

Another relevant remedy 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.

Criminal penalties may also apply under certain circumstances.

**TRADEMARKS**

_Nature of right_

Trademark protection is available for 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:
Using a sign identical to the trademark filed for products or services identical to those for which the mark was registered

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

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

Unregistered trademarks enjoy a less extensive protection. In fact, in order to get protection on a national basis, the trademark shall be used in a way originating from a general notoriety of the similar trademark.

**Legal framework**

Sections 2569 to 2574 of the Italian Civil Code and the Industrial Property Code regulate 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; Regulation No. 1001/2017/EU applies, too.

**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 lapse).

The trademark can be transferred without the company or without a branch thereof, provided that no deception is caused to the consumer; trademarks can be 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.

Injunctions can be granted also as preliminary measures, by way of a summary proceedings, which could stop the infringement within a very short time, and also ex parte. The court may also order the seizure of the products and of all matters related to the infringement.
Another relevant remedy 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.

A popular means of protection is the so-called "search order", which allows the 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.

**TRADE SECRETS**

*Nature of right*

Trade secrets are defined as corporate information and technical-industrial experiences subject to the legitimate control of the owner provided that 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 confidentiality

iii. Is subject to reasonable measures to keep it secret by persons under the lawful control of which they are subject

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.

The current legal framework governing Trade Secret protection has been slightly amended by Legislative Decree 11 May 2018, No. 63 in order to comply with the provisions set forth in Directive no. 943/2016/UE (so called Trade Secret Directive).

*Duration of right*

The duration of protection is potentially perpetual as long as the information is secret.

*Ownership / licenses*
The holder of the trade secret is the entity that developed 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.

**OTHER KEY IP RIGHTS**

**Nature of right**

Not applicable.

**Legal framework**

Not applicable.

**Duration of right**

Not applicable.

**Ownership / licenses**

Not applicable.

**Remedies for infringement**

Not applicable.

**INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT**

**Employees**

**Copyright**

As a general rule, unless otherwise agreed by the parties, should a work be commissioned by third parties or created by an employee in the performance of his tasks or upon instructions given by the employer, the economic rights on such work would be held by the commissioner or employer, while moral rights, which are non-transferable and inalienable, would be retained by the author.

With regard to software and databases, unless otherwise agreed, the employer holds the exclusive right to exploit the work created by an employee in the performance of his or her tasks or upon the instructions of the employer.
With regard to industrial designs, the economic rights would be held by the employer in case the work has been done by the employee in the performance of his or her duties. Moral rights would in any case be retained by the employee.

**Patent**

When an industrial invention is made during the performance or fulfillment of an employment 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 an employment contract not providing specific compensation for inventive activity, the employer holds the patent rights arising from the invention and the inventor is entitled to a fair compensation 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 employers, the employer retains the right to purchase the invention. Different principles apply to inventions carried out within the frame of publicly funded researches by universities and similar institutions and researchers.

**Consultants / contractors**

Law No. 81/2017, published on 13 June 2017, established the principle, previously supported only by case law, according to which any IP right originating from a work on commission is owned by the commissioner, unless the parties agree otherwise.

The inventor or author keeps the rights on the result of his activity.

**KEY COMMERCIAL CONTRACT CONSIDERATIONS**

**Registration of commercial agreements**

While it is not necessary to register any agreement at the Italian PTO, the registration of some contracts (eg, trademarks and patent licenses) could be advisable, especially for evidentiary purposes in case of a court proceeding.

**Recognized language of commercial agreements**

Generally, the parties are free to determine the language of the contract. However, with regard to business-to-consumer agreements for the sale of goods and standard terms and conditions, Italian language is mandatory. Moreover, should one of the parties not be familiar with a foreign language, said party may claim the invalidity of some clauses of the contract.

**Country-specific issues for online content**

With regard to B2C contracts, the Consumer Code, as amended by Legislative Decree No. 21/2014, provides for some specific obligations in relation to pre-contractual information to be communicated to consumers, such as the ones on the vendor, the specific object of the contract and the right of withdrawal.
With regard to the right of withdrawal, such right may be unilaterally exercised by the consumer within 14 days, even without any reason and with no expenses except for those connected to the decrease of the goods’ value in case the returned goods are damaged. If the vendor has not properly informed the consumer on the withdrawal term, the right of withdrawal is extended to 12 months.

Furthermore, the Code provides that the delivery of goods shall take place at the latest within 30 days from the date of conclusion of the contract. An additional term may be provided under certain circumstances to the vendor to deliver the goods, but at the expiry of such term the consumer is entitled to terminate the contract and to obtain damages compensation.

**Enforceability of online/clickwrap/shrinkwrap terms**

The following considerations should be taken into account when entering into an online contract, especially in case of clickwrap and shrinkwrap terms.

Pursuant to Section 1341 of the Italian Civil Code, in case of standard terms and conditions drafted by one party, some provisions would be enforceable against the party who did not have the chance to negotiate the contract solely if specifically accepted in writing by the latter though the so called ”double signature”. In particular, the Italian Civil Code identifies as restrictive clauses the provisions which

- Limit the liability of the party who prepared the terms and conditions
- Give said party the right to withdraw from the contract or to suspend the execution thereof
- Burden the other party with time limits for the exercise of a right or limitations of such party’s power to raise defenses or with restrictions on freedom of contract with third persons, or with tacit renewal of the contract
- Provide for arbitration or derogations from the normal venue or jurisdiction of the courts

In B2C contracts, the clauses which are set by the vendor with no negotiation and which determine a consistent imbalance for the consumer shall be considered “restrictive clause” and therefore void. Where said clauses are the result of a negotiation between the vendor and the consumer, such clauses shall be considered effective provided that they

- Do not exclude or limit the liability of the vendor in the event of death or injury to the consumer due to an action or omission of the vendor
- Do not exclude or limit the consumer’s power to raise defenses in case of non-fulfillment or inadequate fulfillment of the vendor’s obligations
- Result in the acceptance of clauses that the consumer could not examine before the conclusion of the contract

**Governing law**

With regard to B2B contracts, governing law can be freely specified by the parties.
With regard to B2C contracts some provisions shall necessarily be governed by the Italian law irrespective of the governing law of the agreement.

**KEY COMMERCIAL CONTRACT TERMS**

**Enforceability of warranty disclaimers**

In B2B sale contracts, the vendor shall ensure that the goods sold are free from defects which could make the goods unfit for the use for which they are intended or which could appreciably impair their value. Pursuant to Section 1490 of the Italian Civil Code, the agreement by which the parties exclude or limit such guarantees has no effect, if the seller has in bad faith concealed the goods’ defects to the buyer. Such legal guarantee lasts for one year.

In B2C sale contracts, the vendor shall ensure consumers against any lack of conformity for a period of two years from the delivery of the good. In this case, the consumer is entitled, at its option, to the repair or replacement of the defective good. Should such remedies be impossible or too burdensome, the consumer is still entitled to a price reduction or a reimbursement against the return of the defective product.

**Enforceability of exclusions/limitations of liability indemnification**

Provisions containing limitations of liability are generally enforceable, except in the event of willful misconduct and gross negligence.

In case of standard contracts drafted only by one party, limitation of liability clauses shall be approved in writing by the other party, as mentioned above.

In B2C agreements, clauses excluding or limiting the liability of the vendor in the event of death or injury to the consumer due to an action or omission of the vendor are in any case void.

Tort liability may not be excluded or limited.

**Indemnification**

Under the general provisions of the Italian Civil Code, only the damages that are an immediate and direct result of the non-fulfillment or delay in the performance of the contractual obligation (Section 1223 of the Italian Civil Code) can be claimed by the parties.

**Electronic signatures**

Legislative Decree 7 March 2005, no. 82 (the Digital Administration Code or CAD) provides a twofold legal regime for simple electronic signatures, and for advanced, qualified and digital electronic signatures. Indeed,

- The suitability of an electronic document signed with a simple electronic signature (SES) to meet the requirement of written form and its probative value shall be freely assessed by the court, in relation to its own safety, integrity and immutability features

- On the contrary, the electronic document meets per se the requirement of written form and is per se valid
for proof when it is signed by way of a digital signature, another type of qualified electronic signature or an advanced electronic signature, or is created, following a electronic identification of its author, through a process meeting the requirements set by the Italian Digital Authority.

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INTELLECTUAL PROPERTY FRAMEWORK

Overview

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

Overview

Contracts including commercial contracts are interpreted and enforced in accordance with the Civil Code (Act No. 89 of 1986), any other related laws, specified rules and regulations such as the Commercial Code (Act No. 48 of 1899) and court precedents.

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 (except for movies) 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, adapt the work and use derivative works.

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.


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 before or 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 (eg, 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 and not waivable.

Remedies for infringement

No registration is required to seek remedies for infringement.

Monetary damages can be compensated. There are certain statutory presumptions to calculate damages but 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 (eg, 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 / TOPOGRAPHIES**

**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.

An owner 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 10 years from registration, and no renewal or extension of duration is provided. The layout-design must be registered within 2 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. There are certain statutory presumptions to calculate damages but 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 creation of technical ideas utilizing the laws of nature), utility models (the creation of technical ideas utilizing the laws of nature), and designs (shapes, patterns or colors, or any combination of these of an article having visual aesthetic attributes), and plant varieties.

A patent holder has the exclusive right to produce, use, transfer, sell, lease, offer for sale or lease, export 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 5 years extension, subject to certain requirements.

For utility model patents, the duration of protection is 10 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. There are certain statutory presumptions to calculate damages but 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), three-dimensional shape(s), or any combination of these, or color(s), or any combination of these, or sound(s) and other certain item(s) 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 10 years from registration and renewable every 10 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.

*Remedies for infringement*

Monetary damages can be levied. There are certain statutory presumptions to calculate damages but 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"

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*

The UCPA is silent on joint ownership of and licensing of trade secrets. As long as these do not undermine trade secrets to meet the three-prong test, the trade secrets will be still protected.

*Remedies for infringement*

Monetary damages can be levied. There are certain statutory presumptions to calculate damages but punitive damages are not available.

Injunctive relief is available as a remedy.

Criminal penalties are available for theft and use of trade secrets.
OTHER KEY IP RIGHTS

Nature of right
Not applicable for this jurisdiction.

Legal framework
Not applicable for this jurisdiction.

Duration of right
Not applicable for this jurisdiction.

Ownership / licenses
Not applicable for this jurisdiction.

Remedies for infringement
Not applicable for this jurisdiction.

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

Employees
The "work for hire" doctrine is applicable to copyrights and mask works. The doctrine is also applicable to patents as long as it is agreed in the work rules or employment agreement that the work for hire patents are inherently owned by the employer in advance. Employees must be reasonably compensated by an employer for the work for hire patents, patent assignments or grant of an exclusive license. The law does not provide the compensation figures but certain factors to be taken into consideration are provided and the amount must be reasonable. For copyrights, a work must be made public under the name of an employer except for computer program related copyrights.

Even if an employer did not provide that patents created by employees are inherently owned by the employer from the moment of their creation 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.

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 (ie, 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 non-exclusive 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.

Country-specific issues for online content

Does not apply for this jurisdiction.

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 (eg, accidental click) to cancel the contract if the company does not take appropriate measures (eg, 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 indemnification**

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.

**Electronic signatures**

Act No. 102 as of 2000 on Electronic Signatures and Certification Business (Act) provides details regarding the enforceability of electronic signatures of individuals. Under the Act, documents with electronic signatures that meet certain requirements are acknowledged as authentically created by the signatories and are admissible as evidence in civil litigation. Electronic signatures are also available for corporations. Electronic signatures have been used in both public and private sectors in Japan, such as tax filings, biddings and commercial transactions.
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LUXEMBOURG

Last modified 01 January 2019

INTELLECTUAL PROPERTY FRAMEWORK

Overview

In general, the intellectual property rights in Luxembourg are governed by the following 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 February 10, 2015 (the Copyright Act)

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 February 10, 2015 (the Copyright Act)


vii. Professor’s Privilege/Ownership of publicly funded research – Special laws on the public funding of research results

Since July 1, 2016, the 80 percent partial exemption of revenue from intellectual property under article 50bis of the Law of December 1, 1967 on income tax had become unavailable. However, the new Law of April 17, 2018 on income tax, concerning the tax regime for intellectual property (short title), now provides for an 80 percent partial exemption of revenue derived from intellectual property under certain restrictive conditions (to be BEPS-compliant) and applies in parallel (and non-cumulatively) with the former regime (until the expiry of the grandfathering period under that regime).
COMMERCIAL CONTRACT FRAMEWORK

Overview

A number of laws 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.


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


Duration of right

The duration of an author’s right is the author’s life, plus 70 years after his or her 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 Law includes a rebuttable presumption of authorship; the author is presumed to be the person under whose name the work is being disclosed.

Persons collaborating directly on 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 share the right to exploit their contribution in isolation provided that such exploitation is not done together with the contribution of another co-author and 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 or her moral rights to the extent that it is not prejudicial to his or her 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

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 but after authorization by the judge, 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:

   ○ Imprisonment

   ○ Monetary fine

   ○ Confiscation and possible destruction of infringing goods
iv. Heavier sanctions in case of repeated infringement:
   ○ Possible combination of imprisonment and monetary fine
   ○ Permanent or temporary closure of the establishment ran by the condemned party for a maximum period of 5 years
   ○ Publication and posting of judgment

MASK WORKS / TOPOGRAPHIES

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 (or import it to this end). The rights holder may, however, not assert this exclusive right: (i) to prohibit reproductions of the topography that serve the sole purpose of analyzing or evaluating 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:

- The date on which the topography was first commercially exploited anywhere in the world
- The date on which the application for registration was filed in due form

This exclusive right expires after ten years, calculated from the end of the calendar year during which the exclusive right came into existence.

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 "Patents – Remedies for Infringement").

PATENTS

Nature of right

An invention is eligible for patent protection if it satisfies three conditions:

i. It is new

   ○ 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 6 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. Inventive

   ○ It is inventive if it, in regard to the state of the art, is not obvious to a person skilled in the art.

ii. Capable of industrial application

   ○ 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.

ii. Such priority right provides that the date of priority shall be the date of filing the application.

iii. 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 or her consent:

- 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
- 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
- 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
- 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 4 years following the date of patent application or for a period of 3 years following the grant of the patent, a compulsory license may be granted following a request to the court.

Ownership / licenses
The Patents Law 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 "Trademark counterfeiting" 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 harm caused

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:

- 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 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 will be declared as lapsed.

A registered trademark will give its owner an exclusive right to prevent any third party, without its consent, from:

- 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
- 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
- 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
- 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

There is no Luxembourg trademark system per se. Luxembourg is party to the Benelux Convention, and as such, Benelux trademarks are in effect in Luxembourg (alongside with EU trademarks and international trademarks designating Benelux).

Trademarks are governed by the Benelux Convention on Intellectual Property of February 25, 2005 as approved by the Law of May 16, 2006 as amended.


Furthermore, as far as EU trademarks are concerned, Regulation (EU) 2015/2424 of the European Parliament amending Council Regulation (EC) No 207/2009 on the Community trademark and Community Regulation (EC) No 40/94 on the Community trademark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market, has now come into force. Most notably, it included
a name change for the traditional Community marks to European Union marks as well as a change from the traditional OHIM to EUIPO.


**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:

   ○ 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

   ○ 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 current legislation in Luxembourg.

To respond to the need for harmonization across borders, the Directive (EU) 2016/943 of the European Parliament and of the Council of June 8, 2016 on the protection of undisclosed know-how and business information (trade secrets) against their unlawful acquisition, use and disclosure brought both a common definition for trade secrets as well as more legal clarity as to the conditions guaranteeing the protection of a trade secret across the European Union.

On August 13, 2018, Luxembourg Parliament has tabled draft bill of law No. 7353 on the protection of undisclosed know-how and commercial information (trade secrets) against unlawful obtaining, use and disclosure, in order to transpose Directive (EU) 2016/943. For the time being, the Luxembourg draft legislation stays very close to the text of the Directive, but it still might undergo some changes during the parliamentary discussions.

At the present time, Luxembourg law does not provide for a uniform definition of trade secrets. Reference should be made to Directive (EU) 2016/943, article 2(1), which defines a "trade secret" as "information which meets all of the following requirements:

- It 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

- It has commercial value because it is secret

- It has been subject to reasonable steps under the circumstances, by the person lawfully in control of the information, to keep it secret"

This definition is close to the definition of Section 39(2) of the TRIPS Agreement:

Reference should also be made to Section 1 (i) of the Commission Regulation (EC) 316/2014 of March 21, 2014 on the application of Article 101(3) of the Treaty on the Functioning of the European Union to categories of technology transfer agreements: "know-how" means a package of practical information, resulting from experience and testing which is:

- Secret, that is to say, not generally known or easily accessible

- Substantial, that is to say, significant and useful for the production of the contract products

- 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 based on good or bad faith of one of the contracting parties (Article 1134 of the Civil Code)

**Duration of right**

Not applicable for this jurisdiction.

**Ownership / licenses**

As for most European jurisdictions, competition rules prevail over contractual arrangements. Licenses of trade secrets are subject to Commission Regulation (EC) 316/2014 of March 21, 2014 on the application of Article 101(3) of the Treaty on the Functioning of the European Union to categories of technology transfer agreements. Such licenses are exempted from the application of Article 101(1) of the Treaty in case the parties’ joint market share does not surpass certain thresholds and if the licensed technology rights have not expired, lapsed or been declared invalid or, in the case of know-how, for as long as the know-how remains secret, except if the disclosure of the know-how is the result of an action by the licensee (in which case the exemption shall only apply for the duration of the agreement). 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)

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)

v. Dissolution of company (companies)

OTHER KEY IP RIGHTS

Nature of right

Not applicable for this jurisdiction.

Legal framework

Not applicable for this jurisdiction.

Duration of right

Not applicable for this jurisdiction.

Ownership / licenses

Not applicable for this jurisdiction.

Remedies for infringement

Not applicable for this jurisdiction.

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 if the parties have expressly agreed to this in writing.

The original author retains the moral rights on the work but is in principle entitled to transfer them in whole or in part.

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

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.

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 for the license to become enforceable against third parties and will entitle the licensee 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 (ie, 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 Ibis 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 indemnification**

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, willful misconduct, death or personal injury.

**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.

**Electronic signatures**

Until mid-2016, the use of electronic signatures in the European Union was governed by Directive 1999/93 on a Community framework for electronic signatures (E-Signature Directive) as transposed into the national laws of 28 member states of the European Union. In Luxembourg, the E-Signature Directive was implemented by the Luxembourg E-Commerce Law of 14 August 2000.

The Regulation (EU) No 910/2014 on electronic identification and trust services for electronic transactions in the internal market and repealing Directive 1999/93/EC (Regulation) was adopted in July 2014, and has been effective as of July 1, 2016. This Regulation aims to provide more predictable regulatory environment and will be directly applicable in all member states of the European Union without having to be transposed in national legislation.

The Regulation has a two-tier approach. This means that all electronic signatures, ie, "data in electronic form
which is attached to or logically associated with other data in electronic form and which is used by the signatory to sign”, receive some legal recognition but only so-called "qualified" electronic signatures are automatically assimilated with handwritten signatures. Thus, in case of a dispute, it will be up to the competent court to decide whether a "non-qualified" electronic signatures can be assimilated with a handwritten signature. The Regulation does not preclude member states from deciding that, in certain circumstances, only specific types of electronic signatures, such as qualified electronic signatures, can be used.

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INTELLECTUAL PROPERTY FRAMEWORK

Overview

Two Federal laws provide the core legal basis for protection of intellectual property rights in Mexico:

- The Industrial Property Law (Ley de la Propiedad Industrial)
- The Federal Copyright Law (Ley Federal del Derecho de Autor)

COMMERCIAL CONTRACT FRAMEWORK

Overview

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 (ie, bank credit agreements, insurance, pledge, trusts, among others).

Additional commercial contract provisions may be found in other Federal laws (ie, 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.

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**


**Duration of right**

Moral rights are perpetual; economic rights last for the life of the author plus an additional 100 years.

**Ownership / licenses**

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.

The copyrights related to broadcasting work are limited by the signal retransmission obligation for broadcasting concessionaires set forth in the Federal Telecommunications and Broadcasting Law.

**Remedies for infringement**

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.

**MASK WORKS / TOPOGRAPHIES**

**Nature of right**

Mask Works protect the titleholder of any reproduction (total or partial), as well as from the import, sell or distribution for commercial purposes.
**Legal framework**

Fifth-Bis Title of the Industrial Property Law (*Ley de la Propiedad Industrial*) governs mask works.

**Duration of right**

The duration of mask work protection is ten years from the date the filing is presented before the Mexican Institute of Industrial Property (*Instituto Mexicano de la Propiedad Industrial, or IMPI*).

**Ownership / licenses**

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.

**Remedies for infringement**

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.

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**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 5 years as of the filing requesting the registration (subject to additional extensions of 5 years, until reaching 25).

**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, figures, sounds, scents or the plurality of operational elements (image, shape, size, color, package, decoration, etc.) 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.

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.

OTHER KEY IP RIGHTS

Nature of right

Not applicable.

Legal framework

Not applicable.

Duration of right

Not applicable.

Ownership / licenses
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

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 (eg, 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 in 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 indemnification**

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.

**Electronic signatures**

Electronic commerce and electronic signatures are recognized and regulated by Mexican law for private transactions; electronic methods may be used for commercial acts and their formation and the consent may be expressed through electronic methods. The electronic signature is any electronic data comprised in or attached to a data message used in order to:

- Identify the signatory in connection with the data message and
- To indicate that person’s approval of the information contained in the data message
The electronic signature produces the same legal effects as the handwritten signature and it is admitted as evidence in court.

Mexican law does not limit or restrict the electronic signatures to a particular format or tool. However, the data message shall contain information regarding the name of the signatory, in order to create a connection between the person and the electronic signature.

Pursuant to the provisions set forth in Article 93 of the Commerce Code, any commercial act required to be signed by the corresponding parties pursuant to the applicable laws, may be signed electronically by placing the electronic signature, as long as such electronic signature is attributable to the relevant parties and/or signatory persons. Furthermore, the information contained in the relevant data message shall be entirely conserved and kept as available for subsequent consultation.

Furthermore, an electronic signature may be considered advanced:

- When the signature is exclusively in control of the signatory person and
- When any modification to the original data message or electronic signature may be identified (i.e., the password protected identification form, digital fingerprint, etc.), pursuant to the opinion issued by a Certification Agent in E-Commerce Matters

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NETHERLANDS

INTELLECTUAL PROPERTY FRAMEWORK

Overview

In the Netherlands, the intellectual property rights are governed by the following federal 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)


vi. Semiconductors – Act on the Legal Protection of Topographies of Semiconductor Products of 1987

vii. Database rights – Databases (Legal Protection) Act of 1999

viii. Trade name – Trade Names Act of 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

Overview

Depending on the circumstances, such as the type of contract and sector, the Dutch Civil Code and other Dutch
laws apply to commercial contracts.

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 or her 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. If the author is unknown or is not a natural person, the copyright expires 70 years after the first of January of the year following the year of first publication of the work.

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 assignment of the copyrighted work and the grant of an exclusive license requires a written deed. The assignment or license will comprise only such rights as are recorded in such deed or necessarily derive from the nature or purpose of the title. The works transferred must be sufficiently determinable. If the author is a natural person they have the right to terminate the assignment.
agreement or a license if the work is not sufficiently exploited within a reasonable time by the assignor or the licensee. The assignment or license of a copyright of a not yet existing work is possible but voidable if the author of the work is a natural person.

The author (natural person) who grants a license is entitled to a fair remuneration. If the work is exploited in a way that was unforeseen at the moment the license was granted, the author (natural person) is entitled to an additional remuneration. These rights can be invoked against third parties — such as third-party assignees.

Authorization given by the author of a work protected by copyright to a third party to file a design in which that work is incorporated, must imply the assignment of the copyright attached to that work insofar as it is incorporated in the design. The party filing a design will be presumed also to be the owner of the copyright relating thereto; this presumption does 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 will 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 infringement profits made. A number of supplementary, injunctive measures are available, such as:

- A recall, 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
- The right of information, ordering that the infringer discloses 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
- The publication of the decision in full or in part

A European rule of exhaustion applies, which means that if a specimen (particular copy) of literary, scientific or artistic work, has been brought into circulation by means of transfer of ownership for the first time with the consent of the author or his assignees within the community, then the bringing of that specimen (particular copy) into circulation in any other way, with the exception of hiring and letting, shall not be considered as an infringement of the copyright.

According to Article 1019h of the Dutch Code of Civil Procedure, generally the losing party is obliged to pay the legal costs of the winning party. However, the judge has the authority to decide that these costs will be partly compensated by winning party.

MASK WORKS / TOPOGRAPHIES

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:

- Reproduction solely for the purposes of analysis, evaluation or teaching of the topography or the concepts, processes, systems or techniques embodied in the topography

- A topography resulting from the analysis and evaluation of another topography carried out in accordance with item 1, 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, ie, without the obligation to register, and is freely licensable and transferrable, 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 infringement profits. A number of supplementary, injunctive sanctions may be applied for, such as:

- A recall or definitive removal from the channels of commerce, surrender to the patent holder 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
• 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

• Appropriate measure for the dissemination of, or information on the decision

A European rule of exhaustion applies, which means that if a particular semiconductor product in which the topography is incorporated has been brought into circulation by means of transfer of ownership for the first time with the consent of the right holder within the community, then the bringing of that particular product into circulation in any other way shall not be considered as an infringement.

According to Article 1019h of the Dutch Code of Civil Procedure, generally the losing party is obliged to pay the legal costs of the winning party. However, the judge has the authority to decide that these costs will be partly compensated by the winning party.

PATENTS

Nature of right

Subject to the provisions of Articles 53 to 60 of the Dutch Patent Act of 1995, a patent shall confer on its owner the exclusive right:

• To make, use, put on the market or resell, hire out or deliver the patented product, or otherwise deal in for his or her business, or to offer, import or stock it for any of those purposes

• To use the patented process in or for his or her 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 or her 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:

• It is new (novel)
  ○ An invention is new (novel) if that invention was not already known in the state of the art

• Inventive
  ○ It is inventive if it would not be obvious to a skilled person based on the state of the art

• Susceptible of industrial application
  ○ 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:

• An obvious abuse in relation to the applicant
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 or her intention to manufacture or apply, in or for his or her 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 or her knowledge was obtained from a matter already made or applied by the applicant or from the applicant’s descriptions, drawings or models.

Legal framework


Duration of right

Patents have a duration of 20 years from the filing date of the patent application. It is not possible to renew the patent application. Exploitation of the invention is not a prerequisite for maintaining patent protection.

Ownership / licenses

The Patents Act provides that the patent rights are held by the patent holder or his/her successor in title.

If the public interest so requires, the competent ministry can grant a compulsory license.

The patent owner must grant a license required for the use of a patented invention granted in respect of an application which has the same or a later date of filing or, where a right of priority exists for the application, the same or later priority date, if the patent for which the license is requested represents a considerable advance; the patent owner shall, however, only be obligated to grant a license required for the working of a European patent after the time limit for filing an opposition to the European patent has expired or after pending opposition proceedings have been terminated. Such a license shall not extend further than is necessary for the application of the patented invention of the licensee. The latter shall be obliged to grant a reciprocal license under his or her patent to the owner of the other patent. If the abovementioned license is unjustifiably withheld, the license can also be granted by the court on a claim by the interested party.

Remedies for infringement

A patent holder is entitled to remedies for infringement similar to those available for infringement of other intellectual property rights, which warrant both (interim and final) injunctive and monetary relief (see Article 70 et seq of the Dutch Patent Act).

Damages as well as surrender of profits made can only be awarded if the infringer knew or should reasonably have known his or her actions entailed a patent infringement. A number of supplementary, injunctive sanctions may be
applied for, such as:

- A recall or definitive removal from the channels of commerce, surrender to the patent holder 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

- 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

- The dissemination of the decision in full or in part

A European rule of exhaustion applies, which means that if a particular patented product, or product that has been directly obtained through the patented process, has been brought into circulation for the first time with the consent of the patent holder within the Community, and/or Curacao or St. Martin, then the bringing of that particular product into circulation in any other way shall not be considered patent infringement.

According to Article 1019h of the Dutch Code of Civil Procedure, generally the losing party is obliged to pay the legal costs of the winning party. However, the judge has the authority to decide that these costs will be partly compensated by the winning party.

**TRADEMARKS**

*Nature of right*

Any signs (such as, but not limited to, names, designs, letters, numerals, colors shapes of goods or their packaging, or sounds) that can be represented in a sufficiently clear fashion and can 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:

- 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

- 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
- 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.

- 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 are 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 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.

**Remedies for infringement**

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:

- 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

- 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

- The dissemination of the decision, including the displaying and publishing of the decision, in full or in part

A European rule of exhaustion applies, which means that the trademark owner shall not be entitled to prohibit the use in relation to goods which have been put on the market in the European Community under that trademark by the trademark owner or with the owner’s consent. This rule of exhaustion does not apply where there exist legitimate reasons for the trademark owner to oppose further commercialization of the goods, especially where the condition of the goods is changed or impaired after they have been put on the market.

According to Article 1019h of the Dutch Code of Civil Procedure, generally the losing party is obliged to pay the legal costs of the winning party. However, the judge has the authority to decide that these costs will be partly compensated by the winning party.

**TRADE SECRETS**

**Nature of right**

Reference is made to the Dutch Trade Secrets Act 2018, which implements the EU trade secrets directive. The Trade Secrets Act defines a Trade Secret as information that is:

- Secret, this means that it is not generally known among or readily accessible to persons within the circle that normally deal with the kind of information in question

- Commercially valuable because it is secret

- Subject to reasonable steps under the circumstances, by the person lawfully in control of the information, to keep it secret

A trade secret is not necessarily restricted to technical knowledge or information. Commercial information such as marketing strategies, business plans and trade information can also be considered trade secrets. The trade Secrets Act also contains measures and remedies to enforce trade secrets, such as filing for an injunction to prevent further use or disclose of a trade secret. Furthermore, the Trade Secrets Act also provides various remedies against "infringing goods."

The Trades Secrets Act allows courts to grant the winning party a full cost award of all reasonable and equitable legal costs and other costs, similar to the full cost award in intellectual property right cases.
Legal framework

Civil law

In addition, 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.

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

Article 7:678 sub I of the Dutch Civil Code, provides that an employee who discloses information about his or her employer’s company, which information should have been kept secret, can be dismissed with immediate effect.

Criminal Law

Articles 272 and 273 of the Dutch Criminal Code stipulate the criminal protection of trade secrets.

European developments

On June 8, 2016, following a proposal from the European Commission, the European Parliament and the Council adopted a directive that aims to standardize the national laws in EU countries against the unlawful acquisition, disclosure and use of trade secrets.

The directive harmonizes the definition of trade secrets in accordance with existing internationally binding standards. It also defines the relevant forms of misappropriation and clarifies that reverse engineering and parallel innovation must be guaranteed, given that trade secrets are not a form of exclusive intellectual property right.

Without establishing criminal sanctions, the proposal harmonizes the civil means through which victims of trade secret misappropriation can seek protection, such as:

- Stopping the unlawful use and further disclosure of misappropriated trade secrets
- The removal from the market of goods that have been manufactured on the basis of a trade secret that has been illegally acquired
- The right to compensation for the damages caused by the unlawful use or disclosure of the misappropriated trade secret

EU countries must bring into force the laws and administrative provisions necessary to comply with the Directive by June 9, 2018. As stated above. The EU Trade secrets directive was enacted in the Netherlands in October 2018.

Duration of right

Not applicable for this jurisdiction.

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.

OTHER KEY IP RIGHTS

Nature of right

Not applicable for this jurisdiction.

Legal framework

Not applicable for this jurisdiction.

Duration of right

Not applicable for this jurisdiction.

Ownership / licenses

Not applicable for this jurisdiction.

Remedies for infringement

Not applicable for this jurisdiction.

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 exactly according to the draft and under the strict 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 2 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 his or her employer's company, which information he should have kept 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 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 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.

Country-specific issues for online content

If a consumer acquires online content, the right to terminate the agreement within a 14-day period (general consumer right for online purchases) remains in effect. In order to exclude this right, the consumer needs to explicitly accept that:

- Content will be provided within the 14-day period
- That the right to terminate the agreement is waived after provision of the content

Furthermore, pursuant to Dutch consumer law, a subscription for online content may not exceed one year. After such term, the subscription can be terminated with one month's notice period.

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 (eg, hard drive, USB stick), 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.

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 on, 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

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 of warranty provisions that set aside a consumer’s statutory rights 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 indemnification

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. Limitations of liability set out in general terms and conditions are generally deemed unreasonable in B2C relationships. 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.

Electronic signatures

Pursuant to Dutch law, agreements are concluded by means of an offer and acceptance thereof. Agreements are generally valid if legally competent parties reach an agreement (irrespective of whether the agreement is concluded verbally, on physical paper or electronically). Electronic signatures are no different from handwritten signatures from an enforceability perspective. If the validity of a signature - whether electronic or not - is contested, the underlying agreement cannot serve as evidence of the agreement reached as long as the origins of the signature is not proven. For electronic signatures, this risk can be mitigated through the use of so-called ”qualified electronic signatures” as defined in the Electronic Identification and Trust Services Regulation 2014 (Regulation (EU) No 910/2014 (eIDAS Regulation).

Generally, commercial agreements can be concluded by means of a simple electronic signature (without authentication). Some contracts must be concluded in writing, such as the sale of a house to a non-professional party. Such contracts can also be concluded by electronic means, provided that all of the following requirements are met:

- The contract is and remains accessible for the parties
- Authenticity of the contract is sufficiently guaranteed (by electronic signature)
- Moment on which the contract was formed can be determined with sufficient certainty
Identity of the parties can be assessed with sufficient certainty

Deeds that create or transfer rights in real estate require the involvement of courts, public authorities or professions exercising public authority and cannot be concluded electronically.

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NEW ZEALAND

INTELLECTUAL PROPERTY FRAMEWORK

Overview

Intellectual property rights in New Zealand are primarily governed by specific statutes: the Trade Marks Act 2002, Designs Act 1953, Patents Act 2013 and the Copyright Act 1994. However, these statutes have not codified New Zealand intellectual property law, and common law principles relating to intellectual property rights are still an important part of the intellectual property framework.

COMMERCIAL CONTRACT FRAMEWORK

Overview

The commercial contract framework in New Zealand is composed of an amalgamation of statutes, the common law, equitable doctrines and, to some extent, international law instruments. The most recent addition is the Contract and Commercial Law Act 2017, which has combined a number of statutes and covers matters such as contractual privity, contractual remedies, sale of goods and electronic transactions, among other things. The interpretation and enforceability of commercial contracts is generally a matter of common law.

There are statutes that may be relevant to certain commercial arrangements. For example, there are specific statutes relating to consumer contracts, consumer credit contracts and construction contracts, as well as statues governing competition and fair trading in the marketplace. There are also industry-specific regulations that may be applicable to contracts in particular industries.

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

COPYRIGHTS

Nature of right

Copyright protection is available for original literary, dramatic, musical or artistic works, as well as sound recordings, films, communication works and typographical arrangements of published editions.
There is no registration requirement for copyright in New Zealand and no copyright registration system. The protection is automatic and the work is protected from the time it is first recorded (in writing or otherwise).

Copyright owners have the exclusive right to prevent others from copying the work, issuing copies of the work to the public, performing, playing or showing the work in public, communicating the work to the public or making an adaptation of the work.

Legal framework

Copyright is governed by the Copyright Act 1994 as well as court judgments that impact the interpretation of the Copyright Act.

The Copyright Act provides for moral rights for original works, as well as for performer's rights for performances.

New Zealand is a party to the Berne Convention, the Universal Copyright.

Duration of right

Copyright protection in a literary, dramatic, musical or artistic work generally lasts for the life of the author plus an additional 50 years. Where the work is of unknown authorship, the copyright expires at the end of the period of 50 years from the end of the calendar year in which the work was first made available to the public by an authorized act.

For sound recordings and films, the copyright expires 50 years from the end of the calendar year in which the work was made, or if it is made available to the public by an authorized act before the end of this period, then 50 years from the end of the calendar year in which it was made available. Copyright in communication work expires 50 years from the end of the calendar year in which the work was first communicated to the public.

Copyright in a typographical arrangement of a published edition expires 25 years after the end of the calendar year in which the edition was first published.

Crown copyright generally lasts for 100 years from the end of the calendar year in which the work is made.

Ownership / licenses

The copyright owner can assign or license some or all of their copyright rights to another person. Moral rights may not be assigned, but these can be waived in certain circumstances.

Joint ownership of copyrights is recognized and arises automatically where a work has been produced by more than one owner. In general, licensing jointly owned copyright works requires consent from all joint owners.

Remedies for infringement

The copyright owner (or, in some circumstances, licensee) may bring proceedings in court for infringement of copyright and the relief available includes damages, injunctions and/or an account of profits. In certain situations criminal proceedings may be brought for copyright infringement. In addition, infringement of moral rights are actionable by the person entitled to the right and relief by way of damages and injunction is available.
In proceedings where it is proven that the defendant did not know and had no reason to believe that copyright existed in the work, damages will not be available.

The court may, due to the flagrancy of the infringement and any benefit accruing to the defendant due to the infringement, award additional damages.

**MASK WORKS / TOPOGRAPHIES**

**Nature of right**

The Layout Designs Act 1994 provides protection for the original three-dimensional disposition, however expressed, of the elements of an integrated circuit (a layout design) where this layout design was produced by an eligible person (such as a New Zealand citizen), or first commercially exploited in New Zealand.

The owner of the layout design rights has the exclusive right to copy the layout design, produce an integrated circuit in accordance with the layout design or copy, and commercially exploit the layout design in New Zealand.

The protection is automatic and registration is not required in New Zealand.

**Legal framework**

Layout designs are governed by the Layout Designs Act 1994.

**Duration of right**

The duration of protection is 15 years after the calendar year in which the layout design was made, or, if the layout design was first commercially exploited within 5 years after the calendar year it was made, then the protection lasts for 10 years after the calendar year in which the layout design was first commercially exploited.

**Ownership / licenses**

The maker of a layout design is generally the first owner of the rights in that layout design. However, where a layout design is made under the terms of an employment agreement, contract for services or as commissioned, then the employer/contractor/person who commissioned the work, as the case may be, is the first owner of the layout design. Joint ownership of layout designs is also recognized where the layout design is jointly made.

The owner of the layout design rights may assign or license some or all of the rights to another person. These rights may also pass by will or operation of law.

**Remedies for infringement**

A court may grant relief for infringement of layout design rights by way of damages, an account of profits and/or an injunction.

Where the infringement occurred, but the defendant was not aware and did not have reasonable grounds to suspect that there was an infringement of a layout design, then damages will not be available.
The court will consider the flagrancy of the infringement and benefit to the defendant when deciding whether to grant additional damages.

**PATENTS**

**Nature of right**

Patents are a registered right that protects inventions that are a "manner of manufacture" (including chemical compounds, products, systems, processes and methods), are novel, involve an inventive step and are useful.

Patents grant the right to exclude others from making, hiring, using, selling, offering for sale or hire, offering to make, and importing the claimed invention.

**Legal framework**

Patents are governed by the Patents Act 2013. New Zealand is a party to the Patent Cooperation Treaty and the Paris Convention.

**Duration of right**

Patents generally have a term of 20 years from the filing date of the complete specification for the application. In certain cases, an application can be made for a term beginning from a later date. This term is subject to payment of renewal fees.

Separate registrable rights exist for plant varieties and designs.

**Ownership / licenses**

A patent owner can license or assign some or all of their patent rights. Assignments must be registered.

Joint ownership is recognized and each patentee is entitled to an equal undivided share in the patent. Each patentee is entitled to exercise the exclusive rights given by the patent for the person's own benefit, without accounting to the others, but must not assign or license the patent without consent of all patentees.

In certain circumstances, the Commissioner may give directions to co-owners relating to the sale, lease or license of a patent or any interest in it. The court may also grant compulsory licenses if a market for the patented invention is not being supplied in New Zealand or is not being supplied on reasonable terms in New Zealand.

**Remedies for infringement**

Infringement proceedings may be brought in court by the patentee or, in some cases, the licensee. The relief available includes injunctive relief and, at the option of the plaintiff, damages or an account of profits.

However, the court may not award damages or an account of profits for infringement if the defendant proves that, at the date of infringement, the defendant did not know and ought not reasonably to have known that the patent...
existed or that the complete specification had become open to public inspection. If a product is marked merely to indicate that it is patented, this will not be sufficient to presume the defendant ought to have known the product was patented.

**TRADEMARKS**

*Nature of right*

Trademarks can be a word, phrase, design, image, smell, shape, sound, color, gesture, letter, number or any combination of these. Trademarks identify and distinguish the source of the goods or services of one trader from those of others traders.

Registering a trademark is not mandatory but is strongly encouraged so as to get the full benefit of the rights that trademark owners are afforded under the Trade Marks Act 2002.

Though it is possible to enforce trademark rights in respect of non-registered trademarks, it can be more difficult as proof of ownership and use must be established, which, in some situations, can be difficult to show. Registering a trademark with the Intellectual Property Office clearly shows ownership and is difficult to dispute.

*Legal framework*

The Trade Marks Act 2002 governs registered trademark rights. Registered marks are signified by the symbol ®, and the ™ symbol can be used to indicate a trader’s intention to register a mark as a trademark. Trademark owners have the exclusive right to use, license or sell the trademark and can prevent others from using the same mark, or a similar mark, usually in relation to the same or similar goods and services.

The Fair Trading Act 1986 and the common law tort of "passing off" provide additional remedies to trade mark owners of registered and unregistered marks.

New Zealand is a party of the Madrid Protocol, Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods, Singapore Treaty on the Law of Trademarks, Trade Related Aspects of Intellectual Property and Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of Registration of Marks.

*Duration of right*

Trade mark registrations are protected for ten years from the date of the application and are renewable indefinitely (for 10 year periods) on the payment of renewal fees, provided that the relevant mark continues to be used.

*Ownership / licenses*

Trade mark owners can assign or license their trade mark rights. It is advisable to include appropriate quality control language when licensing a trade mark in order to avoid dilution (or loss) of the mark and to preserve the mark’s reputation, although licenses are not required to be written.

*Remedies for infringement*
The remedies available for infringement of a trade mark include damages, an account of profits and an injunction. In certain situations criminal proceedings may be commenced for trademark infringement.

Trade mark owners may also give notice to the New Zealand customs service requesting that they detain any goods in the control of customs, on which or in physical relation to which an infringing sign is used.

In addition, remedies may be sought under the Fair Trading Act 1986 for misleading and deceptive conduct as well as pursuant to the tort of "passing off."

TRADE SECRETS

Nature of right

In New Zealand, trade secrets are a form of confidential information. A trade secret is information that is not generally known within the industry and that has commercial value to a business, such as formulas, recipes or business strategies. Unauthorized disclosure of trade secrets can generally give rise to a claim for breach of confidence. In certain circumstances criminal proceedings may be brought for taking, obtaining or copying trade secrets.

There is no requirement or ability to register trade secrets in New Zealand.

Legal framework

Trade secrets are governed by common law protection of confidential information, but often plaintiffs will be able to rely on contractual arrangements and also employment law.

Duration of right

Trade secrets can lose the necessary quality of confidence if they are no longer required to remain protected as confidential information, but otherwise, the protection has a potentially indefinite term.

Ownership / licenses

Trade secrets are confidential information and therefore not property per se. However, contractual rights to use trade secrets may be assigned or licensed.

Remedies for infringement

The main remedies for infringement available are damages, accounts of profits and injunction. There is also the possibility of punitive damages if the conduct of the defendant is deserving of condemnation.

Criminal penalties are possible under certain circumstances.

OTHER KEY IP RIGHTS

Nature of right
Passing off

The common law tort of passing off generally concerns the false or misleading representation that another trader's goods or services are, or are connected with, those of the plaintiff. The tort can also include misrepresentations as to quality and authority or endorsements.

The misrepresentation can be an express statement, but often arises from the defendant's use of a mark, trade name or "get-up" with which the goods or services the plaintiff are commonly associated, in the minds of the relevant customers or other traders.

There must be damage, to the plaintiff's business or goodwill or likely damage if the conduct continues.

Designs

Designs are a registered right governed by the Designs Act 1953. A design is defined as the new or original features of shape, configuration, pattern or ornament applied to an article by any industrial process or means. However, this cannot be a solely functional element. The design must not be published prior to the filing date.

Design rights owners have the exclusive right in New Zealand to make or import for sale or for use for the purposes of trade, or to sell, hire or offer for sale, an article in respect of which the design is registered. Design rights can be assigned and licensed. In some cases a compulsory license in respect of a registered design can be granted by the Commissioner or a court.

Legal framework

Not applicable for this jurisdiction.

Duration of right

Designs

Design rights generally subsist for a period of 5 years from the date of registration and can be renewed for a further two 5-year periods on the payment of renewal fees.

Ownership / licenses

Not applicable for this jurisdiction.

Remedies for infringement

Design

The remedies available for infringement include damages, an accounting of profits and injunction. However, in the case of innocent infringement, neither damages or accounting of profits is available.

Criminal penalties are also possible in certain circumstances.
INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

Employees

Where an employee makes, in the course of their employment, a literary, dramatic, musical or artistic work, that person’s employer is the first owner of any copyright in that work, subject to any agreement to the contrary. The position is the same with respect to design rights created in the course of employment. With respect to patentable inventions, the invention belongs to the employer if it was made in the normal course of the employee’s duties or specifically assigned duties.

Where specific work is commissioned, then the person who paid for the commissioned work will generally own the rights in that work.

Usually, employment contracts will contain provisions relating to the ownership and/or waiver of rights, if any, in intellectual property created by the employee, as well as provisions relating to non-disclosure or confidential information and restraints of trade.

Consultants / contractors

As a general rule if intellectual property is created by an independent contractor, it belongs to the contractor. However, this can be modified by express agreement if it is a commissioned work and, in some cases, by implied terms.

KEY COMMERCIAL CONTRACT CONSIDERATIONS

Registration of commercial agreements

There are no general registration requirements for commercial agreements. However, some commercial agreements may require disclosure where they relate to publicly listed companies or the state sector.

Where an agreement creates a security interest over personal property then this should be registered on the Personal Property Securities Register, pursuant to the Personal Property Securities Act 1999.

Recognized language of commercial agreements

A contract in plain English that is consumer-friendly is preferred. In consumer contracts in particular, certain terms may be unenforceable if they are not brought to the consumer’s attention in a clear and unambiguous manner.

Country-specific issues for online content

An Internet service provider does not infringe copyright merely because a consumer uses the Internet services of the provider in infringing the copyright or merely because the Internet service provider knows of the infringement from information received as a result of enforcement action taken pursuant to the Copyright Act 1994. However, in some cases injunctive relief is still available against the provider.

All consumer contracts, whether online or otherwise, are subject to the requirements in the Consumer Guarantees Act 1993 and the Fair Trading Act 1986. In addition, consumer credit contracts, whether online or
otherwise, are subject to the Credit Contracts and Consumer Finance Act 2003.

**Enforceability of online/clickwrap/shrinkwrap terms**

Information is not denied legal effect solely because it is in electronic form or is an electronic communication. Therefore, online, clickwrap and shrinkwrap agreements are generally enforceable, provided that they are validly made (including giving appropriate notice of terms and conditions).

However, traders must also be mindful of the statutory rights of consumers as well as fair trading requirements, as these may impose additional terms and/or render some terms unenforceable.

**Governing law**

Governing law and choice of forum for disputes that have been expressly specified in a commercial contract will generally be accepted and recognized in New Zealand courts. However, in some cases the subject matter or the type of contracting party (consumers for example) may justify challenging an express choice of law clause. There are also particular statutes that may apply regardless of any express choice of law clause (such as the Commerce Act 1986, the Consumers Guarantees Act 1993 and the Fair Trading Act 1986).

Arbitration may be a preferred option for parties and is governed by the Arbitration Act 1996. There are also a number of alternative dispute resolution procedures including private mediation and judicial settlement conferences. In some industries, such as telecommunications and utilities, specific dispute resolution forums have been established.

**KEY COMMERCIAL CONTRACT TERMS**

**Enforceability of warranty disclaimers**

Statutory consumer’s rights cannot be disclaimed or limited by a warranty disclaimer. A warranty disclaimer that purports to exclude or limit these rights will be unenforceable and could also lead to civil and/or criminal proceedings against the trader. Any warranty provided must be additional to statutory consumer guarantees.

Warranty disclaimers between parties in trade are generally enforceable, but in some cases, for example where there is a substantial imbalance of bargaining power, disclaimers may be challenged.

**Enforceability of exclusions/limitations of liability indemnification**

An exclusion or limitation of liability clause will generally be construed strictly against the party that drafted the clause or against the party seeking to rely on the clause where there is ambiguity, particularly where there is an imbalance of bargaining power. Clear and unambiguous language is generally required to exclude liability for negligence.

Where such a clause seeks to limit or exclude liability in relation to certain guarantees or representations in consumer contracts, these will be unenforceable.

In New Zealand, no action may be brought for personal injury covered by the Accident Compensation Act 2001 other than proceedings for exemplary damages. However, this liability may not be excluded or limited.
**Indemnification**

Express indemnities are recognized and generally respected.

However, with respect to specific subject matter, for example pecuniary penalties in relation to entering into cartel provisions, an indemnity may be void. In addition, some statutes require additional formalities before an indemnity provision will be enforceable (such as pursuant to the Credit Contract and Consumer Finance Act 2003).

**Electronic signatures**

A legal requirement for a signature will generally be met by means of an electronic signature if that signature adequately identifies the signatory and their approval of the information to which the signature relates, and is as reliable as is appropriate given the context and the purpose for which the signature is required.
INTELLECTUAL PROPERTY FRAMEWORK

Overview

In Norway, intellectual property rights are governed by various Norwegian laws. Norwegian intellectual property legislation is based on various international agreements and EU directives and regulations implemented through the EEA agreement.

COMMERCIAL CONTRACT FRAMEWORK

Overview

Norwegian contract regulations are governed by statute, non-statutory law and practice. The principles of *pacta sunt servanda* and freedom of contract are fundamental to the Norwegian contract law.

The Norwegian Contracts Act (*avtaleloven*) regulates and codifies certain law in relation to contracts. However, due to the development of non-statutory rules, the Contracts Act is mainly used for rules of authorization of contracts and invalid agreements.

The content of an agreement is primarily determined by what has been agreed between the parties, their justified expectations and subjective understanding of the agreement.

Certain mandatory provisions may apply in business-to-consumer contracts.

COPYRIGHTS

Nature of right

Copyright protection is available for original literary or artistic works. The protection covers works of any kind, regardless of mode of expression or form of creative expression.

To earn copyright protection the work has to be created through creative effort and have sufficient originality.
Neither registration nor the use of the international copyright sign is required. However, it is generally recommended that, where possible, both be included in order to strengthen the owner’s right to the work.

Copyright owners have the exclusive right to distribute copies and make the work available to the public, including the right to publicly display, present and share the created work.

**Legal framework**

Copyrights are governed by the Norwegian Copyright Act (No: åndsverkloven).

The new Copyright Act came into force on July 1, 2018. The purpose with the new Copyright Act was to modernize and simplify the Act, and thus the new Act entailed mostly structural changes. Norway is a signatory to multiple international conventions, such as the Berne Convention, the Rome Convention, and the TRIPS agreement.

**Duration of right**

Copyright protection lasts for the life of the author plus an additional 70 years. For an anonymous work, the copyright lasts for 70 years from the year of its publication or if it has not been published, 70 years from its creation. In general, the copyright protection of neighboring rights lasts for 50 years but the duration runs from various dates depending on the neighboring right in question.

**Ownership / licenses**

The author owns the work. Joint ownership of copyrights is recognized, and the economic rights to the work can be transferred or licensed, in whole or in part. Moral rights may not be transferred and can only be waived (except from the right to be referred to as the author, which cannot be transferred or waived). There are no formal requirements for licenses. However, through the Copyright Act of 2018 the original author or artist has an invariable right to get a *reasonable remuneration* when transferring his or her rights to commercial parties. This provision is meant to protect the artists from being taken advantage of when negotiating transfers.

**Remedies for infringement**

Remedies for copyright infringement include equitable and reasonable compensation for use, as well as compensation for losses and further injuries caused by negligent or willful infringement.

It is possible to obtain a court order for destruction of infringing products. An optional initial step is to obtain a preliminary court order for the confiscation of infringing products and equipment used in the manufacture thereof.

Criminal penalties are possible.

**MASK WORKS / TOPOGRAPHIES**

**Nature of right**

The creator of an integrated circuit/layout design has the exclusive right to enforce the design. The owner is granted the exclusive right to reproduce, import and make the layout design available to the public by sale,
renting/lending, or other public distribution.

The layout design has to be the result of the creator’s own intellectual effort, and it cannot be standard in the industry.

The protection of the layout design does not include any information, systems or techniques that the circuit is based on or represents.

**Legal framework**

Mask works/Topographies are governed by the Norwegian Integrated Circuits Act (No: kretsmønsterloven).

**Duration of right**

The exclusive right to the layout commences with its creation, and expires 10 years after the circuit was used commercially for the first time. The exclusive right shall nevertheless come to an end 15 years after the creation of the layout, regardless of whether it has been commercially utilized or not.

**Ownership / licenses**

The creator of the layout design is the owner of it. Joint ownership is recognized.

The creator is at any time entitled to transfer the exclusive right in whole or in part to any other person. Transfer of a copy of the layout design does not constitute a transfer of any rights in the layout.

If the layout design has been created by an employee, the exclusive right to the layout design passes to the employer unless otherwise agreed.

**Remedies for infringement**

Potential remedies for infringements are injunctive relief, damages and criminal penalties, and illegal copies may be confiscated or destroyed.

**PATENTS**

**Nature of right**

Upon registration, patent protection is available for reproducible inventions of a technical character with a technical effect. The inventions have to be "new," be industrially applicable, and have sufficient "inventive step."

Patent right owners are granted the exclusive right to exploit the invention commercially.

**Legal framework**

Patents are governed by the Norwegian Patent Act (No: patentloven).

Norway became party to the European Patent Convention on January 1, 2008 and ratified the Patent Cooperation
Treaty on October 1, 1979.

Norway is also a signatory of the Trade-Related Aspects of Intellectual Property Rights (TRIPS) Agreement, the London Agreement, Strasbourg Agreement Concerning the International Patent Classification and Paris Convention Treaty.

**Duration of right**

Patents have a duration of 20 years, calculated from the filing date of the application. The patent system in Norway is based on a "first to file" system.

**Ownership / licenses**

The inventor owns the patent, unless assigned. Others cannot, without consent from the inventor or his successor in title, use the invention.

Joint ownership is permissible and in case of joint ownership, use within its ordinary business operations are allowed without further agreement, and the parties must receive consent of each joint owner to each significant transaction, unless the parties contractually agree to waive the duty to account to other joint owners.

Contractual license and compulsory license can be granted.

**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. Criminal penalties and injunctions against continuous infringements can also be granted.

**TRADEMARKS**

**Nature of right**

A trademark may consist of any signs capable of being represented graphically, or 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.

**Legal framework**

Trademarks are governed by the Norwegian Trademark Act (*No: varemerkeloven*).


Norway has also signed the Paris Convention, the TRIPS Agreement, the Madrid Protocol and the Nice Agreement.

**Duration of right**
Registered trademarks are in effect for a period of 10 years from the date of the application, after which they can be renewed indefinitely for periods of 10 years.

Protection for unregistered trademarks are in effect for as long as the trademark fulfills the requirements for unregistered protection (well known in the market).

Ownership / licenses

Any natural or legal person can apply for and own a trademark or obtain a trademark through use.

The owner of the trademark has the exclusive right to use, transfer or license the trademark.

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. The court can also order products or materials infringing the trademark be recalled from stores, delivered to the trademark owner or destroyed.

Injunctive relief and criminal penalties are also possible remedies.

TRADE SECRETS

Nature of right

Trade secrets do not have a statutory definition by law, but often include information about business and operation conditions, first and foremost commercial, technical or operational information, which value is dependent on keeping such information a secret. By case law, the definition of trade secrets generally refers to company specific information, which have importance to the competitive position of the company, and which are subject of precautions to maintain its secrecy.

Legal framework

The protection of trade secrets are governed by the Norwegian Marketing Act (No: markedsføringsloven) and the Criminal Code (No: straffeloven).

The Norwegian Ministry of Justice and Public Security is currently reviewing the Directive 2016/943 of the European Parliament and of the Council June 8, 2016 on the protection of undisclosed know-how and business information (trade secrets) against their unlawful acquisition, use and disclosure. This Directive will enter into force in the EU on June 9, 2018, and the Ministry is considering how it will implement this Directive into Norwegian law. On November 26, 2018, the Ministry drafted proposition for a new Act on the Protection of Trade Secret, which currently is distributed among relevant stakeholders for consultation. The proposed new Act would repeal the current scattered legal framework and consolidate the laws into the proposed Act on Trade Secrets.

Duration of right
As long as the secret has commercial value and is not known by others outside the company, the secret will have legal trade secret protection.

Ownership / licenses

Licenses for know-how and trade secrets are common in Norway, and as such these can be transferred and licensed. To retain their status as trade secrets, such information must be subject to confidentiality provisions.

Remedies for infringement

In case of an infringement, the owner of the trade secret may proceed by either claiming for damages or injunction based on the Marketing Act, or by filing a criminal claim.

OTHER KEY IP RIGHTS

Nature of right

Design

A design is defined as the looks or part of a product that is characterized by its lines, contours, colors, form, structure or material to the product or its decoration. The design has to be "new" and have "individual character" in order to be able to be protected.

The designer can protect his exclusive right to the design through registration with the Norwegian Industrial Property Office. Registration of a design does not however limit the design’s protection under other law, such as trademark, copyright or patent law.

Legal framework

Design

Designs are governed by the Norwegian Design Act (No: designloven).

Duration of right

Design

The right to registered designs lasts for five years, but the protection can be renewed for up to five consecutive periods a total protection period of 25 years.

Ownership / licenses

Design

The designer has the exclusive right to his registered design, and no third party may use the design without the designer’s consent.

There are some exceptions to this exclusive right, and it applies to private and non-commercial use, use for
experimental purposes and use with a purpose of teaching and citation.

Licenses to designs can be granted.

**Remedies for infringement**

**Design**

The remedies for design infringement include equitable and reasonable compensation for the use and compensation for losses and further injuries caused by negligent or willful infringement. The court can also order that products or materials infringing the design can be recalled from stores, delivered to the design owner or destroyed.

Injunctive relief and criminal penalties are also possible remedies.

**INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT**

**Employees**

The Norwegian Right to Inventions made by Employees Act (No: arbeidstakeroppfinnelseloven) regulates the right to patentable inventions which are invented by employees employed in private and public sectors.

The general rule is that employees have the same right to their original inventions as any other inventor. However, there are certain exceptions to this general rule that provides the employer the right or priority to the inventions.

Employees must provide their employer with a notice of any invention in accordance with section 5 in accordance with the Norwegian Right to Inventions made by Employees Act.

The employer has the following types of claims against the employer's inventions:

- In accordance with section 4 paragraph 1 of the Norwegian Right to Inventions made by Employees Act, if the employee is employed as an inventor or researcher, or the invention is within a certain task set by the employee, then the employer has a right to claim that such patent is transferred to him, if this invention can be used within the company's business area. Within four months from the employee's notice, the employer has to inform the employee whether he wishes to claim any rights to the invention.

- If the invention is created by an employee in connection with the employment but not as set out in paragraph 1, then section 4 paragraph 2 of the Norwegian Right to Inventions made by Employees Act states that the employer has a right to request a license to the invention. If the employer wishes to receive a more extensive right, then he has a first right of refusal for four months after the provision of the employee's notice to enter into an agreement for such purposes.

- Where the invention has been made by the employee in circumstances that are not connection with the employment, then the employer has a first right of refusal for four months after the provision of the employee's notice to enter into an agreement for such purposes. This is subject to the invention being relevant to the company's business area, and this provision does not apply to universities or similar institutions.
Inventions made by the employee within 6 months after he has left the company will be considered to have been created under the service of the employer. This is subject to the invention being relevant to the business area of the company and was part of the inventor’s work during employment, or the invention is a result of a task that was assigned by employer to the employee.

If the employee transfers the invention to the employer, he has the right to a reasonable remuneration, except when the value of the inventions does not exceed what reasonably should be expected, taken into account the salary and other benefits received as employee.

The Copyright Act does not state any specific rules for work created in the scope of an employment other that 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 remain as a general principle under the Copyright Act the property of the employee, unless otherwise agreed. However, it is still outlined by non-statutory employment law principles that the copyright is transferred to the employer if creating of the copyrighted material is considered necessary for the employment contract to fulfill its purpose, or otherwise necessary for the employers ordinary business. Clarification in the employment contract is strongly recommended for clarity.

The right to lay outs generated by an employee is transferred to the employer unless there is a contractual agreement stating otherwise.

The employer’s right to a design is not regulated in the Design Act. The employee therefore owns the design, unless otherwise agreed or employer can prove there is a presumption between the parties that such design is to be owned by employer. However, also this will be governed by the above mentioned non-statutory employment law principles.

**Consultants / contractors**

Consultants and contractors own the intellectual property developed by them, unless they have signed a written agreement stating otherwise.

**KEY COMMERCIAL CONTRACT CONSIDERATIONS**

**Registration of commercial agreements**

There is no general registration requirement for commercial contracts. Some contracts may however require registration to be enforceable towards third parties, 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 business-to-business transaction are often in English, although Norwegian is the most common language between smaller companies.
Though not expressly required under mandatory law, Norwegian is preferable and recommended in business-to-consumer contracts.

**Country-specific issues for online content**

Companies must adhere to the E-Commerce Act (No: *ehandelsloven*) and the Right of Cancellation Act (No: *angrerettloven*).

**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. This can for example be done through a check 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 E-commerce Act.

In a business-to-consumer situation, specific rules apply.

**Governing law**

The parties have a contractual freedom in relation to choice of law. Governing law and venue of resolution of disputes specified in a commercial contract will generally be accepted and recognized by Norwegian Courts.

In a business-to-consumer situation, specific rules may apply.

District courts have jurisdiction over disputes unless an alternative dispute resolution procedure, such as arbitration, is specified in the contract.

**KEY COMMERCIAL CONTRACT TERMS**

**Enforceability of warranty disclaimers**

Disclaimers of warranty are usually enforced unless they are unconscionable, unclear or not conspicuous. Warranty disclaimers against consumers will most likely be covered by mandatory provisions seeking to protect the consumer, and in case of an unclear contract terms, it must be interpreted in favor of the consumer.

**Enforceability of exclusions/limitations of liability indemnification**

Exclusions and limitations on liability are usually enforced unless they are unconscionable, unclear or not conspicuous. Exclusions of liability in cases of gross negligence or willful misconduct, and for contractual terms which inappropriately excludes or limits the legal rights in the event of total or partial non-performance are presumed to be unfair, however there is little case law established on this point.

**Indemnification**

Indemnification clauses of contracts are generally enforceable, unless they are unfair.
Electronic signatures

Norwegian general contract law is based on the principle that all agreements are binding irrespective of the form they are entered into. Norway has implemented the eIDAS regulation through the Act on dated 15.6.2018 No. 44.

KEY CONTACTS

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INTELLECTUAL PROPERTY FRAMEWORK

Overview

The regulations governing intellectual property rights in Poland include:

i. The Industrial Property Law Act (ustawa Prawo wasnoci przemysowej), which regulates patents, utility models, industrial designs, trademarks and service marks, mask works and geographical indications

ii. The Act on Copyright and Related Rights (ustawa o prawie autorskim i prawach pokrewnych), which covers the protection of the rights of authors to their works, the rights of performers to their artistic performances, the rights of producers of phonograms and videograms, and the protection of personal images

iii. The Act on Combating Unfair Competition (ustawa o zwalczaniu nieuczciwej konkurencji), which protects trade secrets


COMMERCIAL CONTRACT FRAMEWORK

Overview

Legal provisions relating to contracts in general can be found in the Civil Code and the Code of Commercial Companies.

However, there are specific laws related to contracts concerning particular intellectual property rights, as indicated above.
COPYRIGHTS

Nature of right

Copyright protects the manifestation of creative activity of an individual nature, established in any form, irrespective of its value, purpose or form of expression. Copyright protection begins as soon as the work is established (registration of the right is not necessary). As a general rule, the copyrights to works of authorship (comprising the author’s economic and personal copyrights) are owned by their author.

The author’s economic copyrights stipulate the author’s exclusive right to use the work, or to trade the right to use the work in all fields of exploitation, and to receive remuneration for its use.

The author’s moral rights concern the author’s relation with the work. These moral rights include the right:

- of authorship
- to put the author’s name or pseudonym on a work, or to communicate a work anonymously
- to protect the integrity of the content and form of a work and its fair use
- to decide to communicate a work to the public for the first time
- to control the manner in which the work is used

Legal framework

Poland became a signatory of the Berne Convention in 1920 and the WIPO Copyright Treaty in 2003. It is also a signatory of other international treaties relating to copyright matters, eg, Poland has been bound by the TRIPS Agreement since July 1, 1995.

Additionally, Poland has implemented – or is in the process of implementing – certain EU Directives relating to copyright matters.

Duration of right

As a general rule, the duration of economic copyright protection is 70 years from the death of the author. If the copyrights are owned by joint authors, the 70-year period lapses with the death of the last surviving co-author.

However, if the author of the work is unknown, the 70-year period starts from the date of the first dissemination of the work, unless a pseudonym does not raise any doubts as to the author’s identity or the author has disclosed his/her identity. Moreover, if the author’s economic rights are vested in a person other that the author of the work, the period starts from the date of dissemination - or the date of establishment of the work if it has not been disseminated.

In the case of an audiovisual work, the protection period lapses with the death of the last of the following persons: the main director, the author of the script, the author of the dialogues or the composer of the music. In the case of a word-musical work, if it was created for a particular work, the period lapses with the death of last of the
following: the author of the verbal work or the composer of the music.

The protection of copyrights is calculated in years (following the year in which the event commencing the protection period took place). Different protection periods apply to rights to artistic performances, producers' rights to phonograms and videograms, broadcasting rights, and rights to first publications and scientific and critical publications.

Ownership / licenses

As a general rule, copyrights are owned by the author of the work. However, the author’s economic copyrights may be assigned to third parties (natural or legal persons), and also to heirs after the author’s death.

An employer acquires the copyrights to the works created by an employee in the course of the performance of his/her employment duties, upon the acceptance of the work, within the scope resulting from the aim of the employment contract and the agreed will of the parties; however, copyrights to computer programs created by an employee in the course of the performance of his/her employment duties are vested in the employer (unless the employment agreement provides otherwise).

As a rule, a copyright assignment agreement must be concluded in writing (otherwise being null and void) and should list the fields of exploitation to which the assignment relates. Joint ownership of copyrights is also recognized under Polish law. The author’s moral rights are non-transferrable.

Moreover, the author (or the owner of the author’s economic copyrights) may grant consent for the use of the works to third parties by concluding a license agreement, which may be exclusive or non-exclusive. An exclusive license needs to be concluded in writing. As a rule, licenses are limited in terms of the time, place and manner of using the copyrights.

Remedies for infringement

The remedies available to a copyright holder whose copyrights have been infringed include the right to seek:

- The cessation of the infringement
- The removal of the effects of the infringement
- Compensation for damage incurred – on the basis of the general provisions of Polish law or by the payment of a lump sum equal to two times the value of the license fee
- The return of any benefits gained

Regardless of the above, the copyright holder may also request that the infringer make a single or multiple statements in the media or that the ruling be published in a manner ordered by the court.

Additionally, at the request of the copyright holder, the court may decide on the future of the infringing goods and the tools and materials used for their manufacturing. In particular, it may order that they be withdrawn from the market, that they be given to the copyright holder or that they be destroyed.

The injured party is not obliged to send a cease and desist letter to the infringer before the initiation of a court
dispute. However, before the initiation of infringement proceedings, a copyright holder may file a request for a preliminary injunction (which may take the infringing party by surprise and increase the chances of seizing the infringing goods). A preliminary injunction provides the opportunity to secure the situation of the copyright holder for the entire duration of the civil proceedings since the infringer may be prevented from offering and marketing the infringing goods and they would be seized and held until the civil proceedings conclude with a final judgment.

The copyright holder may file a request for information (also before the main proceedings when infringement is highly probable) required to pursue claims against the infringer.

Violation of copyrights may also result in criminal sanctions, eg, the distribution of a third person’s work in its original version or as a derivative work, a performance, a phonogram or a broadcast or the fixing or reproducing of such a work for the purpose of distribution, may be subject to a fine, a restriction of liberty or imprisonment of up to two years.

**MASK WORKS / TOPOGRAPHIES**

*Nature of right*

A topography of an integrated circuit is a three-dimensional arrangement of elements presented in any form, where at least one of them is an active element, and all or part of the connections of the integrated circuit.

The registration right to a topography may be granted for a topography which is original. A topography is original if it is the result of the creator’s own intellectual effort and its design is not commonly known at the moment of its creation. For a topography consisting of commonly known elements, a registration right is granted only if the combination of the elements is original.

The protection of a topography is granted by the Polish Patent Office (Urzd Patentowy RP). From the moment the right is registered, the right owners have the exclusive right to exploit the topography for profit or for professional purposes.

The Polish Patent Office issues a decision on granting a right if the application is properly filed and no impediments to the granting are found. However, the granting of the right may be challenged by third parties.

*Legal framework*

Topographies of integrated circuits are governed by the Industrial Property Law Act.

*Duration of right*

The protection of a topography ceases to have effect 10 years after the end of the calendar year in which the topography – or an integrated circuit incorporating the topography – was put on the market, or the end of the calendar year in which an application to register the topography was filed with the Patent Office, depending on which of these time limits expires first.

The registration right to a topography also lapses 15 years after its creation and establishment if this period expires earlier than the time limit for which a right in registration was granted (and the topography was not used within said time for commercial purposes).
Ownership / licenses

The ownership of the right to a topography can be transferred by contractual agreement. The agreement for the assignment of the right must be concluded in writing. Information on the assignment of the right should be entered in the register in order for the right to be enforceable against third parties. Joint ownership of the right to a topography is possible under Polish law.

Licenses for the use of a registered topography can be granted on an exclusive or non-exclusive basis, also to multiple parties. A license must be concluded in writing. Sub-licenses can be granted only with the consent of the right holder.Granting of further sub-licenses is not permitted.

Remedies for infringement

If the right to a topography is infringed (e.g., it is reproduced as a whole or in part, unless for non-original part, or a copy of the protected topography is marketed), the right holder may demand:

i. The cessation of the infringement

ii. The payment of compensation for the damage incurred – on the basis of the general provisions of Polish law or by the payment of a lump sum equivalent to the value of the license fee

iii. The return of unfairly gained profits

Regardless of the above, the right holder may also demand that the ruling be published in a manner ordered by the court. At the request of the right holder, the court may also decide on the future of the infringing goods and the tools and materials used for their manufacturing. In particular, it may order that they be withdrawn from the market, that they be given to the right holder or that they be destroyed.

Before the initiation of infringement proceedings, a right holder may file a request for a preliminary injunction to secure its situation for the entire duration of the civil proceedings, since the infringer may be prevented from offering and marketing the infringing products and its products would be seized and held until the civil proceedings conclude with a final judgment. A right holder may also file a request for information – also before the main proceedings, when infringement is highly probable – required to pursue claims against the infringer.

PATENTS

Nature of right

An invention is patentable in Poland if it is novel, has an inventive step and is industrially applicable. There are certain categories of inventions that cannot be patented, such as discoveries, scientific theories and mathematical methods, schemes, rules and methods concerning mental or economic activity, as well as games and computer programs. Additionally, some technical solutions are excluded from patent protection for ethical reasons.

Under Polish law, technical solutions may also be protected as utility models. In order to be protected as a utility model, a technical solution should be new, useful, and refer to the shape, structure or durable assembly of an object.
A patent application may be converted into a utility model application (but not vice versa).

Patents and protection rights to utility models are both granted by the Polish Patent Office.

A patent and a protection right to a utility model give the holder the exclusive right to use them in a commercial and professional way in the territory of Poland. They forbid any third party from making, using, offering, marketing or importing a product incorporating the invention or the technical solution that is the subject of the right to a utility model. In the case of a patent, third parties are prohibited from applying the process that is the subject of the patented invention and from using, offering, marketing or importing products obtained by means of this process.

**Legal framework**

The Industrial Property Law is the law applicable to both patents and utility models.

**Duration of right**

A patent lasts for 20 years from the application date. In the case of patents referring to pharmaceutical products and plant protection products, protection may be extended, in principle, up to 25 years.

Utility models are protected for 10 years from the application date and the protection period cannot be extended.

**Ownership / licenses**

Joint ownership of a patent or the right to a utility model is possible. A co-owner may, without the consent of the other co-owners, use the patent or utility model to the extent to which the right belongs to him and may pursue claims against third parties for infringement.

It is also possible to transfer a patent or the right to a utility model, although it must be done in writing – otherwise the transfer will be null and void. The same applies to licenses.

Licenses may be granted on an exclusive and non-exclusive basis. However, only the holder of an exclusive license (which has to be recorded in the patent register) may pursue claims for infringement of the patent, unless the license agreement provides otherwise. A licensee may grant a further license only upon the consent of the licensor (further sublicensing is prohibited). A license that does not limit the scope of patent use is regarded as a license granting full rights as exercised by the patent holder.

The license remains effective towards the new owner of the patent or a right to the utility model.

**Remedies for infringement**

Polish law provides remedies for patent holders to combat patent infringement, such as demands to cease infringement, to compensate for damage incurred (also by paying a license fee), and the return of unfairly gained profits. Furthermore, under Polish law it is possible to pursue claims to prohibit actions constituting a threat of patent infringement. The patent holder may also seek a preliminary injunction before initiating the main proceedings, under which, for example, the infringing actions must be ceased and the infringing goods seized and held for the duration of the main infringement proceedings before the court.
In some instances, patent infringement may be regarded as the misappropriation of third party economic right.

Patent infringement claims may be pursued once the patent is granted. However, the patent holder may pursue claims against an infringer for infringements that occurred from the moment the patent application was published by the Patent Office (under some circumstances, also for an earlier period) or, in the case of a European patent validated in Poland, from the moment the information on the submission (to the Polish Patent Office) of a translation of the patent claim is published by the Polish Patent Office.

Contributory or indirect infringement and inducement is not regulated in the Industrial Property Law Act. However, based on general civil law rules, any person that induces another person to inflict damage, or that assists this person, as well as any person that consciously benefits from the damage inflicted on a patent holder, may be held liable for these acts.

In patent infringement litigation, the losing party must, upon the request of the adverse party, reimburse the court costs and attorneys’ fees (capped fees). When only a part of the claims is awarded, the costs may either be waived or proportionally shared between the parties. In specially justified cases, the court may also charge the losing party with only a part of the costs or no costs at all. In the case of a settlement, the costs are waived, unless the parties agree otherwise.

**TRADEMARKS**

*Nature of right*

Trademarks are signs that have a distinctive character and that distinguish the products of one company from the products of another company. A trademark has to have a graphic form in order to be registered – however, this statutory condition will be modified in the near future and the requirement of graphic representation will be abolished (the Polish parliament is working on an amendment to the Industrial Property Law (Bill No. VIII.3107) that will implement the provisions of Article 3 of Directive (EU) 2015/2436 of the European Parliament and of the Council, which does not require a trademark to be represented graphically). For instance, a word, design, color composition, shape, packaging, sound or melody may be registered as a trademark.

In Poland there are three regimes of registered trademark rights:

- **National trademarks** (registered by the Polish Patent Office)
- **International trademarks** (registered through World Intellectual Property Organization and approved by the Polish Patent Office)
- **EU trademarks** (registered through EU Intellectual Property Office)

In Poland, a person wishing to seek protection of his or her designation (sign) does not have to register the trademark through any office. This person may benefit from an unregistered trademark right based on unfair competition law on the basis of prior use on the market. The Polish Industrial Property Law also confers certain rights on the owners of non-registered but well-known trademarks commonly used in the Republic of Poland (a high degree of recognition by the relevant public is required).

The trademark right grants the owner the exclusive right to use the trademark in a commercial and professional
way in the territory of Poland (or in the EU, based on an EU trademark). A trademark right prohibits any third party from manufacturing, using, offering, marketing or importing and exporting and stocking for these purposes, products marked with an identical, similar or confusingly similar trademark (in the case of renowned trademarks, the level of similarity is lower and does not require that goods marked with such trademarks be identical or very similar).

**Legal framework**

In Poland, a trademark owner may pursue claims on the basis of the Industrial Property Law and the Act on Combating Unfair Competition.

In the case of EU trademarks, EU Regulation 2017/1001 of June 14, 2017 on the European Union trade mark applies.

Poland is also a signatory of the Madrid Agreement (since March 18, 1991) and the Madrid Protocol (since March 4, 1997).

**Duration of right**

The right to a registered trademark may last indefinitely if the protection is extended every 10 years.

In the case of unregistered rights, the trademark has to be in use for the owner to pursue any claims regarding its infringement.

**Ownership / licenses**

Under Polish law, there are three types of joint trademark ownership:

- Simple joint ownership by several commercial entities (such use must not create confusion for the public)
- A collective trademark (registered in the name of an organization and its affiliated companies)
- Certification trademark (registered in the name of organization that may grant the right to trademark use to entities that meet established requirements)

For all types of trademark ownership, the rules of trademark use should be filed with the trademark application.

A trademark owner may transfer or license the ownership rights. This must be done in writing otherwise it will be null and void.

Licenses may be granted on an exclusive and non-exclusive basis. However, only the holder of an exclusive license (which has to be recorded in the trademark register- this applies in the case of Polish trademarks) may pursue claims for the infringement of the trademark, unless the license agreement provides otherwise. A licensee may grant a further license only upon the consent of the licensor (further sublicensing is prohibited). A license that does not limit the scope of trademark use is regarded as a license granting full rights as exercised by the trademark owner.

**Remedies for infringement**
Polish law provides remedies for trademark owners to combat trademark infringement, such as demands to cease infringement, to compensate for damage incurred (also by paying a license fee), and the return of unfairly gained profits. Furthermore, under Polish law it is possible to pursue claims to prohibit actions constituting a threat of trademark infringement. The trademark owner may also seek a preliminary injunction before initiating the main proceedings, under which, for example, the infringing actions – such as manufacturing, offering and selling the infringing products – must be ceased and the infringing goods seized and held for the duration of the main infringement proceedings before the court. The possibility to file a request for information required to pursue claims against the infringer – when an infringement is highly probable – is also available to the right-holder (before the main proceedings or during the course thereof).

The same rules as in patent infringement cases apply with regard to the court order concerning costs of the proceedings.

**TRADE SECRETS**

*Nature of right*

A trade secret is understood as technical, technological and organizational information (know-how) of an enterprise, or other information of economic value, which, as a whole or in the precise configuration and assembly of its components, is not generally known to persons who normally deal with the kind of information in question or is not readily accessible to such persons, and provided that the person entitled to use or dispose of the information (eg, licensee) has taken, with due care, steps to maintain its confidentiality. Thus, in order to be regarded as a trade secret, the information should be confidential, not disclosed and protected. The definition of a trade secret, the forms of infringement, as well as the catalogue of available claims were recently modified (amendments in force since September 4, 2018) due to the implementation of the provisions of Directive (EU) 2016/943 of the European Parliament and of the Council into Polish law.

*Legal framework*

The Act on Combating Unfair Competition.

*Duration of right*

A trade secret is protected as long as the information is kept confidential and remains of economic value. As a result of the implementation of Directive (EU) 2016/943, the previous statutory 3-year non-disclosure time limit relating to employees or persons working for an enterprise under civil law contracts was removed from the Polish legal system (now there is no particular time limit for the protection of trade secrets based on the provisions on combating unfair competition). There are also some statutory exemptions aimed at protecting the public interest and social values (eg, freedom of speech), describing when an infringement will not occur.

*Ownership / licenses*

Information regarded as a trade secret may be transferred or licensed. The relevant agreement usually includes a non-disclosure clause. There are no requirements as to the form of the transfer or licensing of such information. With regard to licensing an invention that is protected as a trade secret (which is patentable but not protected by a patent), certain rules referring to licensing patents apply, eg, the license expires when the trade secret is no
longer confidential (unless the parties agree otherwise). It is accepted that a license for the use of such trade secrets does not have to be in writing (as it is in the case of patents).

Remedies for infringement

A party whose interests and rights are infringed by the disclosure of trade secrets may take action against the infringer, demanding that it cease its unlawful actions (using the trade secrets in its business), pay damages – on the basis of the general provisions of Polish law or by the payment of a lump sum equal to the value of the license fee, return unfairly gained profits, redress the effects of the infringement and publish certain statements in this regard, including information on the court judgment or information on its content. The court may also order the destruction of products and other things that are directly connected with the infringement. In such cases, the court may grant a preliminary injunction to be effective while it is considering the main claim.

Conduct which leads to an infringement may include the unlawful disclosure, use or acquisition of a trade secret.

Polish law also provides criminal liability for the infringement of trade secrets. This was recently modified to cover the disclosure or use of trade secrets by persons who became acquainted with them in connection with participation in court proceedings concerning unfair competition related to a trade secret or in connection with reading the files of such proceedings – provided that the court ordered that the proceedings be confidential.

The same rules as in patent infringement cases apply with regard to the court order concerning costs of the proceedings.

OTHER KEY IP RIGHTS

Nature of right

Industrial design is the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colors, shape, texture and/or materials of the product itself and/or its ornamentation. An industrial design will be granted protection if it is new and has an individual character.

In Poland, there are 3 regimes of registered industrial designs:

- National industrial designs (registered by the Polish Patent Office)
- International industrial designs (registered through the World Intellectual Property Organization and approved by the Polish Patent Office)
- Community designs (registered through the EU Intellectual Property Office)

In Poland, a person seeking protection of his or her design does not have to register the design through any office. This person may benefit from an unregistered community design right that lasts for three years from the date on which the design was first made available to the public within the community. Furthermore, an industrial design may be protected as a copyrighted work under the rules established in the Act on Copyrights and Related Rights (provided it meets the requirements described in the definition of a work). Additionally, the appearance of a product may be protected under unfair competition law (Act on Combating Unfair Competition) against its copying by industrial means, if such copying causes the likelihood of confusion.
The right of registration to an industrial design gives its owner the exclusive right to use the design in a commercial and professional way in Poland (or in the EU, in the case of registered community designs). The holder of the right to a registered industrial design may prohibit any third party from manufacturing, using, offering, marketing or importing and exporting and stocking for these purposes, products whose appearance does not produce on the informed user a different overall impression.

**Legal framework**

The owner of an industrial design registered with the Polish Patent Office may pursue claims on the basis of the Industrial Property Law and the Act on Combating Unfair Competition as well as the Act on Copyrights and Related Rights.


Poland is also a signatory to the Hague Agreement (since July 2, 2009).

**Duration of right**

The right to a registered design may last 25 years from the date of application, if the protection is extended every 5 years.

**Ownership / licenses**

Joint ownership of a Polish registered industrial design is possible. A co-owner may, without the consent of the other co-owners, use the registered design to the extent to which the right belongs to him or her and may pursue claims against third parties for infringement.

It is also possible to transfer a registered design, although in respect of the industrial designs registered with the Polish Patent Office, it must be done in writing – otherwise the transfer will be null and void. The same applies to licenses.

Licenses may be granted on an exclusive and non-exclusive basis. However, only the holder of an exclusive license to an industrial design registered with the Polish Patent Office may pursue claims for infringement of the rights to the design, unless the license agreement provides otherwise. A licensee may grant further licenses only upon the consent of the licensor (further sublicensing is prohibited in respect of designs registered with the Polish Patent Office). A license that does not limit the scope of the design's use is regarded as a license granting full rights as exercised by the holder of rights to the registered design.

The license remains effective towards the new owner of the rights to a registered industrial design (in case of transfer of rights to such design to a third party).

**Remedies for infringement**

Polish law provides remedies for the owners of industrial designs right to combat infringements, eg, the right-holders may demand the cessation of infringement, compensation for damage incurred (also by paying a lump sum equal to a license fee) and the return of unfairly gained profits. Furthermore, under Polish law it is possible to pursue claims to prohibit actions constituting a threat of a registered design infringement. The holder of the right
to an industrial design may also seek a preliminary injunction before initiating the main proceedings, under which, for example, the infringing actions – such as manufacturing, offering and selling the infringing products – must be ceased and the infringing goods seized and held for the duration of the main infringement proceedings before the court. The possibility of filing a request against an infringer to disclose certain information (before or during the main proceedings) is also available (please see preceding sections, eg, on patents or trademarks).

The same rules as in patent infringement cases apply with regard to the court order concerning the costs of the proceedings.

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

**Employees**

Under the general rules of Polish law, the employer generally acquires all the intellectual property rights to works created on the basis of an employment contract, unless the contract provides otherwise.

Therefore, based on the employment relationship, the employer acquires, *inter alia*, the following rights to intellectual property created in the course of employment:

- Right to inventions, designs and utility models, which also includes the right to obtain a patent or protection rights for the design or utility model
- Economic copyrights

However, copyrights to computer programs created by an employee in the course of the performance of his/her employment duties are vested in the employer.

The acquisition of copyrights to works that are not computer programs does not include personal copyrights (non-disposable rights of the author).

However, it is permissible to include in an employment contract an authorization for the employer to exercise the personal copyrights to an employee’s works. This is usually provided in the contract in order to enable the employer to interfere in the integrity of the work (in particular, by modifying the work) or to disseminate the work without indicating its author.

In addition, the transfer of the right to use and dispose of works derived from an employee’s work does not occur automatically with the transfer of economic copyrights. Therefore, the contract of employment needs to specifically provide for the transfer of derivative rights as well as the fields of exploitation in which this transfer occurs.

**Consultants / contractors**

**Industrial property rights**

Under the Industrial Property Law Act, where an invention, utility model or industrial design is created in the performance of an employment contract or other contract, it is the employer or the contractor that is entitled to the right to obtain a patent for an invention or a protection right over a utility model or a right in industrial design registration, unless the parties agreed otherwise.
Copyrights

Under Polish law, copyrights to works created by consultants or contractors are not automatically transferred to the entity to which the consultants or contractors are related. In order to transfer the copyrights to this entity to the greatest possible extent, the contract should stipulate:

- The transfer of economic copyrights for specified fields of exploitation
- The transfer of the right to use and dispose of works derived from the work created by the consultant or contractor in specified fields of exploitation
- The authorization for the entity to exercise personal copyrights on behalf of the consultant or contractor

KEY COMMERCIAL CONTRACT CONSIDERATIONS

Registration of commercial agreements

In general, the contracts do not need to be registered. However, certain laws may require that specific contracts be registered in order to cause specific legal consequences.

Recognized language of commercial agreements

Commercial agreements may be drafted in any language that the parties choose. However, contracts concluded with consumers have to be drafted in Polish. Also, for the purpose of providing the contract with the authorities or to register the contract in order to cause specific legal consequences, it may be necessary to prepare a Polish version or a sworn translation of the contract.

Country-specific issues for online content

Generally, the hosting provider is not liable for content provided by third parties that infringes intellectual property rights provided that it was unaware of the unlawful character of the stored data or related activities or – having received an official notification or reliable information about the unlawful character of the data or related activities – denies access to the data or deletes the data, as applicable.

The hosting provider is not obliged to check (monitor) the data which it stores in order to assess whether they infringe any intellectual property rights.

Enforceability of online/clickwrap/shrinkwrap terms

Online and clickwrap general terms and conditions are enforceable. However, if written form is prescribed by law (eg. agreements on the transfer of an author’s economic rights must be in written form), the document must be signed with handwritten signatures. Therefore, such agreements cannot be concluded as clickwrap terms and conditions. The enforceability of shrinkwrap terms is less clear, especially with regard to the business-consumer relationship.

Governing law
The parties are free to choose any governing law for the contract. However, Polish law may contain so-called overriding mandatory provisions which would be applicable despite the law chosen by the parties.

**KEY COMMERCIAL CONTRACT TERMS**

*Enforceability of warranty disclaimers*

In B2B relations, warranty for defects may be extended, limited or excluded. However, the exclusion or limitation of liability on account of warranty for defects is considered invalid if the defect was hidden deceitfully.

In contracts concluded with consumers, the limitation or the exclusion of liability on account of warranty for defects is only admissible in the cases provided for in specific provisions.

*Enforceability of exclusions/limitations of liability indemnification*

The parties to a contract who are professionals conducting business entity may limit the liability for negligence in full. However, it is not permitted to exclude liability for willful conduct.

There are specific laws which prohibit the exclusion or limitation of liability, the most well-known of which is the liability for hazardous products.

For contracts concluded with consumers, clauses excluding or limiting liability towards the consumer in the event of an injury to a person or the non-performance or improper performance of an obligation are considered abusive.

*Indemnification*

It is permissible for one party to indemnify the other party against the claims of third parties. Such clauses are commonly used in contracts concerning the transfer or licensing of intellectual property rights.

In transactions, indemnification clauses are usually used for defined and already existing risks, to ensure that the indemnifying party will hold the other party harmless in the event of any third-party claims.

*Electronic signatures*

Under Polish law, the following legal acts regulate electronic signatures: EU Regulation No. 910/2014 (eIDAS Regulation) and the Polish Act on Trust Services and Electronic Identification.

In the light of the eIDAS Regulation, there are two forms of electronic signatures:

- **Advanced electronic signature** – an electronic signature that meets the requirements set out in Article 26 of the eIDAS Regulation:
  - It is uniquely linked to the signatory
  - It is capable of identifying the signatory
It is created using electronic signature creation data that the signatory can, with a high level of confidence, use under his/her sole control.

It is linked to the data signed therewith in such a way that any subsequent change in the data is detectable.

According to Article 26 of the eIDAS Regulation, advanced electronic signatures may be used in public online services if an EU member state requires an advanced electronic signature to use an online service offered by, or on behalf of, a public sector body. In Poland, there are several specific regulations requiring the use of an advanced electronic signature within such public online services (such as customs law, etc.).

- Qualified electronic signature – an advanced electronic signature that is created by a qualified electronic signature creation device and is based on a qualified certificate for electronic signatures. According to Article 25 of the eIDAS Regulation, a qualified electronic signature has the equivalent legal effect of a handwritten signature.

Under the Civil Code, a declaration of intent made in electronic form (a declaration of intent with a qualified electronic signature should be treated as such) should be tantamount to a declaration of intent made in written form. A company is able to issue a qualified electronic signature if it is included in the Trusted List of qualified trust service providers which every EU member state maintains pursuant to Article 22 of the eIDAS Regulation.

The general rule under Polish law (ie, when no specific form is required by a specific legal provision) is that agreements may be concluded with any kind of electronic signature (including a signature that is neither advanced nor qualified, such as an e-mail signature). If written form is mandatory, a qualified electronic signature should be used because only this type of electronic signature has the equivalent legal effect of a handwritten signature. Agreements which require the form of a notarial deed cannot be concluded in electronic form (even with a qualified electronic signature).

Therefore, if a specific form (eg, written or notarial deed) for a particular contract is not required by the law, the contract may be concluded with any kind of electronic signature (ie, the signature does not need to be advanced or qualified in the meaning of eIDAS Regulation to be valid).
KEY CONTACTS

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INTELLECTUAL PROPERTY FRAMEWORK

Overview

The fundamental intellectual property framework in Portugal is provided in two main acts: the Code of Copyright and Related Rights (Decree-Law no. 63/85 of 14 of March, as amended) and the Industrial Property Code (Decree-Law no. 110/2018 of 10 of December).

COPYRIGHTS

Nature of right

Copyright covers original literary, scientific and artistic intellectual creations (works). Registration is not required for the acquisition or maintenance of copyright rights; however, there are certain specific copyright-related acts subject to registration in order to be valid.
In Portugal, copyright comprises patrimonial and moral rights.

In the scope of the patrimonial rights, copyright owners have the exclusive right to use, enjoy and dispose of their work, or to authorize the use of the work, wholly or in part, by third parties.

Moral rights consist in the right to claim authorship of the work, as well as the right to ensure its genuineness and integrity.

**Legal framework**

Copyrights are governed by the Code of Copyright and Related Rights.

Portugal became signatory to the Berne Convention in 1911 and to the WIPO Copyright Treaty in 2010.

**Duration of right**

As general rule, Copyright protection expires 70 years after the death of the author of the work, even in cases where the work was only published or disclosed after the death of the author.

In the case of works in collaboration, copyright expires 70 years after the death of the last surviving author. As per collective works or works originally assigned to a corporate person, copyright expires 70 years from the date of the first licit publication or disclosure, except if the individuals who create it were identified in the version of the work available to the public.

The duration of an anonymous work (or work that was legally published or disclosed without identifying the respective author) protection is for 70 years after publication or disclosure.

**Ownership / licenses**

Moral rights are inalienable.

The copyright owner (as well as his or her successors or assignees) may authorize the use of the work by third parties or assign economic rights, wholly or partially.

Granting an authorization to third parties in order for them to divulge, publish, use or explore the work does not imply the transfer of copyright.

Authorization shall only be granted in writing (mandatorily including the duration, place and price conditions) and it is presumed to be onerous and non-exclusive.

The total and final transmission of copyright patrimonial rights shall only be valid if concluded by public deed.

Partial transmission shall be concluded in writing with notarized signatures and shall include the rights object of transmission and the conditions of execution – notably, the duration, place and price (if applicable). In case no duration is established, it is presumed that the maximum duration is 25 years (in general) and 10 years in cases of photographs or applied art.

**Remedies for infringement**
If a copyright infringement is intentional or negligent, the agent shall be obliged to compensate the injured party for damages resulting from the infringement.

The determination of the amount of the compensation will take into consideration the profit realized by the infringer as a result of the infringement, the loss of profit and financial loss suffered by the injured party, as well as the costs borne by the injured party related with the protection of copyright rights and the costs with the investigation and with the termination of the infringement.

The amount of the compensation shall also take in consideration the personal injury caused by the conduct of the infringer, the circumstances of the infringement, the seriousness of the offense and the degree of the illicit disclosing of the work.

Criminal penalties are also possible for infringement of copyright and may be punished with imprisonment for up to three years or a fine.

**MASK WORKS / TOPOGRAPHIES**

**Nature of right**

The topography of a semiconductor product is a set of related fixed or encoded images that represent the three-dimensional layout of the layers making up the product, in which each image shows the layout or part of the layout of a surface of the same product in any stage of its manufacture.

Only topographies of semiconductor products that result from the intellectual efforts of their creator and are not known in the semiconductor industry may be protected.

Topographies consisting of elements known in the semiconductor industry may also be protected, provided that the combination of these elements, as a whole, fulfills the conditions in the previous paragraph.

Protection granted to topographies of semiconductor products applies only to the topographies themselves and not to any concept, process, system, technique or encoded information incorporated in them. Any creator of a final or intermediate topography of a semiconductor product has the exclusive right to use this topography, provided that the creator meets legal requirements, such as those regarding registration.

**Legal framework**

Mask works are governed by Title II, Chapter II of the Industrial Property Code (Articles 153 to 172).

**Duration of right**

The duration of a registration is 10 years from the date of application or the date on which the topography was first exploited in any location, if earlier.

**Ownership / licenses**

The topography of a semiconductor product can be transferred in writing whether or not for financial reward.
The topography of a semiconductor product may also be licensed in writing, wholly or partially, whether or not for financial reward, on an exclusive or non-exclusive basis.

Transfer of ownership and licenses shall be recorded in the Portuguese Institute of Industrial Property to be effective against third parties.

**Remedies for infringement**

Whenever there is violation of, or justified fear that another party may cause serious and difficult-to-repair harm to an industrial property right, including a topography of a semiconductor product, the court may, at the request of the interested party, order appropriate measures to prevent any imminent violation or to prohibit continuation of the violation.

Whoever illegally violates the industrial property rights of another person with intent or by negligence shall be obliged to pay compensation to the injured party for the damages resulting from the violation.

In determining the amount of compensation for losses and damages, the court shall take into account the profit obtained by the infringer and the resulting damages and lost profits suffered by the injured party. The costs borne with the protection of the right in question and the investigation and termination of the harmful conduct shall also be taken into consideration, as well as personal injury.

If it is impossible to quantify the losses effectively suffered by the injured party, the court may, provided this is not opposed by the injured party, alternatively define a fixed amount with recourse to equity that is based, as a minimum value, on the remuneration that the injured party would have received if the infringer had requested authorization to use the industrial property rights in question and the costs borne with the protection of the industrial property right and the investigation and termination of the harmful conduct.

Infringement of the exclusive right granted by a topography of a semiconductor product is punishable as crime with imprisonment up to 3 years or a fine.

**PATENTS**

**Nature of right**

Patent rights cover new inventions, in all fields of technology, provided that they are new, involve an inventive step and are susceptible of industrial application.

An invention shall be considered new if it does not form part of the state of the art, which comprises everything, inside or outside the country, made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the patent application.

An invention shall be considered involving an inventive step if it is not obvious to a person skilled in the art.

An invention shall be considered susceptible of industrial application if it can be made or used in any kind of industry, including agriculture.

A national patent confers on its owner the exclusive right to exploit the patented invention in Portuguese territory.
Legal framework

Patents are governed by:

i. Title II, Chapter I, Subchapter I of the Industrial Property Code (Articles 50 to 118)


Portugal became party to the Paris Convention in 1884.

Duration of right

Patent protection is granted up to a maximum period of 20 years from the date of filling of the patent application.

Ownership / licenses

Patents can be transferred in writing whether or not for financial reward.

Patents may also be licensed in writing, wholly or partially, whether or not for financial reward, on an exclusive or non-exclusive basis.

Transfer of ownership and licenses shall be recorded in the Portuguese Institute of Industrial Property to be effective against third parties.

Remedies for infringement

Whenever there is violation of or justified fear that another party may cause serious and difficult-to-repair harm to an industrial property right, including patent rights, the court may, at request of the interested party, order the appropriate measures to prevent any imminent violation or to prohibit continuation of the violation.

Whoever illegally violates the industrial property rights of another person with intent or by negligence shall be obliged to pay a compensation to the injured party for damages resulting from the violation.

In determining the amount of compensation for losses and damages, the court shall take into account the profit obtained by the infringer and the resulting damages and lost profits suffered by the injured party. The costs borne with the protection of the right in question and the investigation and termination of the harmful conduct shall also be taken in consideration, as well as personal injury.

If it is impossible to quantify the losses effectively suffered by the injured party, the court may, provided this is not opposed by the injured party, alternatively define a fixed amount with recourse to equity, that is based, as a minimum value, on the remuneration that the injured party would have received if the infringer had requested authorization to use the industrial property rights in question and the costs borne with the protection of the industrial property right and the investigation and termination of the harmful conduct.

Infringement of the exclusive right granted by a patent may be also punishable as crime with imprisonment up to 3

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years or a fine.

**TRADEMARKS**

**Nature of right**

A trademark may be composed by a sign (or a combination of signs) capable of being represented graphically (e.g., words, drawings, letters, numbers, sounds, colors, the shape of goods or of their packaging) or by a sign (or a combination of signs) which may be represented in a manner which enables to determine the clear and precise subject matter of the protection, provided that such signs are capable of distinguishing the goods or services of one company from those of other companies.

The registered trademark confers to the owner, the right to prevent third parties not having his or her consent, from using in the course of trade any sign which is identical or similar to the trademark in relation to goods and/or services which are identical or similar to those for which the trademark is registered and where, because of its similarity, there is a likelihood of confusion or association on the part of the public.

**Legal framework**

Trademarks are governed by:

i. Title II, Chapter IV of the Industrial Property Code (Articles 208 to 269)


Portugal became party to the Paris Convention in 1884.

Portugal became member of the Madrid Agreement in 1893.

Portugal became member of the Madrid Protocol in 1997.

**Duration of right**

National trademark registrations remain valid for 10 years starting from the date of filing of the application and may be indefinitely renewed for equal periods.

**Ownership / licenses**

Trademarks can be transferred in writing, wholly or partially, whether for financial reward or not.

Trademarks may also be licensed in writing, wholly or partially, whether for financial reward or not, on an exclusive or non-exclusive basis.

Transfer of ownership and licenses must be recorded in the Portuguese Institute of Industrial Property to be effective against third parties.
**Remedies for infringement**

Whenever there is violation of or justified fear that another party may cause serious and difficult-to-repair harm to an industrial property right, including trademarks, the court may, at request of the interested party, order appropriate measures to prevent any imminent violation or to prohibit continuation of the violation.

Whoever illegally violates the industrial property rights of another person with intent or by negligence shall be obliged to pay a compensation to the injured party for the damages resulting from the violation.

In determining the amount of compensation for losses and damages, the court shall take into account the profit obtained by the infringer and the resulting damages and lost profits suffered by the injured party. The costs borne with the protection of the right in question and the investigation and termination of the harmful conduct shall also be taken in consideration, as well as personal injury.

If it is impossible to quantify the losses effectively suffered by the injured party, the court may, provided this is not opposed by the injured party, alternatively define a fixed amount with recourse to equity that is based, as a minimum value, on the remuneration that the injured party would have received if the infringer had requested authorization to use the industrial property rights in question and the costs borne with the protection of the industrial property right and the investigation and termination of the harmful conduct.

Trademark counterfeiting is punishable as crime with imprisonment up to 3 years or a fine.

The sale of counterfeit products is punishable as crime with imprisonment up to 18 months or a fine.

**TRADE SECRETS**

**Nature of right**

Trade secrets may be defined as information that is secret in the sense that it is not common knowledge or easily accessible for persons in the circles that normally deal with the type of information in question, that has commercial value based on the fact that it is secret, and that has been the object of considerable diligences on the part of the person with legal control over it in order to keeping it secret.

**Legal framework**

Trade secrets are governed by:

i. Title III, Chapter II of the Industrial Property Code (Articles 313 to 315)

ii. Articles 195 to 197 of the Criminal Code

**Duration of right**

Information is protected as secret for so long as it qualifies as secret.

**Ownership / licenses**
The person with legal control over the information is the owner of the information.

**Remedies for infringement**

Whenever there is violation of or justified fear that another party may cause serious and difficult-to-repair harm to an industrial property right or a trade secret right, the court may, at request of the interested party, order appropriate measures to prevent any imminent violation or to prohibit continuation of the violation.

In case of trade secrets, the court shall take in consideration, notably, the value of the secret or other specific characteristics of the secret, the measures taken in order to protect it, the behavior of the infringer, the impact of the illegal use or disclosure, as well as the legitimate interests of the parties, third parties and public interest and the safeguard of fundamental rights. The judicial decision may impose to the infringer:

- The termination or, depending on the case, the prohibition of use or disclosure of the trade secret
- The prohibition of producing, offering, placing on the market or use of the products in infraction, or the importation, exportation and storage of products in infraction to such purposes

Whoever illegally violates trade secret rights of another person with intent or by negligence is obliged to pay a compensation to the injured party for the damages resulting from the violation.

In determining the amount of compensation for losses and damages, the court will take into account the profit obtained by the infringer and the resulting damages and lost profits suffered by the injured party. The costs borne with the protection of the right in question and the investigation and termination of the harmful conduct shall also be taken in consideration, as well as personal injury.

If it is impossible to quantify the losses effectively suffered by the injured party, the court may, provided this is not opposed by the injured party, alternatively define a fixed amount with recourse to equity that is based, as a minimum value, on the remuneration that the injured party would have received if the infringer had requested authorization to use the industrial property rights in question and the costs borne with the protection of the industrial property right and the investigation and termination of the harmful conduct.

The unlawful acquisition, use or disclosure of trade secrets (i.e., without the consent of the trade secret holder) is punishable with a fine between €5,000 and €100,000 if the infringer is a legal person, and from €1,000 up to €30,000 if the infringer is a natural person.

Trade secret violation or undue use may also be criminally punished with imprisonment up to 1 year or a fine.

**OTHER KEY IP RIGHTS**

**Nature of right**

**Logo**

A logo is a sign (or a combination of signs) capable of being represented graphically, in particular by word or figurative elements or by a combination of both, or a sign (or a combination of signs) which may be represented in a manner which enables to determine the clear and precise subject matter of the protection afforded to its proprietor, provided that such signs are capable of distinguishing an entity.
The registered logo confers to the owner, the right to prevent third parties not having his or her consent, from using any identical or confusing sign which is designed to identify an identical or similar activity and where, because of its similarity, there is a likelihood of confusion or association on the part of the public.

**Legal framework**

**Logos**

Logos are governed by Title II, Chapter VI of the Industrial Property Code (Articles 281 to 298).

**Duration of right**

**Logo**

Logos registrations remain valid for 10 years starting from the date of filing of the application and may be indefinitely renewed for equal periods.

**Ownership / licenses**

**Logos**

Logos can be transferred in writing, wholly or partially, whether for financial reward or not. When a logo is used in an establishment, the rights arising from the application for registration or registration of a logo may only be transmitted together with the establishment or part of the establishment to which they are connected.

On the other hand, the transfer of the establishment involves its logo, which may continue as it is registered, unless the transferor reserves it to another establishment, present or future.

Logos may also be licensed in writing, wholly or partially, whether for financial reward or not, on an exclusive or non-exclusive basis.

Transfer of ownership and licenses must be recorded in the Portuguese Institute of Industrial Property to be effective against third parties.

**Remedies for infringement**

**Logos**

Whenever there is violation of or justified fear that another party may cause serious and difficult-to-repair harm to an industrial property right, including logos, or a trade secret right the court may, at request of the interested party, order appropriate measures to prevent any imminent violation or to prohibit continuation of the violation.

Whoever illegally violates the industrial property rights or trade secret rights of another person with intent or by negligence will be obliged to pay a compensation to the injured party for the damages resulting from the violation.

In determining the amount of compensation for losses and damages, the court will take into account the profit obtained by the infringer and the resulting damages and lost profits suffered by the injured party. The costs borne with the protection of the right in question and the investigation and termination of the harmful conduct will also
be taken in consideration, as well as personal injury.

If it is impossible to quantify the losses effectively suffered by the injured party, the court may, provided this is not opposed by the injured party, alternatively define a fixed amount with recourse to equity that is based, as a minimum value, on the remuneration that the injured party would have received if the infringer had requested authorization to use the industrial property rights in question and the costs borne with the protection of the industrial property right and the investigation and termination of the harmful conduct.

Improper using of a logo is punishable as crime with imprisonment up to 3 years or a fine.

**INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT**

*Employees*

As a general rule, the copyright over a work made under a labor agreement or in compliance with functional obligations is determined by agreement between the parties. In case no agreement exists, it is presumed that the ownership over the work belongs to the respective intellectual creator. In case the name of the creator is not in the work, it is presumed that the copyright belongs to the entity for which the work was created. In specific circumstances, even if the patrimonial rights belong to the entity for which the work was made, the intellectual creator, in addition to the agreed remuneration, may have the right to a special remuneration.

In case of a computer program created by an employee in the exercise of his or her functions or according with the instructions provided by the employer, the employer shall be the owner of the rights over the programs, except when otherwise agreed or implied in the purposes of the contract. In specific circumstances, even if the patrimonial rights belong to the entity for which the computer program was created, the intellectual creator, in addition to the agreed remuneration, may have the right to a special remuneration.

The right to patent shall belong to the inventor or his or her successors in title. Notwithstanding, if an invention was made during the performance of an employment contract in which inventive activity is provided for, the right to the patent belongs to the employer.

*Consultants / contractors*

In principle, consultants and contractors will retain ownership of the intellectual property developed by them, unless otherwise agreed by the parties or provided for in the law.

**KEY COMMERCIAL CONTRACT CONSIDERATIONS**

*Registration of commercial agreements*

There are no general registration requirements for commercial contracts under Portuguese law; however, certain exceptions may arise. Furthermore, Industrial Property Rights licenses are subject to registration within the Portuguese Industrial Property Institute (INPI) in order to be enforceable against third parties.

*Recognized language of commercial agreements*
There are no general requirements under Portuguese law that provide that contracts must be written in Portuguese. However in certain cases (for instance, contracts with consumers), Portuguese language is mandatory, and, if the contract is to be used in specific situations (for example, for purposes of evidence in court or used with public authorities), translation to Portuguese is required.

**Country-specific issues for online content**


**Enforceability of online/clickwrap/shrinkwrap terms**

Online terms are, in principle, enforceable in cases where the legal requirements applicable to the agreement are met.

**Governing law**

The interpretation and enforceability of contracts is a matter of governing law. The choice of law by the parties is accepted as a general principle, except when otherwise provided for by law (please, however, note that in certain cases there are rules of mandatory application – for instance, in the scope of contracts concluded with consumers).

**KEY COMMERCIAL CONTRACT TERMS**

**Enforceability of warranty disclaimers**

This will depend on the specific warranty. Notwithstanding, the law may provide some restrictions on the enforceability of warranty disclaimers – eg, for reasons of consumer protection.

**Enforceability of exclusions/limitations of liability indemnification**

As general rule, the enforceability of exclusions or limitation of liability is limited under Portuguese law. According to civil law, limitation of liability or exclusion of liability concerns the grounds of liability itself and the damages and losses. The law is not absolutely clear when dealing with the matter; therefore, some hold the opinion that the law does not prevent clauses limiting or excluding liability for acts of mere negligence, while others suggest that all clauses of exclusion or limitation are completely null and void.

**Indemnification**

Indemnification clauses in contracts are, in principle, enforceable, but may be subject to restrictions provided for in the law. It is relatively common to stipulate in commercial agreements that the indemnifying party will indemnify and hold harmless the other party against claims of third parties related to the subject matter of the agreement.

**Electronic signatures**
According to Portuguese law, a qualified electronic signature is equivalent to an autographic signature in paper documents. An electronic document shall only be deemed to be signed for purposes of evidence where it meets the requirements set by the law on electronic signature and certification.

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INTELLECTUAL PROPERTY FRAMEWORK

Overview

As a general matter, intellectual property rights are governed by statutory provisions, which are generally harmonized across the European Union.

COMMERCIAL CONTRACT FRAMEWORK

Overview

Romania is a civil law jurisdiction. Under the new legal regime implemented by the New Civil Code (NCC), which entered into force in Romania as of October 1, 2011, commercial contracts are now referred to as contracts concluded between professionals. There are no general statutory provisions that govern contracts between professionals.

There are however statutory provisions that may be relevant to certain contracts concluded between professionals, eg, provisions regarding the price determination, and industry-specific provisions that may be applicable to contracts in particular industries.

Mandatory provisions on licensing and/or assignment of intellectual property rights may be found in various laws regulating the legal regime of such intellectual property rights.

The interpretation and enforceability of contracts concluded between professionals is generally a matter governed by the laws of the state specified in the contract. However, certain rights that are recognized by the Romanian copyright law, eg, moral rights, when the work has been published in Romania, may not be waived irrespective of the laws governing the merits of the contract. Case law is not a source of law.

Contracts with state government agencies are subject to separate public procurement laws, which can include, among other matters, the allocation of intellectual property rights that can be unilaterally decided by the contracting authority.
COPYRIGHTS

Nature of right

Copyrights are available for original works of authorship fixed in a tangible medium of expression. The rights arise at the time the original work of authorship is fixed in a tangible medium of expression, and registration is not required to validate the copyright. Registered copyrights are denoted by the symbol ©.

Copyright owners have a bundle of exclusive rights, which include the right to reproduce, distribute, prepare derivative works and publicly perform their works of authorship.

Legal framework

Law no. 8 of March 14, 1996 on copyright and neighboring rights governs copyright in Romania. Romania became signatory to the Berne Convention in 1926 and grants moral rights to authors, which may not be waived.

Duration of right

Copyright protection lasts for the life of the author plus an additional 70 years. In case of co-authored works, the 70 years term starts after the death of the last co-author. For anonymous works or pseudonymous works, the copyright endures for a term of 70 years from the year of its first publication.

Unpublished works that are lawfully disclosed to the public following the expiry of the copyright (eg, after the death of the author) are protected for 25 years starting from the date when they were disclosed.

For musical works with lyrics, the 70 year term is calculated from the death of the last survivor between the lyricist and the composer, whether or not they have been designated as co-authors, provided that the contribution made to that musical work has been specifically created for it.

These terms are calculated starting with January 1 of the next year following the death of the author or the public disclosure.

Ownership / licenses

Joint authorship is recognized in collective and common works. In case of collective works, the co-authors’ personal contributions may not be differentiated when taking into account the nature of the work and in such cases the copyrights are jointly exercised. Conversely, in case of works created in common, the personal contribution of each of the co-authors may be separated and utilized independently provided that such use does not harm the rights of the other co-authors. Except otherwise agreed, the co-authors of a common work may not utilize the work without having the joint consent of all co-authors.

Copyrights may be transferred by way of an assignment contract which must contain clauses referring to the patrimonial rights transmitted and must indicate each right transferred, the modalities of use, the duration and extent of the assignment, and the remuneration of the copyright holder. The absence of any of these provisions entitles the interested party to request the termination of the contract. Licenses are possible as well and their duration is limited to 49 years.

Remedies for infringement
Copyright registration is not required to claim damages for infringement.

Actual damages may consist of actual monetary loss suffered by the copyright owner and profits gained by infringer. In establishing the damages, the court takes into account criteria such as the negative economic consequences, particularly the non-earned benefit, the benefits earned unlawfully by the offender or other elements, such as the moral damages caused to the copyright holder. If these criteria may not be applied, the court may grant damages representing the triple of the amounts that would have been lawfully owed for a similar lawful utilization.

Attorneys’ fees of the copyright holder in a copyright infringement suit are available even if the work is not registered. Injunctive relief is also a possible remedy, including the ability to enjoin importation of infringing goods.

Copyright infringement may be considered a criminal offense in certain conditions punishable with criminal penalties or imprisonment.

**MASK WORKS / TOPOGRAPHIES**

*Nature of right*

Owners of original topographies have exclusive rights in relation to the topography of semiconductor products following their registration.

Topographies of semiconductor products are defined as a series of related images, however fixed or encoded, representing the three-dimensional configuration of the layers that make up a semiconductor product and in which each image reproduces the design or part of the drawing of a semiconductor surface at any stage of its manufacture.

Semiconductor products are defined as (i) the final or intermediate form of any product composed of a substrate that has a layer of semiconductor material, (ii) consisting of one or more layers of conductive, insulating or semiconducting materials, the layers being arranged according to a predetermined three-dimensional configuration, and (iii) such configuration is intended to perform, whether exclusively or not, an electronic function.

Subject to certain exceptions, owners of registered topographies have the exclusive rights to exploit the topography and to authorize or forbid the reproduction of the said topography and the commercial exploitation or import for this purpose of a topography or a semiconductor product made based on the said topography.

*Legal framework*

Topographies of semiconductors are governed by Law no. 16 of March 6, 1995 on the protection of topographies of semiconductor and are protected following their registration at the State Office for Inventions and Trademarks (SOIT).

*Duration of right*

The duration of protection is ten years and as a general rule this term is calculated from registration. Registration must be filed within two years from the first commercial exploitation.
Ownership / licenses

Common ownership of topographies is recognized and must be exercised jointly by creators.

Remedies for infringement

Infringement is considered a criminal offense punishable in certain conditions with imprisonment or a criminal fine.

Statutory damages are not available for owners of topography rights. The aggrieved party is entitled to claim actual damages which can be actual monetary loss suffered by the topography owner and loss of profit. Attorneys’ fees and costs can be recoverable.

Injunctive relief, including the seizure of infringing goods, is also a possible remedy.

PATENTS

Nature of right

Patents are a statutory right. 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 are protected for 20 years from the filing date of the application for registration.

Ownership / licenses

Joint ownership is permissible and patent rights must be exercised in common. If the inventor is an employee, the right to the patent belongs to the employer for (i) inventions made by the employee in the performance of a labor contract that provides for an inventive task entrusted explicitly, which corresponds to his/her functions or (ii) inventions made by the employee either in the exercise of his office or after the termination of the labor agreement for a period of no more than two years by knowing or using the technique or the specific means or data of the employer.

Remedies for infringement

Patent law permits an award of damages in an amount adequate to compensate for the infringement which includes the actual loss and loss of profit.

Injunctive relief is also a possible remedy.
Infringement of patent rights is a criminal offense in the form of counterfeit punishable by imprisonment in certain conditions.

**TRADEMARKS**

**Nature of right**

Any signs, in particular words, including personal names, or designs, letters, numerals, colors, the shape of goods or of the packaging of goods, or sounds, provided that such signs (i) are capable of distinguishing the goods or services of one undertaking from those of other undertakings, and (ii) being represented on the register in a manner that enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.

**Legal framework**

Law no. 84 of March 30, 1998 on trademarks and geographical indications provides protection for registered marks.


**Duration of right**

National trademark registrations are in effect for ten years and are renewable indefinitely so long as the mark’s use in commerce continues.

**Ownership / licenses**

Owners may grant licenses to third parties, but there are no statutory requirements regarding specific clauses referring to appropriate quality control language in order to preserve and avoid dilution (or loss) of the mark.

**Remedies for infringement**

Damages can include actual damages and/or loss of profits resulting from the infringement. Trademark infringement is considered a criminal offense punishable in certain conditions with imprisonment.

Costs and reasonable attorneys’ fees are recoverable.

Injunctive relief is also an available remedy. The owner of the registered marks may file a request for intervention with the Romanian customs in order to prevent importation of counterfeit products.

**TRADE SECRETS**

**Nature of right**

Legal protection is available for trade secrets holders against unlawfully acquired, used or disclosed trade secret.
Trade secrets are defined as information which (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) it has commercial value because it is secret, and (iii) it has been subject to reasonable steps under the circumstances, by the person lawfully in control of the information, to keep it secret.

**Legal framework**

Trade secrets are protected under Law no. 11 of January 29, 1991 on fighting unfair competition.

**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.

**Remedies for infringement**

Damages can include actual loss and loss of profit.

Statutory attorneys' fees can also be awarded.

Disclosure, acquisition or use of commercial secrets by third parties as a result of commercial or industrial espionage is considered a criminal offense punishable with imprisonment or criminal penalties provided that the interests of the trade secrets holder are affected. Thus, seizures of property connected with the trade secrets are possible.

**OTHER KEY IP RIGHTS**

**Nature of right**

**Industrial designs**

Industrial design holders are protected against infringement. The term industrial design is defined as the appearance of a product or a two or three dimensional part of it resulting from the combination of the main features (especially lines, contours, colors, shape, texture and/or ornamentation of the product itself).

**Legal framework**

Industrial designs are protected under Law no. 129 of December 29, 1992 on the protection of industrial designs.

**Duration of right**

The registration certificate is valid for ten years from the filling date of the application for registration and can be
renewed for up to three consecutive five year periods.

**Ownership / licenses**

Joint ownership is possible. Rights over industrial designs may be transferred by way of assignments and/or licenses.

**Remedies for infringement**

Damages can include actual damages or loss of profit resulting from the infringement. Industrial design infringement is considered a criminal offense punishable in certain conditions with imprisonment.

Costs and reasonable attorneys' fees are recoverable.

Injunctive relief is also an available remedy. The owner of the industrial design may file a request for intervention with the Romanian customs in order to prevent importation of counterfeit products.

**INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT**

**Employees**

**Inventions/patents**

Under the Labor Inventions Law, the employer owns the rights over inventions resulting from the exercise of the inventor's job specifications expressly mentioned in his employment agreement and in the job description sheet or mentioned in other binding material for the inventor that provides for an inventive mission and over inventions created while the inventor is an employee, as well as for inventions created after termination of employment for a maximum of two years after the termination of the employment agreement, by knowing or using the employer's experience and material resources, as a result of the professional training acquired offered to the employee at the expenses of the employer or by the use of information derived from the employer's activity. Inventions must be disclosed at once to the employer. In this case, the employer has four months (subject to a longer term provided in the internal regulation) to categorize the invention as a labor invention and to claim ownership over the invention. If the employer does not claim ownership, the invention belongs to the employee.

Employers can benefit from a non-exclusive license granted by the employee for the patented invention if the employer no longer wishes to continue with the post-filing procedures for the invention or is not interested in protecting the invention in some states other than Romania.

However, employees own the rights to inventions developed by employees entirely on their own time without use of employer resources and that are unrelated to the employer's business.

**Copyright**

As a general rule, employees own the copyright for works created in the exercise of their duties described in their labor contract. In this case, the employee may authorize the use of such work by third parties only with the consent of the employer and after compensating the employer for the costs incurred for the creation of the work. The employer is not required to obtain the employee's authorization for the use of the work within its scope of activity.
Specific rules are applicable to computer programs created by employees in the exercise of their duties or following the instructions of employer. In this case, the patrimonial rights over the computer programs belong to the employer subject to a contrary provision in the labor contract. However, the direct enforceability of such provision in the absence of a specific assignment provision in the labor contract is under current debate.

**Consultants / contractors**

It is customary for consultants and contractors to sign written agreements. As a general rule, the written form of the agreement is mandatory in order to prove the content of such agreement.

**KEY COMMERCIAL CONTRACT CONSIDERATIONS**

**Registration of commercial agreements**

Trademark and industrial design licenses and assignments must be registered with the SOIT for opposability purposes.

**Recognized language of commercial agreements**

There are no mandatory requirements in relation to the language of contracts concluded between professionals. However, legalized translations into Romanian are necessary for court proceedings purposes. For contracts concluded with consumers, Romanian language is mandatory.

**Country-specific issues for online content**

Law no. 365 of May 9, 2002 regarding e-commerce (E-Commerce Law) sets out the conditions for the provision of internet based services and incriminates criminal offenses related to the security of the domains used in electronic commerce, the issuance and use of electronic payment instruments and the use of identification data for the purpose of conducting financial transactions.

The E-Commerce Law features a safe harbor provision for Internet service providers to avoid liability for infringement claims arising from storing or transmitting information provided by a recipient of that service if certain conditions are met such as for example, if the service provider is unaware that the stored activity or information is unlawful and, in respect of damage claims, is unaware of facts or circumstances that indicate that the activity or information in question could harm the rights of a third party.

**Enforceability of online(clickwrap/shrinkwrap terms**

Online, clickwrap and shrinkwrap agreements are generally viewed as enforceable if they are conspicuous and users have an opportunity to review and indicate affirmative assent (such as through checking a box). However, unusual clauses (such as limitation of liability clauses or clauses containing the right to unilaterally terminate the contract or to suspend the performance of the obligations and the like) must be expressly accepted in writing in order to be enforceable.

**Governing law**
Governing law and venue for resolution of disputes specified in a contract will generally be accepted and recognized subject to mandatory provisions in relation to the jurisdiction of the Romanian courts.

Jurisdictions clauses in consumer contracts that provide for a different court than the court located in the area where the consumer lives are not enforceable if signed before the consumer’s right to damages arises.

**KEY COMMERCIAL CONTRACT TERMS**

*Enforceability of warranty disclaimers*

Sellers, in their contracts for the sale of goods under Article 1699 of the NCC, may not exclude completely their liability for damages caused by their own actions or generated by reasons known by the seller at the time of sale which were hidden from the buyer. Enforceability of disclaimers against consumers is of limited applicability as it is mandatory for companies to offer warranty for the products/services sold to consumers.

*Enforceability of exclusions/limitations of liability indemnification*

Sellers, in their contracts for the sale of goods under Article 1709 (2) of the NCC, may limit their liability for hidden defects. A cap on direct damages or aggregate liability is also possible.

*Indemnification*

Express indemnities stated in contracts are recognized and generally respected. Such express indemnity may be censored by Romanian courts in very limited situations.

Implied indemnities are possible as well and usually include the loss actually suffered by the aggrieved party and loss of profit. In determining the extent of the indemnity, account is also taken of the costs incurred by the aggrieved party, within a reasonable limit, to avoid or limit the damage.

Express indemnities based on comparative fault are enforceable.

Caps on liability under indemnification provisions can be enforceable.

*Electronic signatures*

Law no. 455 of July 31, 2001 regarding electronic signatures grants advanced electronic signatures the same legal standing as pen-and-paper signatures subject to the fulfillment of several conditions. To this end, an advanced electronic signature must be

- Uniquely linked to the signatory
- Capable of identifying the signatory
- Created by means solely under the control of the signatory party
- Linked to the data signed therewith in such a way that any subsequent change in the data is detectable
RUSSIA

INTELLECTUAL PROPERTY FRAMEWORK

Overview

As a general matter, intellectual property rights are governed by Part IV of the Russian Civil Code.

COMMERCIAL CONTRACT FRAMEWORK

Overview

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).

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

iv. Demand seizure of media bearing infringing objects

**MASK WORKS / TOPOGRAPHIES**

**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.

**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

iii. Demand seizure of media bearing infringing objects; criminal penalties may also apply under certain circumstances

**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 year 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

iii. Demand seizure of media bearing infringing objects; 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 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. The transfer of rights under both trademark assignment and licenses must be registered with the 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

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

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.

OTHER KEY IP RIGHTS

Nature of right

Not applicable.

Legal framework

Not applicable.

Duration of right

Not applicable.

Ownership / licenses

Not applicable.

Remedies for infringement

Not applicable.

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 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 content

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 (eg, 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 (eg, 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 indemnification

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 currently recognized as enforceable in Russia, but in limited scope, and this concept is still very new and untested.

Electronic signatures

The requirements for electronic signature (ES) in Russia are regulated by Federal Law "On the electronic signature" dated April 6, 2011 (ES Law). Under ES Law, the electronic signature made on an electronic document is equivalent to a handwritten signature on an ordinary paper document. The electronic signature technically represents a number of symbols attached to an electronic document that is being signed and that identifies the signatory.

There are two types of the electronic signatures:

- Simple electronic signature
- Enhanced electronic signature.

Depending on the level of encryption protection, enhanced electronic signatures may be "unqualified" or "qualified".

A simple electronic signature is an electronic signature formed by the use of codes, passwords and other means that confirm the formation of the electronic signature by a particular person. As opposed to unqualified and qualified enhanced electronic signature, simple electronic signature is not produced by a certification center.

The ES Law states that any electronic message signed with a simple electronic signature is deemed to have the same legal effect as a paper document signed by hand, provided that:

i. The parties have expressly agreed to use electronic signature when exchanging messages through the relevant electronic messaging system

ii. Rules established in the relevant electronic messaging system for use of electronic signatures are complied with
iii. The electronic message contains information regarding the person on behalf of whom the electronic message was generated and/or sent

iv. The parties' agreement on exchanging messages through an electronic messaging system must at least also contain provisions related to:

- Identification of a person signing electronic messages based on its simple electronic signature
- The parties’ obligation to keep the means for generating the simple electronic signature (e.g., codes, passwords) confidential

An enhanced electronic signature is produced by certification centers (accredited certified centers in case of qualified electronic signature) and shall be used in documents which require a seal. The enhanced electronic signature is more protected compared to the simple electronic signature, and its validity is subject to control by relevant certification centers. Enhanced electronic signatures are created by cryptographic processing of information by an electronic signature key and they help to identify the person that signed the document or made changes to such document.

The qualified type of enhanced electronic signature is even more protected and it has a specific qualifying certificate created by means approved by the competent state authority. The qualified type of enhanced electronic signature is produced by certified centers accredited by Ministry of Telecom and Mass Communications of the Russian Federation. The Ministry keeps a register of qualified electronic signature that can be accessed to verify such electronic signature.

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SAUDI ARABIA

INTELLECTUAL PROPERTY FRAMEWORK

Overview

Intellectual property rights are protected by a number of 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 Shari’a principles.

The KSA generally operates by reference to the Hijri (or Islamic) calendar for official purposes. Careful attention is therefore required when making reference to protection periods and any timeframes associated with the different intellectual property rights, to ensure that relevant deadlines are not inadvertently missed.

COMMERCIAL CONTRACT FRAMEWORK

Overview

The KSA does not have a formal dedicated code or legislation as such setting out the principles of contract law. The key principles of contract law derive from Shari’a (or Islamic) principles, the primary source of law in the KSA, but which are not codified.

In addition, the law in the KSA consists of legislation passed by government (which is secondary if it conflicts with Shari’a principles), which also govern commercial activities in the KSA. For example, additional requirements apply to procurement and contracting with government entities under the Government Tenders and Procurement Law (enacted by Royal Decree No. M/58, dated 4 Ramadan 1427H (corresponding to 27 September 2006)), and its Implementing Regulations. The Saudi Arabian Monetary Authority (SAMA) oversees, amongst other things, banking activities in the KSA.

There is no concept of judicial precedent in the KSA, 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/authorities in the KSA would view a particular matter.
COPYRIGHTS

Nature of right

Under the Copyright Law, copyright protection applies to works "created in the fields of literature, art and sciences, irrespective of their type, means of expression, importance or purpose of authorship."

The Copyright Law covers 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. Copyright Law also affords extensive moral rights to the author of a copyright work, which are considered 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 or, if there are no heirs, to the Ministry of Culture and Information).

Assignment by an author of all his future intellectual production is, under the 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.

Legal framework

The Copyright Law (promulgated by Royal Decree No. M/41 of 2 Rajab, 1424 (corresponding to 30 August 2003)), and its Implementing Regulations (Copyright Law).


Duration of right

The period of copyright protection for an author is the duration of his/her lifetime and 50 years following his/her death. For joint works, the period of protection is computed from the date of the death 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.

Where the author is a corporate entity, the period of protection is 50 years from the date of first publication.

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 is 25 years from the date of first publication.
The period of protection for broadcasting organizations is 20 years from the date of the first transmission of programs or broadcast materials.

The period of protection for the producers of sound recordings and performers is 50 years from the date of performance or its first recording.

Ownership / licenses

Joint ownership of copyright is recognized. Any transfer of copyright must be recorded in writing and must express any limits to the scope of the transferred right with respect to both time and place.

Remedies for infringement

A wronged party can seek damages/compensation for infringement of its rights and damage suffered. In addition, the Copyright Law stipulates certain penalties for infringement, including:

i. A warning to the offender

ii. A fine not exceeding SAR 250,000

iii. Naming and shaming of the violator (at the violator’s expense) by a method deemed appropriate by the competent committee (which is formed by decision of the Minister of Culture and Information to review violations)

iv. An injunction against the printing, production, publication or distribution of the work infringed upon, in addition to impounding of related copies and materials, and any temporary measure the competent committee finds necessary to protect the copyright works until a final decision is reached regarding the complaint/offence

v. A temporary shutdown of the offending establishment for a maximum of two months

vi. A suspension from participating in specific commercial events (if the infringement was discovered during any such commercial events) for a period of up to two years

vii. Confiscation of violating goods/copies of the work and the materials used or intended for use in copyright infringement

viii. A jail term of up to six months

It is notable that repeat offences of infringement may result in doubling of maximum penalties.

MASK WORKS / TOPOGRAPHIES

Nature of right

In the KSA, protection is available for layout designs of integrated circuits.
Any layout design of integrated circuits that is to be protected must be "original" in the sense that it must be the result of its creator's own intellectual effort, and is not commonplace among creators of layout designs and manufacturers of integrated circuits at the time of its creation.

Applications for registration of a layout design of an integrated circuit are made to the King Abdulaziz City for Science and Technology (KACST).

Legal framework


Duration of right

Layout-design certificate protection is valid for ten years from the date of filing the application for registration or 10 years from the date on which it was first commercially exploited anywhere in the world (but in any case no longer than 15 years from the date of creation of the layout design).

Ownership / licenses

A layout design may be assigned or licensed to a third party by the registered owner, in accordance with the requirements of the Patents Law.

There are certain circumstances where compulsory licenses may be granted by KACST to a third party to exploit a layout design covered by a certificate of design.

Remedies for infringement

A wronged party can seek damages/compensation for infringement of its rights and harm suffered. In addition, the Patents Law stipulates certain penalties for infringement (without prejudice to further liability which may arise from other laws), including:

i. An injunction

ii. A fine of up to SAR 100,000 (which may be doubled for a repeat offender)

iii. A possible jail term (including referral to the Board of Grievances)

iv. Naming and shaming in two daily newspapers and the Official Gazette (the cost of which is borne by the party in breach)

v. Any other prompt measures considered necessary to prevent damages resulting from the infringement

PATENTS

Nature of right
A patent may be issued on an invention, if it involves an inventive step, and is capable of industrial application. The invention may be a product, process or related to either.

Applications for registration of patents are made to KACST.

**Legal framework**


**Duration of right**

Patent protection in the KSA is valid for a period of 20 years from the date of filing the application.

Note that it is also possible to file a GCC patent application which, if granted, affords protection of the patent in the six GCC countries. Subject to the continued payment of maintenance fees, the term of a GCC patent application is 20 years from the filing date.

**Ownership / licenses**

A patent may be assigned or licensed to a third party by the registered owner, in accordance with the requirements of the Patents Law.

There are certain circumstances where compulsory licenses may be granted by KACST to a third party to exploit an invention covered by a patent.

**Remedies for infringement**

A wronged party can seek damages/compensation for infringement of its rights and harm suffered. In addition, the Patents Law stipulates certain penalties for infringement (without prejudice to further liability which may arise from other laws), including:

i. An injunction

ii. A fine of up to SAR 100,000 (which may be doubled for a repeat offender)

iii. A possible jail term (including referral to the Board of Grievances)

iv. Naming and shaming in two daily newspapers and the Official Gazette (the cost of which is borne by the party in breach)

v. Any other prompt measures considered necessary to prevent damages resulting from the infringement

**TRADEMARKS**

**Nature of right**
Trademarks must generally take a distinctive form and be capable of distinguishing goods or services.

The GCC Trademark Law provides an indicative list of registrable trademarks, including names, words, signatures, characters, codes, numbers, titles, seals, drawings, images, inscriptions, packaging, figurative elements, shapes or colour, group of colours or combinations of colours. Unconventional marks such as sounds and smells are now also registrable under the GCC Trademark Law.

The KSA has adopted and applies the Nice Classification for the purposes of registration of marks.

An application for trademark registration is submitted to the Trademarks Office at the Ministry of Commerce and Investment. A person who has a registered trademark is its exclusive owner, and the use of a registered trademark by any other person requires the consent of the owner.

Legal framework

With effect from 29 September 2016, the KSA adopted the GCC Trademark Law (Law No. 1/1437 of 13 Dhu'l-Hijjah 1437 H (corresponding to 29 September 2016)), and its Implementing Regulations (GCC Trademark Law). The GCC Trademark Law replaces the former KSA Trademark Law that was in place since 2002.

Note that the GCC Trademark Law does not establish a unitary registration system – it contains a single set of provisions which apply across all GCC countries, but it does not envisage a single registration or enforcement system (ie, a "GCC mark" will still require six separate, national applications).

Duration of right

The period of protection for a trademark is 10 years (subject to rights of renewal).

Ownership / licenses

A trademark may be sold or licensed to a third party by the registered owner, in accordance with the requirements of the GCC Trademark Law.

Remedies for infringement

A wronged party can seek damages/compensation for infringement of its rights and harm suffered. In addition, the GCC Trademark Law stipulates certain penalties for trademark infringement depending upon the nature of the offense. For example, it is an offense to, amongst others, counterfeit or imitate a registered trademark so as to mislead or confuse the public, or to use in bad faith a trademark owned by others on goods or services (without authorization). These offenses carry a jail sentence of between one month to three years or a fine between SAR 5,000 and SAR 1 million, or both. Penalties may be doubled for repeat offenders. Additional penalties may include potential closure of the place of business for between 15 days to six months and publication of the decision at the expense of the offender.

TRADE SECRETS

Nature of right
A commercial secret is defined under the Trade Secrets Regulations 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. However, the Trade Secrets Regulations do not protect commercial secrets which are inconsistent with Shari'a, public order and/or public morals.

Obtaining, using or disclosing any commercial secret in a manner that is inconsistent with "honest commercial practices" and without the consent of the rightful owner is deemed an abuse of the commercial secret under the Trade Secrets Regulations.

**Legal framework**

Trade secrets are governed by the Regulations for the Protection of Confidential Commercial Information issued by Ministry of Commerce and Industry Decision No. 3218 (as amended), passed in 2005 (Trade Secrets Regulations).

**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 Trade Secrets Regulations do not expressly provide for a limit on the duration of the right (although a minimum protection period of five years is specified (subject to limited exceptions) in the context of secret information submitted to an official competent authority for the purpose of approval of the marketing of drugs or chemical agricultural products in which new chemical substances are used).

**Ownership / licenses**

Trade secrets or know-how licenses are, in principle, enforceable.

**Remedies for infringement**

Remedies include a claim for compensation for damages for any person harmed as a result of a violation of the provisions of the Trade Secrets Regulations.

**OTHER KEY IP RIGHTS**

**Nature of right**

Not applicable.

**Legal framework**

Not applicable.

**Duration of right**

Not applicable.
Ownership / licenses

Not applicable.

Remedies for infringement

Not applicable.

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

Employees

There are no regulatory protections that specifically cover employees in the Trade Secrets Regulations. However, agreed confidentiality provisions in an employment contract may grant certain levels of protections.

The Copyright Law restricts the right to assign copyright in future works (any such purported assignment is deemed "null and void"). 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 that suitable intellectual property rights provisions are used, as those rights will not automatically vest in the employer.

The general position under the Patents Law is that the employer shall be the owner of the relevant protection document (a patent, or a certificate of layout design), subject to certain stipulated requirements and exceptions in the Patents Law. There are however provisions in the Patents Law that provide for an employee’s right to receive a special award (either agreed between the parties or a committee formed with members nominated by the President of KACST).

Consultants / contractors

Please see our comments in relation to employees, which are also relevant here.

KEY COMMERCIAL CONTRACT CONSIDERATIONS

Registration of commercial agreements

There is generally no legal requirement for commercial contracts to be registered (subject to certain exceptions, for example registration of qualifying agency, distribution and franchise agreements with the Ministry of Commerce and Investment).

Recognized language of commercial agreements

Generally, there is no legal requirement to execute contracts in Arabic, although there are exceptions. It is however important to bear in mind that, if brought before the KSA courts/authorities, contracts and related documentation will need to be in the Arabic language or translated into Arabic by a certified translator.

Country-specific issues for online content
Not applicable.

**Enforceability of online/clickwrap/shrinkwrap terms**

The enforceability of online terms (including whether the user has given appropriate consent to such terms) should be reviewed on a case-by-case basis.

**Governing law**

Contracting parties generally have the right to choose the governing law of a contract. However, even if the parties state the law of a foreign jurisdiction as the governing law of the contract, if it is considered that there is sufficient nexus to the KSA, there is a risk that the courts in the KSA may in their absolute discretion accept jurisdiction and hear any dispute. If a KSA court accepts jurisdiction over a dispute, it will apply KSA law.

Consideration should be given to the most suitable governing law and jurisdiction for resolving disputes to be specified in the contract, depending upon the nature of the contract and specific circumstances.

**KEY COMMERCIAL CONTRACT TERMS**

**Enforceability of warranty disclaimers**

Warranty disclaimer language must be considered on a case-by-case basis. Such language is generally subject to review by the KSA courts, which will likely assess whether the wording fairly allocates risk between the parties.

**Enforceability of exclusions/limitations of liability indemnification**

Exclusions/limitations of liability are rarely enforced in the KSA courts even if the parties to a commercial contract agree to such limitation.

**Indemnification**

The enforceability of an indemnification obligation is ultimately subject to court evaluation and discretion. That said, a party is only likely to be held liable under an indemnity if found to be a direct cause of losses which have been actually incurred by the party benefiting from the indemnity. Indirect and consequential losses are unlikely to be recoverable.

**Electronic signatures**

The Electronic Transactions Law (ETL), issued by Royal Decree No. M/8 and dated 26 March 2007, provides guidelines for the use of electronic transactions (defined broadly as "any exchange, communication, contracting or other procedure, performed or executed, wholly or partially, by electronic means") and electronic signatures (defined as "electronic data included in, attached to or logically associated with an electronic transaction used to verify the identify and approval of the person signing it and to detect any change to the transaction after signature"). The ETL in principle recognizes the legal effect of "electronic signatures" provided that certain conditions, requirements and specifications are met under the ETL and its Implementing Regulations (No. 1/1429 and issued on 18 March 2008). There are a number of documents and transactions to which the ETL does not apply (for example, transactions relating to personal status law, amongst others).
As there is no system of precedent and cases are not published as a matter of course, the extent to which a KSA court would enforce an electronic signature is uncertain, particularly if the veracity of such signature is challenged. Depending upon the circumstances, it may be prudent to have contracts/documents also physically signed on paper by the relevant parties.

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Last modified 01 January 2019

INTELLECTUAL PROPERTY FRAMEWORK

Overview

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), Registered Designs Act (Cap. 266), Trademarks Act (Cap. 332), among others (as amended and supplemented from time to time). The Intellectual Property Office of Singapore (IPOS) oversees and advises on the application of this legislation.

COMMERCIAL CONTRACT FRAMEWORK

Overview

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 in frustrated contracts (Frustrated Contracts Act (Cap. 115)).

The Electronic Transactions Act (Cap. 88) applies to contracts concluded online and is the primary legislation governing e-commerce in Singapore.

COPYRIGHTS

Nature of right

Copyright protects literary, dramatic, musical and artistic works and other subject matter, such as sound recordings, films, broadcasts, cable programs and published editions of 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 in writing or as a recording. Ideas or concepts alone are not protected.
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. The Copyright Act (Cap 63) is being reviewed by the Ministry of Law to take into account, among other things, whether Singapore should have a voluntary system of copyright registration.

Any artistic work which is applied to a product and industrially produced does not 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. Generally, 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 and cable programs 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 or her employment contract, the employer will own the copyright; 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/engraved 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. They may also license their copyrights either partially or wholly. Future copyrights for a work that has yet to be produced can also be licensed. The license can be exclusive or non-exclusive.

**Remedies for infringement**

Copyright infringement occurs when one of a copyright owner’s exclusive rights are violated (ie, when another party copies, distributes, performs or displays all or part of a copyright work without the permission of the copyright owner). To establish copyright infringement, a copyright owner must establish proof of copyright ownership and proof of copying.

Infringement also occurs if a person imports infringing copies for sale or distribution, sells (including distributes for trade or any other purpose to an extent that affects prejudicially the copyright owner) or lets for hire infringing copies or offers infringing copies for sale or hire by way of trade.
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.

Manufacture of infringing copies for sale, sale of infringing copies, possession or importation of infringing copies for trade or any other purpose to such an extent as to affect the owner prejudicially and willful infringement of copyright for the purposes of commercial advantage and/or to an extent that is significant are criminal offences, subject to fines and/or imprisonment.

MASK WORKS / TOPOGRAPHIES

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 or file the layout-design with the IPOS. A citizen or resident of Singapore, or of 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 10 years if it is first used commercially within 5 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.

The owner of a layout-design may copy and/or commercially exploit the layout-design, as well as authorize the copying and/or the exploitation of the layout-design. Rights in a protected layout-design may be assigned or licensed and it is possible to sign an agreement assigning future rights in a layout-design that is expected to come into existence.

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 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**


**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 prevent others from exploiting their inventions, use the patents to raise funds for their businesses, license the patents to third parties for commercial returns or sell the patented inventions.

Patent owners interested in licensing their patents to a third party may endorse such patents with a license of right (LOR) after they are granted, by way of applying for an LOR entry to be made in the Patents Register. An LOR may help a patent owner attract licensees and reduce the amount of renewal fees that are payable after the LOR entry is made.

**Remedies for infringement**

The patent owner and his exclusive licensee are entitled to take legal action against an infringing party. Remedies available to the patent owner and his exclusive licensee 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 used by a trader 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 10 years. Protection of a registered trademark will take effect from the date the trademark application is filed provided the trademark application is granted.

Ownership / licenses

The owner of a trademark may authorize others to use their trademark by way of license or assignment. The licensing or assignment may be granted for all or only some of the goods or services covered by trademark registration or application.

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.

OTHER KEY IP RIGHTS

Nature of right

Not applicable for this jurisdiction.

Legal framework

Not applicable for this jurisdiction.

Duration of right

Not applicable for this jurisdiction.

Ownership / licenses

Not applicable for this jurisdiction.

Remedies for infringement

Not applicable for this jurisdiction.

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT
**Employees**

If a trademark, work or a design is created by an employee in the course of his or her employment, the trademark, work or design will, in accordance with the relevant statute, be owned by default by the employer rather than the employee unless there are agreements between the employer and employee to the contrary.

It is commonplace for employers to include confidentiality clauses in employment agreements in Singapore.

**Consultants / contractors**

If a piece of work is commissioned, the creator will generally be the owner of the copyright (subject to the information in the copyright section – ownership/licenses), unless otherwise agreed in writing.

It is commonplace for contractors and consultants to be subject to confidentiality clauses in Singapore.

### 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.

#### Country-specific issues for online content

All Internet Content Providers are automatically granted class licenses under the Broadcasting (Class License) Notification (Notification) and are required to comply with the Class License Conditions set out under the Notification and the Internet Code of Practice.

"Internet Content Provider" is defined in the Notification as, among other things, "any corporation or group of individuals (including any association, business, club, company, society, organization or partnership, whether registrable or incorporated under the laws of Singapore or not) who provides any program on the World Wide Web through the Internet."

The Internet Code of Practice issued by the Infocomm Media Development Authority (IMDA) under the Notification requires Internet Content Providers to, among other things, deny access to material considered by the IMDA to be prohibited material if required to do so by IMDA. "Prohibited material" includes material which glorifies, incites or endorses ethnic, racial or religious hatred, strife or intolerance.

#### 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 legislation 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.

**KEY COMMERCIAL CONTRACT TERMS**

**Enforceability of warranty disclaimers**

The Sale of Goods Act (Cap. 393) implies a number of terms into the agreement, including, for example, implied conditions as to the seller’s title to the goods and as to the goods being of satisfactory quality.

While it is not uncommon for a seller to disclaim warranties as to goods, where the contract for a sale of goods is entered into with a consumer, the Unfair Contract Terms Act (Cap. 396) will apply to restrict the ability of the seller to limit their liability in respect of:

- The implied conditions under the Sale of Goods Act (Cap. 393) as to the goods being of satisfactory quality and
- The implied conditions under the Sale of Goods Act (Cap. 393) as to title.

In addition, the Consumer Protection (Fair Trading) Act (Cap. 52A) will apply to consumer contracts alongside the Sale of Goods Act (Cap. 393). If the goods do not conform to the applicable contract at the time of delivery, consumers have the right to require the seller to:

- Repair the goods
- Replace the goods
- Reduce the amount paid for the goods by the consumer or
- Rescind the contract of sale

**Enforceability of exclusions/limitations of liability indemnification**

Exclusions and limitations of liability are common and generally enforceable in Singapore.

However, this is subject to the Unfair Contract Terms Act (Cap. 396). For example, under Section 2(1) of the Unfair Contract Terms Act (Cap. 396), a person cannot exclude or restrict their liability for death of personal injury from negligence while Section 3(2)(a) of the Singapore Unfair Contract Terms provides that 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 or relies on any term to render a different kind of service from that which was reasonably expect of him (or not render any service at all), 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 negligence or breach of contract, except in so far as the contract term satisfies the requirement of reasonableness.

**Electronic signatures**

Electronic signatures are, in most circumstances, recognized and enforceable in Singapore. Save for excluded matters set out in the First Schedule of the Electronic Transactions Act (Cap. 88) (such as wills, negotiable instruments and contracts relating to land), an electronic record or signature will not be denied effect by virtue of the signature being electronic. Where a signature is required under law, that requirement is satisfied in relation to an electronic record if a method is used to identify that person and indicate his intention in respect of the information contained therein and the method used is either:

- Reliable for the purpose of the electronic record, considering all the circumstances
- Proven in fact to have identified the person and indicate his intention in respect of the information contained therein
INTELLECTUAL PROPERTY FRAMEWORK

Overview

There is no complex legislative act governing intellectual property rights as objects of legal protection in the Slovak Republic. Instead, intellectual property rights are subject to national law, law of the European Union and international law.

As regards the national regulation, this is divided into various specific legal acts concerning the respective object of intellectual property.

These objects may be:

- copyright, rights related to the copyright;
- industrial rights, rights similar to the industrial rights.

In addition, there are several regulations of the European Union on intellectual property which apply in the territory of the Slovak Republic, as one of the member states of the European Union. Also, the directives of the European Union on intellectual property have been implemented into the legal order of the Slovak Republic. The international treaties governing the intellectual property rights, applicable in the Slovak Republic, are stated in the following text as well.

COMMERCIAL CONTRACT FRAMEWORK

Overview

Not applicable for this jurisdiction.

COPYRIGHTS

Nature of right
An object of copyright shall be a work in the field of literature, art or science, which is a unique result of the creative intellectual activity of the author. Such a work must be perceptible through senses, regardless of its form, content, quality, purpose, form of expression or phase of completion. The author of a work is a natural person who has created the work. The copyright arises at the time when a work is objectively expressed in a form perceptible by senses.

Copyright includes exclusive personal rights and exclusive property rights.

The author has the exclusive personal rights to decide to publish or not to publish the work, to be identified as the author and to decide on the way of such identification. The author has the right to authorship of the work. The author’s work shall be protected against any unauthorized alteration or other unauthorized interference. The author cannot waive these rights. These rights are not transferable and they cease to exist upon the author’s death.

In addition, the author has the exclusive property rights to use the work and to grant consent with the use of the work to somebody else. The author also has the right to remuneration for the use of work. The use of work includes processing of the work, reproduction of the work, public dissemination of the original of the work or the copy of the work by transfer of ownership or by borrowing or making the work available to the public. The author, as the licensor, grants such consent to the licensee in the license agreement. Author’s property rights do not expire by granting consent with the use of the work. However, the author is obliged to tolerate the use of the work by licensee within the scope of the granted consent.

If two or more authors have created a single work in such a way that it is not possible to distinguish their individual creative contributions, they are considered to be co-authors. In such a case, the personal and property rights shall belong to all co-authors jointly and severally unless the co-authors have agreed otherwise in writing.

As regards the rights related to the copyright, these are:

- the rights of a performing artist (eg, a singer, musician, conductor, actor, dancer);
- the rights of a producer of a sound record;
- the rights of a producer of an audiovisual record;
- the rights of a broadcaster.

The general provisions relating to the copyright shall apply accordingly to these specific authors of works.

**Legal framework**

The copyright is governed by Slovak Act No. 185/2015 Coll., the Copyright Act, as amended (Copyright Act). In addition to the Copyright Act, the Slovak Act No. 40/1964 Coll., the Civil Code, as amended (Civil Code) is applicable as the general regulation. As regards the criminal sanctions resulting from the infringement of the copyright, the Slovak Act No. 300/2005 Coll., the Criminal Code, as amended (Criminal Code) shall apply. Slovak Republic is signatory of several international agreements as well:

- Berne Convention for the Protection of Literary and Artistic Works
• WIPO Copyright Treaty, Rome Convention for the Protection of Performers
• Producers of Phonograms and Broadcasting Organizations
• Convention for the Protection of Producers of Phonograms Against
• Unauthorized Duplication of their Phonograms

**Duration of right**

The copyright exists from the moment when the work is objectively expressed in a way perceptible by senses. No registration is required. The duration of a copyright depends on the fact whether the exclusive personal rights or the exclusive property rights are concerned.

The exclusive personal rights are not transferable and they cease to exist upon the author's death.

The property rights last from the moment of the creation of the work during the life of the author and 70 years after his/her death.

In the case of the co-author's work, the property rights last throughout the life of the co-author who lives the longest and 70 years after his/her death.

With respect to the rights related to the copyright, the duration of the property rights to the work is limited to 50 years only.

**Ownership / licenses**

The author as licensor may grant to a licensee the permission to use the work upon the license agreement. The license agreement contains, in particular, the way of using the work, scope of the license, duration of the license and remuneration. However, the author may agree to grant a free license to a licensee.

**Remedies for infringement**

The Copyright Act does not specify the amount of damages which the author may claim towards the infringing party. With respect to damages of the author whose rights are unlawfully interfered or whose rights are threatened, the Copyright Act only determines that such an author may claim compensation of non-pecuniary damage (including financial compensation), damages and unjust enrichment towards such infringer.

However, pursuant to the Civil Code, in the case of a breach or threat of an intellectual property right which may be the object of a license agreement (such as copyright), the amount of damages shall be at least equal to the remuneration for a license granted at the time of unauthorized interference with the right.

The author may seek the prohibition of the threat to his/her copyright and the prohibition of the unauthorized interference with his/her copyright.

In addition, criminal sanctions pursuant to the Criminal Code shall apply.
MASK WORKS / TOPOGRAPHIES

Nature of right

Topography shall mean a series of fixed or coded mutually related images representing the three-dimensional layers which the semiconductor product is composed of with each scheme representing the pattern or the part of the pattern of the surface of a semiconductor product in any stage of its production.

Semiconductor product shall mean a microelectronic product in the final form or in the intermediate form which is exclusively or in combination with other functions determined to fulfill an electronic function. It consists of a body containing a layer of semiconducting material and has one or more layers composed of conductive, insulating or semiconducting material in a predetermined three-dimensional arrangement.

The right to protection of the topography belongs to its inventor unless otherwise specified. The inventor is the person who created the topography by its own creative intellectual activity.

Legal framework

The topography as the object of the legal protection is defined in the Slovak Act No. 146/2000 Coll. on Protection of Topographies of Semiconductor Products, as amended (Act on Topography). The Act on Photography provides protection to topography that is the result of the creative intellectual activity of the creator and which is not common in the semiconductor product industry. In order to obtain the protection of the owner of the topography, the creator shall submit the application for the registration of the topography to the Industrial Property Office.

In addition to Act on Topography, the Slovak Act No. 513/1991 Coll., the Commercial Code, as amended (Commercial Code) and the Civil Code shall apply as the general regulation.

Duration of right

The duration of protection of topography shall exist as of the date:

- the topography has commercially exploited if the application for the registration has been filed no later than two years after such commercial exploitation

- the application for registration has been filed

Protection of the topography shall expire after 10 years from the end of the calendar year in which the topography protection was granted.

However, the right to protection of the topography shall expire after 15 years as of the date of its first fixation or coding if the topography has not been exploited commercially or if an application for registration has not been submitted to the Industrial Property Office.

Ownership / licenses

The owner of the topography is considered to be the natural or legal person registered in the register of the Industrial Property Office. The joint ownership of a topography is allowed and governed by the Civil Code.
The owner may grant another person a license to his/her topography. A license shall have legal effects towards third parties upon registration in the register of the Industrial Property Office.

**Remedies for infringement**

In the case of an unauthorized interference with the rights, the owner of a topography is entitled mainly to seek prohibition of unlawful interference of the rights or threats to the rights and removal of the consequences of such interference. If due to such interference with the owner’s rights any damage has been caused, the owner shall have the right to damages including loss of profits. If non-pecuniary damage has occurred, the owner has the right to reasonable compensation, including financial compensation. Right to unjust enrichment is not affected.

Pursuant to the Civil Code, in the case of a breach or threat of an intellectual property right which may be the object of a license agreement (such as topography), the amount of damages shall be at least equal to the remuneration for a license granted at the time of unauthorized interference with the right.

In addition, criminal sanctions pursuant to the Criminal Code shall apply.

**PATENTS**

**Nature of right**

The owner of a patent has the exclusive right to use the invention, to grant consent with the use of the invention, to transfer the patent to another person or to pledge the patent as collateral.

**Legal framework**

Legal protection of patents is regulated by the Slovak Act No. 435/2001 Coll. on patents, as amended (Patent Act). Slovak Republic is signatory of several international agreements regarding patents:

- Patent Cooperation Treaty
- Paris Convention
- Strasbourg Agreement Concerning the International Patent Classification
- Patent Law Treaty
- European Patent Convention
- Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure

**Duration of right**

The patent is valid for 20 years from the filing date.
Ownership / licenses

The owner of a patent is the natural or legal person registered in the register of the Industrial Property Office as the owner. The joint ownership of a patent is allowed. The Industrial Property Office will register a co-owner upon an application accompanied by a written agreement concluded between the owner/co-owners of a patent and the person who has the right to invention.

The owner may grant another person a license to his/her patent. A license shall have legal effects towards third parties upon registration in the register of the Industrial Property Office.

Remedies for infringement

In the case of an unauthorized interference with the rights, the owner of a patent is entitled mainly to seek prohibition of unlawful interferences of the rights or threats to the rights and removal of the consequences of such interferences. If due to such interference with the owner’s rights any damage has been caused, the owner shall have the right to damages including loss of profits. If non-pecuniary damage has occurred, the owner has the right to reasonable compensation, including financial compensation. Right to unjust enrichment is not affected.

Pursuant to the Civil Code, in the case of a breach or a threat of an intellectual property right which may be the object of a license agreement (such as patent), the amount of damages shall be at least equal to the remuneration for a license granted at the time of unauthorized interference with the right.

In addition, criminal sanctions pursuant to the Criminal Code shall apply.

TRADEMARKS

Nature of right

A trademark can be any sign which can be represented graphically and which consists of, in particular, words, including personal names, letters, figures, drawings, shape of goods or their packaging or sounds, if such designation is capable of distinguishing goods or services of one person from goods or services of another person and of expressing in the Register of the Industrial Property Office in a way which enables the competent authorities and the public to clearly determine the subject matter of the protection.

Legal framework

The Slovak Act No. 506/2009 Coll. on trademarks, as amended (Act on Trademarks) governs the rights and obligations relating to the legal protection of national trademarks and trademark proceedings in front of the Industrial Property Office of the Slovak Republic (Industrial Property Office).

Slovakia, as a member of the European Union, implemented EU directives on the trademarks into the Act on Trademarks. Therefore, the registration of an EU trademark in the EU register has the same effects in the territory of the Slovak Republic as if the trademark was registered in the Slovak register of trademarks. The Slovak Republic is signatory of several international agreements as well:

- Paris Convention
• Madrid Agreement

• Nice Agreement

• Trademark Law Treaty

**Duration of right**

The registration of a trademark is valid for ten years from the filing date of the application. On the basis of a request, the Industrial Property Office will renew the validity of the trademark registration for the next 10 years.

Pursuant to amended Act on Trademarks effective as of January 14, 2019, if during a period of 5 years from the date of registration of the trademark, the owner has not actually commenced use of the trademark in connection with the goods or services for which it is registered or where such use has been interrupted for a continuous period of 5 years, the Industrial Property Office may upon basis of the submission of a third party either cancel or declare the trademark invalid. However, this does not apply if the owner has had a legitimate reason for not using the trademark.

**Ownership / licenses**

The owner is a legal or natural person registered in the trademark register of the Industrial Property Office. The joint ownership of a trademark is allowed and governed by the Civil Code and the Act on Trademarks.

The trademark owner has the exclusive right to use the trademark in connection with the goods or services for which it is registered. The owner is entitled to use the sign ® together with the trademark. The owner may grant another person a license to his/her trademark. A license shall have legal effects towards third parties upon registration in the register of the Industrial Property Office.

**Remedies for infringement**

In the case of an unauthorized interference with the rights, the owner of a trademark is entitled mainly to seek prohibition of unlawful interference of the rights or threats to the rights and removal of the consequences of such interference. If due to such interference with the owner’s rights any damage has been caused, the owner shall have the right to damages including loss of profits. If non-pecuniary damage has occurred, the owner has the right to reasonable compensation, including financial compensation. Right to unjust enrichment is not affected.

Pursuant to the Civil Code, in the case of a breach or threat of an intellectual property right that may be the subject of a license agreement (such as trademark), the amount of damages shall be at least equal to the remuneration for a license granted at the time of unauthorized interference with the right.

In addition, criminal sanctions pursuant to the Criminal Code shall apply.

**TRADE SECRETS**

**Nature of right**

One of the rights belonging to an enterprise involves a trade (business) secret. A business secret comprises all the
facts of a commercial, manufacturing and technical nature related to the enterprise that have actual or at least potential value, they are not readily available in the respective business circles, and they are to be kept confidential upon the will of the owner of the business secret; the owner of the business secret shall provide for the adequate protection of the business secret.

**Legal framework**

Business secret is regulated by the Commercial Code.

**Duration of right**

The duration of the right to a business secret depends on the fulfilment of its defining criteria. Thus, as long as a piece of information fulfils the defining criteria for a business secret, it shall be protected as a business secret.

**Ownership / licenses**

The owner of a business secret is a natural or legal person who lawfully handles the business secret which is related to an enterprise undertaken by this person within his/her entrepreneurship. This person has in general the exclusive right to handle this business secret, especially to grant a permission to its use and set conditions for its use.

**Remedies for infringement**

The owner of a business secret is legally protected from any interference or threat to his/her rights related with business secrets.

**OTHER KEY IP RIGHTS**

**Nature of right**

**Utility models**

Utility models shall mean a protection of new technical solutions that have been created through inventive activity in any field of technology. A technical solution is capable of being protected as an utility model if it is new, if it is a result of inventive activity and if it is industrially usable. Certain objects are not capable of being protected as utility models, such as:

- discoveries, scientific theories and mathematical methods
- aesthetic creations
- plans, rules and methods of performing intellectual activity, games or business activity
- computer programs
- pure statement of information
Designs

Designs shall mean an external layout of a product or its part that consists of elements which are, predominantly, lines, contours, colors, shapes, structures or materials of the particular product or its decoration. A product shall mean any material thing made in an industrial or crafted way, together with package, layout, graphical symbols, topographical symbols or parts that are intended to be used for compilation of a composite product, apart from computer programs.

A design shall be capable of being protected if it is new and if it possesses a distinctive character.

Legal framework

Utility models

The utility models as the object of the legal protection are defined by the Slovak Act No. 517/2007 Coll. on utility models, as amended (Act on Utility Models). The application for utility model and its requirements are further regulated by the Decree of the Industrial Property Office of the Slovak Republic No. 1/2008 Coll., which implements the Act on Utility Models. In order for the Industrial Property Office to grant the protection to a utility model, it is necessary to submit a utility model application to the Industrial Property Office, which will register the utility model when the conditions for its registration are fulfilled.

Designs

Designs are regulated in the Slovak Act No. 444/2002 Coll. on designs, as amended (Act on Designs). The application for design and its requirements are further regulated by the Decree of the Industrial Property Office of the Slovak Republic No. 629/2002, which implements the Act on Designs.

Duration of right

Utility models

The protection of an utility model is valid for four years from the date of filing of the application. The protection can be extended upon request of the owner of the utility model up to two times, each time for three years.

Designs

The protection of a design is valid for five years from the date of filing of the application. The protection can be extended upon request of the owner of the design up to four times, each time for five years (the overall time of protection being a maximum of 25 years).

Ownership / licenses

Utility models

The owner of an utility model is the natural or legal person registered in the register of the Industrial Property Office as the owner. The joint ownership of an utility model is allowed. The Industrial Property Office will register a co-owner upon an application accompanied by a written agreement concluded between the owner/co-owners of an utility model and the person who has the right to solution.
The owner may grant another person a license to his/her utility model. A license shall have legal effects towards third parties upon registration in the register of the Industrial Property Office.

**Designs**

The owner of a design is a natural or legal person registered in the register of the Industrial Property Office as the owner. The joint ownership of a design is allowed. The Industrial Property Office will register a co-owner upon an application accompanied by a written agreement concluded between the owner/co-owners of a design and the person who has the right to design.

The owner may grant another person a license to his/her design. The license shall have legal effects towards third parties upon registration in the register of the Industrial Property Office.

**Remedies for infringement**

**Utility models**

In the case of an unauthorized interference with the rights, the owner of an utility model is entitled mainly to seek prohibition of unlawful interference of the rights or threats to the rights and removal of the consequences of such interference. If due to such interference with the owner's rights any damage has been caused, the owner shall have the right to damages including loss of profits. If non-pecuniary damage has occurred, the owner has the right to reasonable compensation, including financial compensation. Right to unjust enrichment is not affected.

Pursuant to the Civil Code, in the case of a threat or a breach of an intellectual property right which may be the object of a license agreement (such as utility model), the amount of damages shall be at least equal to the remuneration for a license granted at the time of the unauthorized interference with the right.

In addition, criminal sanctions pursuant to the Criminal Code shall apply.

**Designs**

In the case of an unauthorized interference with the rights, the owner of a design is entitled mainly to seek prohibition of unlawful interference of the rights or threats to the rights and removal of the consequences of such interference. If due to such interference with the owner's rights any damage has been caused, the owner shall have the right to damages including loss of profits. If non-pecuniary damage has occurred, the owner has the right to reasonable compensation, including financial compensation. Right to unjust enrichment is not affected.

Pursuant to the Civil Code, in the case of a threat or a breach of an intellectual property right which may be the object of a license agreement (such as design), the amount of damages shall be at least equal to the remuneration for a license granted at the time of the unauthorized interference with the right.

In addition, criminal sanctions pursuant to the Criminal Code shall apply.

**INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT**

**Employees**

Under the Copyright Act, works created for fulfilment of duties under employment contracts or similar contracts are considered to be employment works. The same applies to works created by authors who are members of
managing, controlling or supervisory bodies of a legal entity, or a statutory body or member of a statutory body of a legal entity. Property rights to employment works are exercised by employers, unless otherwise agreed. If property rights are exercised by employers, employees cannot license the works to a third person; employees as authors shall not exercise property rights to the works themselves. Employers are entitled to license property rights to a third person, unless otherwise agreed.

If property rights are exercised by employers, employees as authors automatically give their consent to publish the works, to use employers' label on the works; to change/intervene/finish the works.

Similarly, these provisions are applicable to computer programs, databases and cartographic works created on contract.

Under the Patent Act, inventions created within the fulfilment of employment contracts are considered to be employment inventions. The right belongs to employers, unless otherwise agreed. The right of the employee to be recognized as the inventor of the invention is not precluded. Employees as inventors shall inform employers about inventions in writing and deliver all the materials necessary for evaluation of the invention. Employers may exercise their rights to the invention within three months, otherwise the rights are transferred to employees. If employers exercise their rights, employees are entitled to a remuneration.

Employment solutions under the Act on Utility Models are regulated in a similar manner as employment inventions under the Patent Act described above.

Employment designs under the Act on Designs are regulated in a similar manner as employment inventions under the Patent Act described above.

Under the Act on Topography, if topographies are created within the fulfilment of duties under employment contract or other contract, the rights belong to employers or entitled contractual parties, unless otherwise agreed.

**Consultants / contractors**

Under the Copyright Act, contractual works are works created by authors based on contracts for work. If authors create contractual works, they grant their consent to use the works for the purpose arising from the contracts, unless otherwise agreed. Use for another purpose requires the consent of authors, unless otherwise stated in the Copyright Act. Authors are entitled to use the work by themselves as well as to license it, unless otherwise agreed and unless it is in conflict with customers' legitimate interests. These provisions are not applicable for audiovisual works.

Under the Act on Topography, if topographies are created within the fulfilment of duties under a contract, the rights belong to entitled contractual parties, unless otherwise agreed.

**KEY COMMERCIAL CONTRACT CONSIDERATIONS**

**Registration of commercial agreements**

The registration of license agreements related to an object of the industrial rights may be required by a specific regulation. For example, pursuant to the Patent Act, a license agreement shall have legal effects towards third
parties from the date of registration by the Industrial Property Office (however, even if the registration has not been conducted, the license agreement should still have legal effect between licensor and licensee).

**Recognized language of commercial agreements**

Slovak language is the official language in the Slovak Republic. However, in general commercial agreements may be concluded in a foreign language.

**Country-specific issues for online content**

Not applicable for this jurisdiction.

**Enforceability of online/clickwrap/shrinkwrap terms**

Not applicable for this jurisdiction.

**Governing law**

Choice of governing law and choice of forum for resolution of disputes specified in a commercial contract will generally be accepted and recognized by courts. In the absence of a specification in contract, rules under the Slovak Act No. 97/1963 Coll. on International Private and Procedural Law, as amended, Regulation No. 593/2008 (Rome I) and Regulation No. 1215/2012 (Brussels I) shall apply.

If specified by the parties in the contract, alternative dispute resolution procedure, such as mediation or arbitration, is in general also possible.

**KEY COMMERCIAL CONTRACT TERMS**

**Enforceability of warranty disclaimers**

Not applicable for this jurisdiction.

**Enforceability of exclusions/limitations of liability indemnification**

Not applicable for this jurisdiction.

**Indemnification**

Not applicable for this jurisdiction.

**Electronic signatures**

Under Slovak Act No. 272/2016 Coll. on Trust Services for Electronic Transactions in the Internal Market (Trust Services Act), as amended, qualified electronic signature is an advanced electronic signature that is created by a qualified electronic signature creation device, and which is based on a qualified certificate for electronic signatures.

With a qualified electronic signature, it is possible to electronically carry out legal acts, which require written
form, *ie*, such electronic signature in this case replaces written form of a handwritten signature. Due to this reason, its usage is necessary in some acts performed within the communication with public authorities and the commercial sector.

Qualified electronic signature of an electronic document secures:

- Authenticity (the identity of the subject creating the signature may be unambiguously verified)
- Integrity (it can be demonstrated that after the signing the document, there was no intentional or unintentional change in the content of the document as it was at the time of signing the document)
- Indisputability (the author cannot claim that he/she did not create the signature of the electronic document)

Slovak Act No. 305/2013 Coll. on the Electronic Form of Governance Conducted by Public Authorities (Act on e-Government), as amended, stipulates that if a legal act is performed under the law in an electronic form or if a special regulation requires a handwritten signature, the person who is not a public authority, shall carry out the authorization of such legal act by means of a qualified electronic signature.

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INTELLECTUAL PROPERTY FRAMEWORK

Overview

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).

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 or her death (an individual author of a cinematographic work 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 copyright in a jointly owned work, consent from all joint owners is required. Non-exclusive licenses are available. An exclusive right against third parties is recognized only for the right of publication (including publication rights for computer programs).

**Remedies for infringement**

Remedies available for infringement are:

- Criminal action
- Preliminary injunction
- Permanent injunction
- Damages

Under the CA, infringement of a copyright is punishable by imprisonment of up to five years or a fine of up to KRW50 million (US$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 KRW30 million (US$30,000), if:

- 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
- A person manufactures or distributes equipment that descrambles or decodes encrypted broadcast signals
- A person forges copyright labels to be attached to a work (eg, a DVD), or transacts labels beyond the permitted scope or
- 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 KRW10 million (US$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 KRW10 million (US$10,000) in statutory damages (or KRW50 million (US$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 / TOPOGRAPHIES**

**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 10 years from the date of registration. However, the term shall not exceed 10 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 KRW30 million (US$30,000). 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.

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:

- Criminal sanction (quite rare)
- Preliminary injunction
- Permanent injunction
• Damages

Under the amended PA which will become effective on July 9, 2019, courts are authorized to award damages as a punitive measure of up to three times the amount of actual damages for intentional or willful acts of patent infringement.

TRADEMARKS

Nature of right

A trademark is broadly defined as any type of mark that functions to distinguish one’s goods from others, regardless of its construction or its representation, including a symbol, character, sound, scent, three-dimensional shape, hologram, motion, a single color or any combination thereof.

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.

Trade dress of a service provider is now protected under the UCPA. Examples of such trade dress are as follows: the manner in which goods are offered for sale or services are provided, and the overall appearance of the place where the service is provided such as signboards, and external and interior design,

The amended UCPA which took effect on July 18, 2018 introduced a new provision prohibiting unfair competition in connection with "idea theft" – the unfair use of the ideas of another with economic value that has been obtained as part of a business negotiation or transaction.

Legal framework

Protection of trademarks is governed by the TMA and the UCPA.

Duration of right

The term of protection is 10 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:

- Criminal sanction
- Preliminary injunction
- Permanent injunction
- 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 reasonable effort. Under the amendment to the UCPA which will take effect on July 9, 2019, the reasonable effort requirement will be deleted and as long as secrecy is simply maintained, the secrecy requirement will be considered met without reference to the "effort" of maintenance at all.

The UCPA defines infringement of a trade secret to include the following:

- 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)
- 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
- 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
- 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
- Acquiring a trade secret knowing (or being grossly negligent in not knowing) that the trade secret had been revealed in the manner set out above, or that the trade secret had otherwise been the subject of such revelation, or subsequently using or revealing a trade secret so acquired
- 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 above, or that the trade secret had otherwise been the subject of such revelation

Under the amended UCPA which will become effective on July 9, 2019, courts are authorized to award damages as a punitive measure of up to three times the amount of actual damages for intentional or willful acts of trade secret misappropriation.
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 5 years of imprisonment or a fine of at least twice (not to exceed 10 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 10 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 7 years or by a fine of up to KRW700 million (US$700,000). 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 fifteen years or by a fine of up to KRW1.5 billion (US$1.5 million). As under 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 failing to prevent such act.

OTHER KEY IP RIGHTS

Nature of right

Not applicable for this jurisdiction.

Legal framework

Not applicable for this jurisdiction.

Duration of right

Not applicable for this jurisdiction.

Ownership / licenses
INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

Employees

In Korea, the right to a patent belongs to the inventor or his or her 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, eg, by contract or inheritance.

The Invention Promotion Act (IPA) defines a "work for hire" invention as an invention that results from:

- Present or past duties of the employee
- 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 that 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 or her 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 four months 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 to the employer.

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 "reasonableness" of the compensation:

- 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
- 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
- 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 relevant employees

- 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, 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:

- The case is not under the exclusive jurisdiction of the Korean courts under Korean law
- The foreign court in question selected by the parties has valid jurisdiction under the laws of the foreign court
- The case has reasonable connection with the foreign jurisdiction
- 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 indemnification**

Under Korean law, damage claims are made for compensation of:

- Ordinary damages
- 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:

- Public policy and general principles of equity under the KCC
- 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.

**Electronic signatures**

The Electronic Signature Act provides that an electronic signature has the same effect as a signature as agreed to between the parties. Therefore, such electronic document executed by an electronic signature will be valid and enforceable. In addition, under the Electronic Signature Act, if a certified electronic signature (i.e., electronic signature that is based upon an authorized certificate) is affixed on an electronic document, it is presumed that such electronic signature is the signature of the relevant signatory and that there has been no alteration in the contents of such electronic documents after it was signed. However, such presumption does not apply to non-certified electronic signatures.

With respect to the signature, there is always a potential issue with verification of the authenticity of such signature. Also, under the same Act, if a certain document is required to be signed pursuant to certain legislation, then the electronic signature is deemed to meet the legal requirement when certified as such.
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INTELLECTUAL PROPERTY FRAMEWORK

Overview

The Spanish Constitution establishes in 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

Overview

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 Protection Act, Mobile Property Pledge Act) and of the regional laws and regulations.

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:

- The cessation of the infringing acts
- Damages
- Seizure of the infringing goods
- To be awarded the seized objects or their means of production
- All necessary steps to prevent the continuation of the infringement
• 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. These measures have been recently modified and further strengthened, including prison sentences up to six years as set out in Articles 270 and 271.

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.

**MASK WORKS / TOPOGRAPHIES**

**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:

- The end of the calendar year in which the topography was first commercially exploited anywhere in the world
- 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:

- Reproduction of a topography with the exception of reproduction for private and non-profitmaking purposes
- 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.

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:

- Be new, ie, novel
- Involve an inventive step
- Be capable of industrial application

Scientific discoveries or theories, mathematical methods, literary, scientific, artistic works and any other aesthetic creations, among others, 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, a software item, or inventions whose commercial exploitation is contrary to public order or morality.

**Legal framework**

In Spain, the Spanish Patents and Trade Marks Office (Oficina Española de Patentes y Marcas) has the authority to grant patents and trademarks.

The new Spanish Patents Act 24/2015 (New Patents Act) entered into force on April 1, 2017. One of the most significant changes brought by the New Patents Act is related to the procedure for the granting of patents. The previous "à la carte" examination procedure (whereby applicants are free to choose whether or not their application should be submitted to substantive examination) will be substituted by the granting procedure involving a prior examination of the merits of the patent. Another important change is in the field of patent litigation. In accordance with the New Patents Act, the patent holder will be able to limit the scope of their patents by amending the claims at any time during the life of the patent. Finally, among other changes of the New Patents Act are provisions relating to Supplementary Protection Certificates (SPCs), which introduces protective letters and patent specialist judges.
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 have been 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.

**Duration of right**

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.

**Ownership / licenses**

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.

**Remedies for infringement**

According to the Spanish Law 24/2015 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:

- Cessation of the acts that infringe his rights
- Compensation for the damages suffered
- 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
- 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

- 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

- 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, names, figures, symbols and drawings, letters, numerals and combinations, three-dimensional shapes, including wrappers, containers and the shape of goods or their packaging, colors, numbers, 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:

- National system
- International system
- European Union Trademark

Legal framework

In Spain, the main law regulating trademark protection is the Law 17/2001 on Trademarks, recently modified by Royal Decree-Law 23/2018 (changes effective from January 14, 2019). 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 European Union 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, among other reasons, if:

- The trademark is not renewed
- It is not effectively used during an uninterrupted five-year period
- It becomes generic or deceptive in connection with the goods or services it covers

European Union Trademark registration is valid for ten years. This period can be renewed for further 10-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, criminal or administrative actions 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:

- The cessation of the acts infringing his right
- The compensation for the damage suffered
- 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
- 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
- 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 criminal proceedings under the Criminal Code.

Legal framework

Trade secrets are mainly protected in Spain under the Unfair Competition Act, the Criminal Code and TRIPS Agreement (Spain being signatory since 1995) containing 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.

OTHER KEY IP RIGHTS

Nature of right

Not applicable.

Legal framework
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 24/2015 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. Furthermore, the employee shall have the right to a reasonable remuneration in relation to the use of the technical improvements developed by the employee which offer a competitive advantage to the employer.

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. The employee has a month to give the communication to the employer, who will have three (3) months to exercise its rights. In the event that the employer does not communicate to the employee its willingness to assume the ownership of the invention within the aforementioned three months period, its rights shall expire, enabling the employee to proceed to the solicitation of the patent for itself. If the employer, having communicated the employee its willingness to assume the ownership of the invention, does not claim in front of the authorities, within a reasonable and pre-agreed term, the industrial property rights, the employee shall claim those on behalf of the employer.

In the event that the employer assumes the ownership of the invention or reserves a right to its use, the employee shall have the rights to a fair (economic) compensation/remuneration proportional to the industrial and commercial importance of the invention as well as considering the value of the resources or know-how given by the employer and the contributions made by the employee. The aforementioned remuneration may consist of a share on the profits made by the employer from the exploitation of the rights over the invention.
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, eg, 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 (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. Spanish laws (e.g., Consumers and Users Protection Act RDL 1/2007) also do establish certain limitations on the choice of law of the parties when dealing with certain specially protected groups, like consumers.

**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 indemnification**

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.

**Electronic signatures**

The use of electronic signatures is governed by Electronic Signature Act 59/2003. Regulation (EU) 910/2014 of the European Parliament and of the Council shall apply within the EU territory from July 1, 2016 (except for a number of provisions that are already in force or that will enter into force at a later date).

There are different types of electronic signatures:

i. Simple electronic signature, i.e., data in electronic form which is attached to or associated with other electronic data and which serves as a method of authentication

ii. Advanced electronic signature, which is:
   - Capable of identifying the signatory
   - Uniquely linked to the signatory
   - Linked to the data signed therewith in such a way that any subsequent change in the data is detectable
   - Created using electronic signature creation data that the signatory can use under his sole control

iii. Qualified ("recognized") electronic signature, i.e., an advanced electronic signature that is created by a qualified electronic signature creation device, and which is based on a qualified certificate for electronic signatures
   - A qualified electronic signature has the equivalent legal effect of a handwritten signature
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SWEDEN

INTELLECTUAL PROPERTY FRAMEWORK

Overview

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

Overview

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) (Avtädlagen). 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.

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 (1960:729) (Lag om upphovsrätt till litterära och konstnärliga verk) 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 and databases. 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.

The copyright protection for catalogues, i.e. a table or other work in which a large amount of information have been compiled or which is the result of a substantial investment, lasts for 15 years after the work is produced. However, if the work has been made available to the public within 15 years from the production, the copyright lasts 15 years from the year when the work was first made available to the public.

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 in specified circumstances. 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 elements which are commonly used in the semiconductor industry are only protected if the combination of such elements fulfils 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 other public distribution.

**Legal framework**

Semiconductor topographies are protected under the Act on the Protection of Topographies for Semiconductor Products (1992:1685) (*Lag om skydd för kretsmönster för halvledarprodukter*).

**Duration of right**

The right lasts for ten years from the expiration of the year when the topographies or semiconductor was first commercially exploited in any part of the world.

If the topography or semiconductor has yet not been commercially exploited, the right expires fifteen years following the expiration of the year in which the topographies or semiconductor was created.

**Ownership / licenses**

The right is granted to the individual person who has created the topography provided that he/she is a citizen of the European Economic Area (EEA), or is domiciled in a country within the EEA.

The right in a topography created by an employee during the course of an employment belongs to the employer unless otherwise agreed and provided that the employer is an individual person who is a citizen of or is domiciled in a country within the EEA or a legal person which conducts business in such country.

In the event a right in a topography does not exist pursuant to the provisions above, the right is granted to such natural or legal person who fulfills the requirements regarding the affiliation with the EEA provided that such a person has been granted the exclusive rights to exploit the topography commercially throughout the EEA and first commercially exploited the topography in a country within the EEA.

The right is also granted to a person who has acquired the right from such person mentioned above.

**Remedies for infringement**

Remedies for infringement include equitable and reasonable compensation for the use and compensation for additional damage 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 file customs actions applications to prevent importation of infringing goods.

Injunctive relief is also a possible remedy.

Criminal penalties are available.
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

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 can be maintained for a period of 20 years from the filing date of the application. If the patent relates to a medicinal or plant protection product, the term of the patent can in some cases be extended by five years, using supplementary protection. 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 file customs actions applications to prevent importation of infringing goods, 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 identical and confusingly similar marks for identical or similar goods and services as those protected by the trademark.

Legal framework

The Swedish Trademark Act (2010:1877) (Varumärkeslagen) 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 public.


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 10 years from the date of application and are renewable indefinitely.

Unregistered Swedish trademarks are in effect for as long as the trademark fulfills the requirements for unregistered protection.

Registered European Union trademarks are in effect for 10 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 EUIPO’s register over European Union 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 file customs actions applications to prevent importation of infringing goods, 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**

In 2018, a new Act on Trade Secrets (2018:558) (Lag om företagshemligheter) entered into force, replacing the older Act from 1990. The Act governs trade secret protection and the new Act is based upon an initiative from the European Union, which broadly strengthens the protection of trade secrets. The strengthened protection means, among other things, that more attacks on business secrets are considered unlawful and that the obligation to pay damages has extended. However, for information to be classified as secret, the new Act sets up a requirement that the holder of the information must take reasonable steps in order to keep the information secret.

However, there have been no changes regarding the provisions listed below.

**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.
Ownership / licenses

The Act on Trade Secrets does not contain any rules on licensing but the Act is based on the assumption that know-how and trade secrets can be licensed. Licenses for know-how and trade secrets are common under the laws of Sweden. Joint ownership is possible.

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.

OTHER KEY IP RIGHTS

Nature of right

Not applicable.

Legal framework

Not applicable.

Duration of right

Not applicable.

Ownership / licenses

Not applicable.

Remedies for infringement

Not applicable.

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. However, a right of use is implied, and if not otherwise expressly agreed, the employer may use the employee’s work within its field of business and for his or her normal...
business activities for the purposes that could be anticipated when the work was created. It is customary for employees to sign copyright assignment and confidentiality agreements. Some collective labor agreements, for example within the mass media sector, provide acquisition rights in the employee's copyright.

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 (1949:345) (Lagen om rätten till arbetstagares uppfinningar), 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 or trademark 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 expressly required under mandatory law, 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. Furthermore, the Swedish Consumer Agency may also impose on a company to use Swedish in its agreements with consumers (including general terms and conditions). If English is used however, 'plain English' that is consumer-friendly is preferred.

Country-specific issues for online content

Generally, there is no requirement on the form of the contract (with a few exceptions, for example real property). Thus, the parties are free to enter into agreements online.

Companies need to adhere to the Act on E-Commerce (2002:562) (Lag om elektronisk handel och andra...
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 (eg, 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.

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 (1990:931) (Köplagen) 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

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 indemnification**

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 seller’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.

In a business-to-consumer situation, the general principle is that the consumer’s legal rights may not be limited by a trader.

**Electronic signatures**

Swedish general contract law is based on the principle that all agreements are binding irrespective of the form they are entered into, unless mandatory laws specifically provide that a document must be signed in person. Hence, the use of electronic signatures is generally accepted.
SWITZERLAND

INTELLECTUAL PROPERTY FRAMEWORK

Overview

Intellectual property rights are governed by Federal statutes and by international treaties.

COMMERCIAL CONTRACT FRAMEWORK

Overview

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.

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

The Federal Act and Federal Ordinance on Copyright and Related Rights govern copyrights. Switzerland became a signatory to the Berne Convention in 1886.
The Swiss federal government recently initiated a revision of the Copyright Act. It is expected to be passed within a few years.

**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 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 (a moral right) 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. Furthermore, for certain areas, collective rights management by approved collecting societies is compulsory.

**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 infringing goods.

Criminal penalties are also possible.

**MASK WORKS / 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 if one of the following preconditions is fulfilled:

- Production by a Swiss manufacturer or a person whose normal place of residence or place of business is in Switzerland
- First publication in Switzerland
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 10 years, starting on the day of the valid application for the registration of the topography or the day the topography was first distributed, whichever is earlier. If the topography is not registered, protection ends 2 years after the day it was first distributed. In any case, the right ends 15 years after the development of the topography at the latest.

**Ownership / licenses**

Co-ownership is permissible.

**Remedies for infringement**

Remedies are the same as for copyright infringement. They include declaratory actions, actions for performance, damages, or destruction. Also, actions for confiscation of unlawfully produced topographies can be sought, except for products acquired in good faith.

Injunctive relief and publication of judgments are also possible remedies.

It is also possible to seek the prevention of importation of infringing goods.

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, in particular for manufacturing, storing, offering, placing on the market, importing, exporting and carrying in transit.

**Legal framework**

The Federal Patents Act and the Federal Ordinance on Patents govern 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 infringing goods.

Criminal penalties are also possible.

TRADEMARKS

Nature of right

A word, a combination of letters, numerals, 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 Trademark Protection Act and Federal Ordinance on Trademarks. Those two statutes were revised with effect as of January 1, 2017. In particular, the provisions concerning the indication of origin in Switzerland were revised.

Duration of right

Trademark registrations remain in effect for 10 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.

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 the prevention of importation of infringing goods.

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*

Protection of trade secrets is addressed by the Federal Unfair Competition Act, Code of Obligations and Criminal Code.

*Duration of right*

There is no specific time limitation for protection. Trade secrets are protected by law as long as they remain secret.

*Ownership / licenses*

Protection may apply to several individuals if they all work on the creation of the trade secret and their individual input cannot be separated, or if secrecy is 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.

**OTHER KEY IP RIGHTS**

*Nature of right*

Not applicable for this jurisdiction.

*Legal framework*
Not applicable for this jurisdiction.

**Duration of right**

Not applicable for this jurisdiction.

**Ownership / licenses**

Not applicable for this jurisdiction.

**Remedies for infringement**

Not applicable for this jurisdiction.

**INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT**

**Employees**

Inventions and designs created by the employee in his or her function as an employee and in fulfillment of his or her contractual duties belong to the employer. The same applies to software copyrights but not to all other copyrights. Therefore, it is advisable to include contractual clauses dealing with the transfer of copyrights from employees to employers in employment agreements.

Non-technical trade secrets are not transferred to the employer.

**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.

**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.

**Country-specific issues for online content**
Not applicable for this jurisdiction.

**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.

The Federal Unfair Competition Act prohibits general terms and conditions that provide, contrary to good faith, for an unfair allocation of rights and obligations to the detriment of consumers.

**Enforceability of exclusions/limitations of liability indemnification**

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 for damages caused by a party 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.

**Electronic signatures**
Because most contracts under Swiss contract law do not require a specific form, generally the parties may validly execute contracts by exchanging electronic messages, provided that the parties and the contents of their respective messages are identifiable. This also applies in relation to choice-of-law provisions or jurisdiction and arbitration clauses, as far as the latter are based on electronic communication that can be evidenced by a text.

In addition, Swiss law provides for and recognizes a technical procedure which makes it possible to guarantee the authenticity of a document or an electronic message and to ensure the identity of the sender. The procedure is based on a certification infrastructure managed by third party providers.

If such third-party provider is further approved by an appointed authority, its issued electronic signatures are treated as equal to handwritten signatures. Thus, the procedure may be used for contracts that require a handwritten form. Nevertheless, this procedure is used very rarely in practice.

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INTELLECTUAL PROPERTY FRAMEWORK

Overview

Intellectual property is regulated and protected in Taiwan under various laws, such as the Copyright Act for original works of authorship; Trademark Act for trademarks; Patent Act for invention, utility model and design; and the Integrated Circuit Layout Protection Act for integrated circuit layouts. The Civil Code is the basic law for any other intangible property right.

COMMERCIAL CONTRACT FRAMEWORK

Overview

Commercial contracts in Taiwan are basically governed by the Civil Code. Certain contracts with a special nature (such as agreements in relation to copyrights or patent) are governed by various special laws or regulations, such as the Copyright Act and Patent Act, among others.

COPYRIGHTS

Nature of right

The Copyright Act 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 authorship work.

Legal framework

The Copyright Act was first introduced and came into force in Taiwan on May 14, 1928. Taiwan is a member of the WTO and follows the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS).

Duration of right
The duration of a copyright is:

- The life of the author plus 50 years after the author’s death
- Ten years from the first public release, if a work is first publicly released between the 40th and 50th year after the author’s death

In case of a joint authorship work, the duration is 50 years after the death of the last surviving author. In case of pseudonymous authorship work or an anonymous authorship work, it is 50 years from the time of public release. In case of authorship works created by a juristic person, it is 50 years after the public release or 50 years after the completion of such creation if not publicly released within 50 years after the completion of such creation. In addition, the duration for authorship in relation to photographic, audiovisual, sound recordings, or performances is 50 years after the public release of such authorship work or 50 years after the completion of such creation in case of no public release is made within 50 years of completion of such creation.

Ownership / licenses

A copyright can be freely assigned, licensed, pledged or inherited in whole or in part. Joint authorship of a copyright is permissible, provided that any assignment, grant of license or creation of pledge thereof can only be made with the unanimous consent of all joint owners. If a joint owner abandons his or her share of a joint authorship copyright, the abandoned share shall be allocated to the other joint owners according to the percentage of their respective shares in such joint authorship copyright.

Remedies for infringement

Available civil remedies:

- Claim for damage for economic loss and non-economic loss (including restoration of author’s reputation)
- Request to stop or prevent infringement
- Request for destruction or other necessary disposition of the infringing articles, or articles used in infringement
- Demanding placement in a newspaper or magazine of all or part of the relevant judgment rendered for such infringement
- Application to the customs authorities to suspend the release of import or export goods that infringe the copyrights

In addition, criminal punishments (such as imprisonments, detention, fine, confiscation and/or disclosure of judgment) are possible.

MASK WORKS / TOPOGRAPHIES

Nature of right
Integrated circuit layouts are protected by the Integrated Circuit Layout Protection Act, which defines:

- "Integrated circuit" as a finished or intermediate product having electronic circuitry functions and with transistors, capacitors, resistors, or other electronic components and their interconnections integrated onto or within a semiconducting material

- "Circuit layout" as a two-dimensional or three-dimensional design of electronic components and interconnecting leads on an integrated circuit

Subject to certain exceptions set forth in the Integrated Circuit Layout Protection Act, an owner of circuit layout rights shall have the exclusive rights to preclude others from reproducing the circuit layout in whole or in part; or importing or distributing for commercial purpose the circuit layout or an integrated circuit containing the circuit layout.

**Legal framework**

The grant of a circuit layout right is based on registration of a circuit right with the Taiwan Intellectual Property Office, Ministry of Economic Affairs. No application for registration of a circuit layout will be accepted after two years from the date of the first commercial exploitation.

**Duration of right**

The duration of a circuit layout is 10 years commencing from:

- The filing date of the circuit layout registration application or
- The date of the first commercial exploitation (whichever is earlier)

**Ownership / licenses**

A circuit layout right can be freely assigned, licensed, pledged or inherited in whole or in part. Joint ownership of a circuit layout right is permissible, provided that any assignment, grant of license or creation of pledge of a jointly-owned circuit layout right can only be made with the unanimous consent of all joint owners. If a joint owner of circuit layout rights abandons his/her share, the abandoned share shall be allocated to the other joint owners according to the percentage of their respective shares in such joint ownership.

**Remedies for infringement**

Available civil remedies:

- Claim for damage for economic loss and non-economic loss
- Request to stop or prevent infringement
- Request for the destruction of integrated circuits containing the infringing circuit layouts
- Request for publication of the contents of the court judgment, in whole or in part, in a newspaper
PATENTS

Nature of right

A patentee has an exclusive right to prevent others from exploiting the patent without the patentee’s consent. Exploiting means the acts of manufacturing, offering for sale, selling, using or importing the products/services containing the patent.

Legal framework

Patent is regulated by the Patent Act in Taiwan and is classified into three types, ie, invention patent, utility model patent and design patent (including derivative design patent).

The grant of a patent right in Taiwan is based on the registration of a patent with the Intellectual Property Office, Ministry of Economic Affairs.

Duration of right

The term of an invention patent is 20 years, the term of an utility model patent is 10 years and the term of a design patent is 12 years, all starting from the filing date of the application. A derivative design patent shall expire simultaneously with the original design patent.

Ownership / licenses

The patent can be assigned, exclusively or non-exclusively licensed, pledged or inherited. Joint ownership is permissible and, unless the joint owners agree otherwise, each of the joint owners is entitled to exploit the patent for his or her own benefit. However, any single owner of a patent is not entitled to assign, entrust, license, pledge, abandon the patent or to assign, entrust or establish a pledge on his or her own share of such patent without the unanimous consent of all joint owners. If a joint owner abandons his or her share of a patent, the abandoned share shall be allocated to the other joint owners according to the percentage of their respective shares in such patent.

Remedies for infringement

Available remedies:

- Claim for damages for economic loss and non-economic loss

- Request to stop or prevent infringement

- Request for destruction of the infringing articles or the materials or implements used in the infringing act, or request for other necessary disposition

- Request customs to detain the imported articles that are suspected of infringing the patent right(s)

- In case of damage to rights of attribution, request for necessary disposition(s) to have the inventor’s name indicated or to restore the impaired reputation
TRADEMARKS

Nature of right

A trademark is defined to be a sign with distinctiveness which is capable of being recognized by relevant consumers as an indication of the source of goods or services and distinguishing goods or services of one from others. A trademark may consist of words, devices, symbols, colors, three-dimensional shapes, motions, holograms, sounds, or any combination thereof.

Legal framework

The Trademark Act governs trademarks. Taiwan is a member of WTO and follows the TRIPS. However, Taiwan is not a member of the Madrid Protocol.

The grant of a trademark in Taiwan is based on the registration of a trademark with the Intellectual Property Office, Ministry of Economic Affairs.

Duration of right

The duration of trademark right is 10 years from the date of registration and renewable. The duration of each renewal period is also 10 years.

Ownership / licenses

A trademark may be exclusively or non-exclusively licensed by the trademark owner for all or some of the designated goods or services for which it is registered and in a particular territory.

Joint ownership of a trademark is permissible and, unless the joint owners agree otherwise, each of the joint owners is entitled to exploit the trademark for his or her own benefit. However, any single owner of a trademark is not entitled to assign, entrust, license, pledge, abandon the trademark or to assign, entrust or establish a pledge on his or her own share of such trademark without the unanimous consent of all joint owners. If a joint owner abandons his or her share of a trademark, the abandoned share shall be allocated to the other joint owners according to the percentage of their respective shares in such trademark.

Remedies for infringement

Available remedies:

- Claim for damage for economic loss and non-economic loss
- Request to stop or prevent infringement
- Request for destruction of infringing articles and the materials or implements used in infringing the trademark
- Application to the customs authorities to suspend the release of import or export goods that infringe the trademark rights
In addition, criminal punishments (such as imprisonment, detention, fine, and confiscation) are possible.

**TRADE SECRETS**

**Nature of right**

According to the Trade Secrets Act, a trade secret shall mean any method, technique, process, formula, program, design or other information that may be used in the course of production, sales, or operations, and also meet all of the following requirements:

- It is not known to persons generally involved in the information of this type
- It has economic value, actual or potential, due to its secretive nature
- Its owner has taken reasonable measures to maintain its secrecy

**Legal framework**

The Trade Secret Act was first introduced and came into force in Taiwan on January 17, 1996.

**Duration of right**

Trade secret can be protected as long as it is confidential.

**Ownership / licenses**

A trade secret can be freely assigned, licensed or inherited in whole or in part.

Joint ownership is permissible, provided that any assignment, grant of license of a jointly-owned trade secret can only be made with the unanimous consent of all joint owners.

As to license a trade secret, an owner of a trade secret may grant a license to another for the use of the trade secret. The territory, term, contents, methods of use or other matters in connection with the license shall be governed by the contract between the owner and licensee. In case of joint ownership, no single owner of a trade secret shall grant a license to another for the use of the jointly-owned trade secret without the unanimous consent of all joint owners, provided that such consent shall not be unreasonably withheld.

Further, no pledge or compulsory execution shall be created over a trade secret.

**Remedies for infringement**

Available remedies:

- Claim for damage for economic loss and non-economic loss
- Request to stop or prevent infringement
• Destruction or other necessary dispositions of products generated from the infringement or articles used exclusively in the infringement

In addition, criminal punishments (such as imprisonment, detention, fine and/or confiscation) are possible.

OTHER KEY IP RIGHTS

Nature of right
Not applicable for this jurisdiction.

Legal framework
Not applicable for this jurisdiction.

Duration of right
Not applicable for this jurisdiction.

Ownership / licenses
Not applicable for this jurisdiction.

Remedies for infringement
Not applicable for this jurisdiction.

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

Employees
According to the Copyright Act, the ownership of an authorship work completed by an employee within the scope of his or her employment is decided according to the agreement entered into between the employer and employees. In the absent of such agreement, the employee shall be deemed as the author of the work and the economic rights to such work shall be vested in the employer. The term "employee" referred to in the preceding two sentences includes a civil servant.

According to the Patent Act, where an invention, an utility model or a design is made by an employee in the course of performing his or her duties, unless otherwise provided for in an agreement between the employee and employer, the right to apply for a patent and the patent right thereof shall be vested in his or her employer, on the condition that the employer shall pay the employee reasonable remuneration. Where the right to apply for a patent and the patent right are vested in the employer, the inventor, utility model creator or designer concerned shall be entitled to a right of attribution.

Where an invention, utility model or design made by an employee has no connection to the course of performing his or her duties, the right to apply for a patent along with the rights attached to such patent for such invention,
utility model or design shall be vested in the employee. However, if such invention, utility model or design is made through the utilization of the employer's resources or experiences, even though the right to apply for a patent and the patent right are vested in the employee, the employer may, after paying the employee a reasonable remuneration, exploit the invention, utility model or design. An agreement concluded between an employer and an employee precluding such employee from enjoying the above-mentioned rights and interests shall be null and void.

The Integrated Circuit Layout Protection Act provides that, if a circuit layout is created by an employee within the scope of employment, the right to apply for registration and the rights attached to such circuit layout right for such circuit layout shall be vested in the employer unless otherwise provided for in an agreement between the employer and employees to the contrary. The employee shall be entitled to the right of attribution based on the facts of the creation.

Consultants / contractors

It is customary for the party who retains a consultant or contractor to sign an agreement with such consultant or contractor. The ownership of the work, patent or integrated circuit layout is determined by the express terms of the agreement. In the absence of an express term of a written agreement:

- The consultant/contractor shall be deemed the author of an authorship work and the economic rights to such work shall be vested in the consultants/contractors
- The right to apply for a patent and the patent right shall be vested in the consultant/contractor if he/she/it is the inventor, utility model creator or designer – provided, however, that the party who retains the consultant/contractor shall be entitled to exploit such invention, utility model or design
- The right to apply for registration of the circuit layout shall be vested in the party who retains the consultant/contractor

KEY COMMERCIAL CONTRACT CONSIDERATIONS

Registration of commercial agreements

There is no law requiring registration of commercial agreements. However, if a commercial agreement will result in the transfer, pledge, license of any registered trademark, patent (including invention patent, utility model patent and design patent) or circuit layout, they shall be recorded with the competent authorities. Failure to register will render such transfer, pledge and license unenforceable against the competent authorities and any bona fide third party.

Recognized language of commercial agreements

The law is silent on the recognized language of commercial agreements. Chinese is the usual language for commercial agreements among local people, and English is the usual language for the agreements between local people and foreigners.

Country-specific issues for online content
The Copyright Act provides some limitations on liability for Internet service providers (i.e., connection service provider, a caching service provider, an information storage service provider and a search service provider) as long as, among other obligations, they:

- By contract, electronic transmission, automatic detective system or other means, informs users of their copyright or plate right protection policy, and takes concrete action to implement it

- By contract, electronic transmission, automatic detective system or other means, informs users that in the event of alleged copyright infringements up to three times, the service provider shall terminate the service in whole or in part

- Publicly announce information regarding their contact window for receipt of copyright infringement notices

**Enforceability of online/clickwrap/shrinkwrap terms**

Generally speaking, online is deemed one of the ways, tools or media for entering into agreement and online terms/click wrap/shrink terms are also generally enforceable – provided, however, that, according to the Consumer Protection Act, more obligations are imposed upon suppliers/sellers online, compared to offline transactions, such as:

- Certain information must be clearly and conspicuously provided in writing in advance

- Suppliers/sellers shall provide consumers with information that they are entitled to return the products within 7 days without any cause and suppliers/sellers are responsible for all expenses and costs for such return

- When consumers notify suppliers/sellers of rescinding the contract in writing, suppliers/sellers shall retrieve the goods within 15 days, unless the parties have agreed otherwise

- Consumers shall not be responsible for keeping custody of any unsolicited goods

**Governing law**

Governing law and jurisdiction for resolution of disputes specified in a commercial contract will generally be accepted and recognized by Taiwan 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**

Warranty disclaimers are enforceable in Taiwan provided that appropriate conditions of the products/services are expressly specified and disclosed.

**Enforceability of exclusions/limitations of liability indemnification**

Exclusions/limitations of liability are enforceable in Taiwan – provided, however, that responsibilities/liabilities for
willful misconduct or gross negligence shall not be released in advance and in certain situations; if the transaction is obviously unfair, an application may be filed to the court for adjustment of liability.

**Indemnification**

Express indemnities stated in contracts are recognized and generally respected and cap on liability under indemnification provisions can generally be enforceable – provided, however, that responsibilities/liabilities for willful misconduct or gross negligence shall not be released in advance and, if the agreed indemnification is disproportionately high, the court may reduce it to a reasonable amount.

**Electronic signatures**

Except for some situations as specifically provide under Taiwan law, electronic signatures are generally recognized and enforceable in Taiwan as long as the parties concerned agree to conclude the contract electronically; the content of the contract can be presented in its integrity and remains accessible for subsequent reference; and the electronic methods used meet the requirements of the Electronic Signatures Act. A contract concluded as required by the Electronic Signature Act will have the same effect as a contract as physical paper and signatures.
UKRAINE

INTELLECTUAL PROPERTY FRAMEWORK

Overview

Intellectual property rights in Ukraine are mainly regulated by Civil and Commercial Codes as well as specific laws pertaining to separate intellectual property objects. Further, Ukraine has ratified a majority of international treaties pertaining to intellectual property rights protection.

Following Ukraine's ratification of the EU Association Agreement, Ukraine is bringing its intellectual property legislation in line with EU standards. Specifically, changes to the regulation of geographical indications, trademarks, inventions, utility models and topographies are expected.

COMMERCIAL CONTRACT FRAMEWORK

Overview

Commercial contracts in Ukraine are governed by the Civil Code of Ukraine dated January 16, 2003 as well as Commercial Code of Ukraine dated January 16, 2003, which contain general rules about contract formation, enforceability and termination, as well as specific provisions applicable to certain types of contracts. Certain provisions pertaining to contracts can also be found in other laws regulating particular spheres such as e-commerce, technology transfer and others.

COPYRIGHTS

Nature of right

In Ukraine, copyright protection is granted to original works of authorship fixed in any tangible medium of expression. Copyright arises from the moment of creation of work and does not require registration or fulfilment of any other formalities to enjoy protection. Registration of copyright is possible in Ukraine on a voluntary basis and does not affect the validity of rights. Copyright protection is granted to both published and unpublished
works, complete and incomplete, irrespective of their designation, genre, volume or purpose. Further, a part of a work that may be used independently, including its original name, is treated as a work that can enjoy copyright protection.

Copyright owners have an exclusive right to reproduce, distribute, publicly perform and publicly display their works of authorship. In addition, copyright owners have moral rights, such as the right to claim authorship by way of indicating the author's name on the work, the right to prohibit mentioning his or her name during public display of work or to choose pseudonym, as well as the right to protect integrity of their work. Moral rights cannot be assigned or transferred to third parties.

Legal framework


Duration of right

Copyright protection lasts for 70 years after the death of an author or the death of the last co-author. Copyright to anonymous or pseudonymous works shall continue for 70 years after the work is lawfully made available to the public.

Moral rights of the author exist perpetually.

Ownership / licenses

Under Ukrainian law, the author of a work is the initial copyright holder. Unless proven to the contrary, the person indicated as an author of the original or a specimen of a work is deemed to be the author of such work. Only natural persons may be recognized as authors in Ukraine.

Persons who created a work jointly are considered co-authors under Ukrainian law. Copyright with respect to a work created in co-authorship is vested with all co-authors irrespective of the fact whether the work represents one inseparable item or is composed of parts each having independent significance. Relations between co-authors are regulated by an agreement between them. The right to publish the work or use the work in another way may be exercised by all co-authors jointly. If a work created in co-authorship is composed of parts each having independent significance, each co-author has a right to use his or her independent part of the work without consent of the rest of co-authors unless otherwise provided in the agreement concluded between them.

Copyright owners may grant the right to use or assign their rights to other parties either partially or wholly through a license or an assignment agreement. Licensing of a copyright to the works which have not been created yet (ie, future works) is prohibited. Any licensing arrangements shall be executed in writing. The rights which are not specifically listed as licensed or assigned in the agreement are regarded as not licensed or assigned respectively.

The relations on collective management of rights have been regulated in the recently adopted law "On the Effective Management by the Tangible Rights of Rightsholders in the sphere of Copyright and (or) Related Rights" as of May 15, 2018 which is aimed to make the system of collective management more effective and transparent in Ukraine.
Remedies for infringement

A copyright owner may seek the following remedies under Ukrainian law in case of infringement of its rights:

- Recognition and restoration of rights cessation of infringing acts
- Reimbursement of moral or monetary damages
- Recovery of revenue received as a result of the infringement
- Payment of compensation (a lump sum) in the amount of double (or in case of intentional violation - a triple) amount of remuneration or commissions that would have been paid if the infringer would apply for permission to use the disputed copyright object
- Seizure of infringing goods
- Prohibition of import
- Publication of court decision on the case concerning copyright infringement

Since April 2017, Ukraine has introduced a notice and take down procedure in relation to online copyright infringements.

Further, under the Criminal Code of Ukraine dated April 5, 2001 criminal penalties for copyright infringements are also available.

MASK WORKS / TOPOGRAPHIES

Nature of right

Ukrainian law ensures protection of topographies if they are original. A topography is considered to be original if it is not created by direct reproduction (copying) of another topography, has characteristics that ensure new peculiarities and had not been known in the field of microelectronics before the date of filing of an application to the Ukrainian IP Office or before the date of its first use. A topography of integral circuit shall be considered original until proof to the contrary is provided.

Intellectual property rights to topographies are subject to registration with the Ukrainian IP Office.

An owner of a registered topography enjoys exclusive rights to use the topography, prohibit such use by third parties and assign or license the right to topography. Use shall mean the reproduction, import and distribution of the topography or integrated circuits produced with the use of such topography.

Legal framework

**Duration of right**

The duration of protection is ten years from the date of filing of an application or the first use date. Registration must be filed within two years upon the first use of the topography.

**Ownership / licenses**

Under Ukrainian law, the author of a topography is the initial intellectual property rights holder.

The persons who created a topography jointly are considered as co-authors under Ukrainian law. The exclusive rights with respect to a topography created in co-authorship are vested with all co-authors. Relations between co-authors are regulated by an agreement between them.

The rights holders may grant the right to use or assign their rights to other parties through license or assignment agreement, which should be in writing.

The assignment of exclusive rights to a topography is subject to mandatory registration with the Ukrainian IP Office.

**Remedies for infringement**

The owner of exclusive rights to a topography or the authorized person (eg, licensee) may seek the following remedies under Ukrainian law:

- Termination of the infringement
- Cancellation of the infringing certificate for topography
- Reimbursement of damages (including loss of profit)
- Recognition of a right
- Publication of the court decision on the case concerning IP rights infringement

Further, the Criminal Code of Ukraine dated April 5, 2001 provides for criminal liability for infringements of intellectual property right with regard to topographies.

**PATENTS**

**Nature of right**

Patents in Ukraine protect exclusive rights in inventions and utility models. The products and/or processes or new application of the known product or process may obtain protection as inventions and/or utility models.

Ukrainian laws stipulate the following patentability requirements for objects eligible for patenting:
• Inventions: including novelty, inventive step and industrial applicability

• Utility models: including novelty and industrial applicability

The rights to inventions and utility models are subject to registration with the Ukrainian IP office in order to be protected in Ukraine.

The owner of the patent to invention or utility model has the exclusive right to prohibit the third parties from producing, using, selling or importing the product or applying the method that are protected with the patent.

Legal framework


Duration of right

The patents to inventions are granted for 20 years from the date of application, which may be extended for another five years if invention relates to pharmaceutical or crop science industry. The patents to utility models are granted for 10 years from the date of application.

Ownership / licenses

Under Ukrainian law the inventor is the initial intellectual property rights holder.

The persons who created an invention or utility model jointly are considered as co-authors under Ukrainian law. The exclusive rights with respect to an invention or utility model created in co-authorship are vested with all co-authors. Relations between co-authors are regulated by an agreement between them.

The right holders may grant the right to use or assign their rights to other parties through license or assignment agreement, which should be made in writing. The assignment of patent rights is subject to mandatory registration with the Ukrainian IP Office. Ukrainian law prescribes that compulsory license to inventions/utility models may be imposed in certain cases.

Remedies for infringement

The patent owner or an authorized person (eg, licensee) may seek the following remedies under Ukrainian law:

• Termination of the infringement

• Cancellation of the infringing patent

• Reimbursement of damages (including loss of profit)

• Recognition of a right
• Seizure of infringing goods

• Prohibition of import

• Publication of the court decision on the case concerning IP rights infringement

Further, the Criminal Code of Ukraine dated April 5, 2001 provides for criminal liability for infringements of intellectual property right with regard to inventions and utility models.

**TRADEMARKS**

**Nature of right**

In general, Ukraine is a first-to-file jurisdiction, which means that trademark rights arise out of registration of the trademark with the Ukrainian IP Office. However, well-known trademarks are protected regardless of registration in Ukraine based on the decision whereby they are recognized/well-known by the Ukrainian IP Office or the court.

A trademark under Ukrainian law is a designation distinguishing the goods or services of one entity from the goods or services of others.

Any words (including proper names), letters, numerals, figurative elements, three-dimensional designs, colors and combinations of colors or any combination thereof, may be protected as a trademark. Moreover, sounds may also be protected as trademarks if it is technically possible to register and publish them.

A trademark holder has the exclusive right to prohibit the third parties from offering, marketing, using, importing, exporting and labelling their products with an identical or similar trademark for identical or similar goods or use the trademark in business documents or on the internet.

**Legal framework**


**Duration of right**

Trademark registration is valid for 10 years from the date of filing an application with the Ukrainian IP Office and may be extended each time for another 10 years upon the request of the registration holder, provided a renewal fee is paid.

**Ownership / licenses**

The exclusive rights with respect to a trademark may be subject to joint ownership. Relations between co-owners are regulated by an agreement between them. When there is no such agreement, each co-owner may use the
trademark at its own discretion, however, all co-owners must consent to the grant of the license to the co-owned trademark.

The rights holders may grant or assign their rights to other parties through a license or an assignment agreement, which should be in writing.

The assignment of patent rights is subject to a mandatory registration with the Ukrainian IP Office.

**Remedies for infringement**

The trademark holder or authorized person (e.g., licensee) may seek the following remedies under Ukrainian law:

- Termination of the infringement
- Cancellation of the infringing trademark certificate
- Reimbursement of damages (including loss of profit)
- Recognition of a right
- Seizure of infringing goods
- Prohibition of import
- Publication of the court decision on the case concerning IP rights infringement

Further, the Criminal Code of Ukraine dated April 5, 2001 contains criminal liability for infringements of intellectual property right with regard to trademarks.

**TRADE SECRETS**

**Nature of right**

The Ukrainian law provides that a trade secret is information that is secret in the sense that it is not, as a whole 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, has commercial value because it is secret and has been subject to reasonable steps under the circumstances, by the person lawfully in control of the information to keep it secret.

Certain information which includes, *inter alia*, the information on charter documents and tax payments shall be not protected as commercial secret in Ukraine by virtue of law.

A trade secret is in the exclusive ownership of the person that classified such information as trade secret.

The owner of the trade secret has the exclusive right to use the trade secret as well as prohibit the third parties from such use.
Legal framework


Duration of right

As long as reasonable efforts are taken by the owner of the information to maintain the information as a secret, it will be qualified as a trade secret.

Ownership / licenses

Joint ownership is possible. Trade secret (or know-how) licenses are enforceable.

Remedies for infringement

The trade secret owner may seek the following remedies under Ukrainian law:

- Termination of the infringement
- Reimbursement of damages (including loss of profit)
- Seizure of infringing goods
- Publication of the court decision on the case concerning IP rights infringement

Further, the Criminal Code of Ukraine dated April 5, 2001 provides for criminal liability for infringements of intellectual property right with regard to a trade secret.

OTHER KEY IP RIGHTS

Nature of right

Patents to industrial designs

Designs in Ukraine are protected by patents. The patents to industrial designs protect the results of creative activity of an individual in the area of industrial designing. For industrial designs, Ukrainian laws contain the patentability requirement of novelty.

The rights to designs are subject to registration with the Ukrainian IP office in order to be protected in Ukraine. The owner to industrial design patent has the exclusive right to prohibit the third parties from producing the products based on the registered industrial design.

Legal framework

Patents to industrial designs

**Duration of right**

**Patents to industrial designs**

The patents for industrial designs are granted for 10 years from the date of application, which may be extended for another 5 years.

**Ownership / licenses**

**Patents to industrial designs**

Under Ukrainian law the design author is the initial intellectual property rights holder.

The persons who created a design jointly are considered as co-authors under Ukrainian law. The exclusive rights with respect to a design created in co-authorship are vested with all co-authors. Relations between co-authors are regulated by an agreement between them.

The right holders may grant or assign their rights to other parties through license or assignment agreement, which should be in writing. The assignment of patent rights is subject to mandatory registration with the Ukrainian IP Office.

**Remedies for infringement**

**Patents to industrial designs**

The patent owner or authorized person (e.g., licensee) may seek the following remedies under Ukrainian law:

- Termination of infringement
- Cancellation of infringing patent to industrial design
- Reimbursement of damages (including loss of profit)
- Recognition of a right
- Seizure of infringing goods
- Prohibition of import
- Publication of court decision on the case concerning IP rights infringement

Further, the Criminal Code of Ukraine dated April 5, 2001 provides for criminal liability for infringements of intellectual property right with regard to industrial designs.
INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

Employees

Ukrainian copyright legislation recognizes a "work for hire" doctrine in which an employer owns works of authorship created by an employee within the scope of employment. At the same time, the transfer of IP rights on work for hire objects from employee to employer must be formalized in writing. Otherwise, arguably by virtue of Ukrainian law only 50% of the IP rights on created objects would be deemed owned by the employer, while the other 50% will remain owned by the employee. It is customary for IP relations to be regulated in the written employment agreement.

Another more complicated procedure is provided by the Ukrainian laws with respect to patent rights to inventions, utility models and industrial designs. An employee must notify an employer in writing about the fact of creation, including the detailed description of the creation. Within four months from the date of receipt of the notification, an employer should:

• File application for the patent or transfer such right to third party or

• Decide to keep the creation as confidential information

Within four months from the date of receipt of notification, an employer shall conclude an agreement with an employee formalizing the transfer of rights from employee and payment of remuneration to the employee.

Failure to do the above actions allows an employee to file the application for the patent.

Consultants / contractors

The "work for hire" doctrine applies to relations with individuals acting as consultants or contractors. Similarly, as in employment relations, transfer of IP rights from consultants or contractors to work for hire objects must be formalized in writing. Otherwise, if no IP transfer provisions are included to the contract, by virtue of Ukrainian law the IP rights to created objects would be deemed owned by the parties jointly.

Under Ukrainian laws "work for hire" doctrine does not work in relations between legal entities. Therefore, no automatic transfer of IP rights between legal entities is possible under Ukrainian laws. Normally, transfer of IP rights to deliverables created under respective agreement between legal entities shall be confirmed by an act of acceptance of services resulting in creation of respective IP rights objects. At that, the IP rights will be transferred under such agreement from the moment of signature of respective act of acceptance. The act of acceptance shall provide for sufficient description of deliverables to which the IP rights are assigned.

KEY COMMERCIAL CONTRACT CONSIDERATIONS

Registration of commercial agreements
Generally, there are no registration requirements applicable to commercial contracts.

Assignment agreements in relation to registered IP objects, eg trademarks, inventions, utility models and industrial designs are subject to obligatory registration with the Ministry of Economic Development and Trade of Ukraine. The assignment of rights to these objects shall be valid for third parties from the moment of registration of assignment agreement.

License agreements for use of registered IP objects (eg, trademarks, inventions, utility models and industrial designs) are subject to voluntary registration with the Ministry of Economic Development and Trade of Ukraine, which does not affect validity/enforceability of such agreements.

Further, under Ukrainian law agreements of transfer of title to real estate (eg, sale and purchase agreement, exchange, donation, etc.) are subject to mandatory notarization. Acquired title to real estate is subject to mandatory state registration in the State Register of Proprietary Rights to Real Estate as, under Ukrainian law, a title to real estate arises on the date of its state registration.

If the lease term amounts to or exceeds three years, the lease agreement is subject to notarisation and the lease title is subject to mandatory state registration.

**Recognized language of commercial agreements**

A commercial contract with a Ukrainian party is highly recommended to be provided in Ukrainian or be bilingual, ie, in Ukrainian and language of the other party.

**Country-specific issues for online content**

The E-Commerce Law dated September 3, 2015 is the key law on online transactions. It sets forth an obligation of sellers to provide customers with certain mandatory information. It also establishes a procedure for concluding an online agreement as well as confirmation of the received order.

Considering that online transactions are performed with the use of telecommunication services, which are rendered by diverse intermediary service providers (eg, providers of hosting, caching services), their role in the transaction may be qualified as pure provision of services or as a party to the transaction. If service providers are not involved into the transaction (ie, they do not initiate the transfer of information, do not choose its recipient and are not able to amend its content), they cannot be liable for infringements related to e-commerce transactions. However, if copyright or related rights are violated, the intermediary service providers cannot take advantage of the safe harbor. In such cases, the intermediary service providers are obliged to take necessary actions for protection of the right holder, eg, to consider the takedown notices, block the illegal content or to delete it when appropriate.

**Enforceability of online/clickwrap/shrinkwrap terms**

Ukrainian legislation does not distinguish such forms of agreements as online, clickwrap or shrinkwrap agreements (or terms). Formally, the agreements concluded according to the requirements of the E-Commerce Law (presumably, online or clickwrap agreements) are deemed enforceable. Additionally, the law established that the validity of the electronic document cannot be denied solely due to the electronic form of the document. However,
in practice such forms of agreements may be rejected by controlling authorities. For example, state authorities require that the software licences must be provided in a written form to duly confirm the rights of the Ukrainian legal entities to use relevant software.

**Governing law**

Under Ukrainian legislation, parties to the agreement may choose the governing law provided that a foreign element is present in respective contractual relations. In particular, a foreign element is considered to be present in the following cases:

- One of contracting parties is a foreign legal entity
- An object of legal relationship is located on the territory of the foreign state
- Legal fact in result of which legal relations arise, which changes or terminates legal relationship takes place in the territory of the foreign state

At the same time, it should be noted that Ukrainian legislation envisages certain exceptions when governing law regulated by agreement shall not apply and Ukrainian law shall be found applicable.

Namely, the governing law of the agreement will not apply if its application causes consequences that are incompatible with the public order of Ukraine. In addition, the imperative (mandatory) norms of the Ukrainian legislation will still apply. At this point, we note that Ukrainian law does not define which provisions are imperative (presumably, these are provisions of public nature, for instance payment of taxes, antimonopoly issues etc., but it should be decided in each particular case based on complex analysis of Ukrainian law whether certain provisions of Ukrainian law should be treated as imperative).

Furthermore, please note that according to Ukrainian law, the law applicable to legal relations in the area of protection of intellectual property rights shall be the law of the country where the protection is sought. In the event there is any dispute between the parties to the agreement in connection with the protection of intellectual property rights within the territory of Ukraine, the laws of Ukraine will apply.

Ukrainian laws also provide that if it turns out that application of the chosen law is not possible in determining the order of fulfilment of the agreement or measures to be applied in the event of non-fulfilment or improper fulfilment of such agreement, the law of the country of performance of the agreement shall be applied. Therefore, theoretically Ukrainian law may be found applicable to the agreement in regard to the order of its fulfilment and the measures to be applied in the event of its non-fulfilment or improper fulfilment.

In relation to the choice of jurisdiction, the parties to the contractual relations with foreign element, eg, foreign entities, are free to choose foreign jurisdiction. However, it should be noted that Ukrainian courts would still have exclusive jurisdiction over some kinds of disputes with a foreign element, in particular, in disputes regarding intellectual property rights which are subject to patenting or obtaining a certificate in Ukraine, regarding real estate located within the territory of Ukraine, etc.

**KEY COMMERCIAL CONTRACT TERMS**
**Enforceability of warranty disclaimers**

Ukrainian law requires the guarantee to be granted by the producer (or its representative) of goods sold in Ukraine. Therefore, excluding guarantees, including the consumer guarantees, is not allowed. In case of commercial contracts, the parties are generally free to define the scope of the guarantee. Thus, the wording of the guarantee provisions may contain, in fact, a limited guarantee.

**Enforceability of exclusions/limitations of liability indemnification**

Ukrainian legislation generally provides a possibility for the parties to an agreement to limit the amount of damages (real damages or loss of profits) to be reimbursed under the agreement. However, in certain cases Ukrainian legislation directly prohibits contractual limitations of liability. In particular, parties cannot contractually limit the liability of the producer (seller or service provider) in case of death or injury caused to the consumer by the action or omission of such producer (seller or service provider) or liability for damages caused to consumers by the defective product. Contractual limitations of liability for deliberate breach of obligations is not allowed.

**Indemnification**

Under Ukrainian laws the damages shall be reimbursed in full unless otherwise prescribed by the agreement and in certain instances by law. Pursuant to Ukrainian laws the damages include:

- Actual damages - losses caused to the party in result of destruction or damaging of property, as well as expenses made/or need to be made by the party for restoring of its violated right

- Loss of profit

Further, under Ukrainian law parties to an agreement may establish the amount of penalties (fine, penalty interest) to be paid in case of failure of the parties to perform certain obligations under the agreement. The amount of penalties in the agreement can be determined as a percentage of the value of unfulfilled obligations, as a fixed monetary amount, as a percentage of the value of obligations irrespective of the stage of their fulfilment or as the multiple amount to the value of goods (works, services).

However, for the breach of certain types of obligations, eg, monetary obligations, the level of penalties may not exceed a statutory determined limit. Ukrainian legislation stipulates that parties may define the amount of interest for the late payment of debts under the agreement, nevertheless the amount of penalty interest shall be calculated based on the sum of overdue debt and shall not exceed the double discount rate of the National Bank of Ukraine (NBU) effective during the period for which the penalty interest is paid. Current discount rate of the NBU is equal to 18% per annum (ie, double discount rate is 36%).

**Electronic signatures**

Electronic signatures are currently regulated by newly adopted Law of Ukraine "On Electronic Trust Services" dated October 5, 2017 which came into force on November 7, 2018. The new law is aimed at harmonization of Ukrainian legislation with EU regulations on this subject.

Effective Ukrainian legislation distinguishes among others on the use of electronic signature and qualified electronic signature. Only qualified electronic signatures have the same legal standing as handwriting signatures.
The qualified electronic signature is a type of the electronic signatures, generated in result of cryptographic transformation of set of electronic data to which this electronic signature relates, using the personal key uniquely associated with the signer, and which enables the electronic identification of the signer and to detect a violation of the integrity of the electronic data associated with this electronic signature; qualified electronic signature is based on a qualified public key certificate that is issued by a qualified trust service provider.

Currently non-residents of Ukraine cannot obtain electronic digital signature and electronic digital signature generated abroad is not accepted in Ukraine. However, the law provides terms recognition of qualified electronic signatures provided by foreign suppliers of electronic trust services in Ukraine. Namely, the foreign qualified trust service provider must meet the requirements of Ukrainian legislation (which must be confirmed by the Ministry of Justice of Ukraine) and the foreign qualified trust service provider must be included in the trust list of the country with which Ukraine has concluded a relevant international treaty. That being said, no such international treaty has been concluded so far.

The use of electronic signature, ie, graphic reproduction of the personal handwritten signature, will be permitted only if the parties have agreed in writing about such form of execution of the documents and if they attach the examples of such signatures to the agreement. In other cases, the use of the electronic signature may be unenforceable.

### KEY CONTACTS

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UNITED ARAB EMIRATES

INTELLECTUAL PROPERTY FRAMEWORK

Overview

In the United Arab Emirates (UAE), intellectual property rights are governed by the following Federal Laws:

2. Federal Law No. 7 of 2002 (Copyright Law)
5. Federal Law No. 19 of 2016 on Combatting Commercial Fraud (Anti Commercial Fraud Law)

In addition, the UAE is a civil law jurisdiction, so the laws and regulations are codified. Court judgments are not routinely published. Moreover, UAE courts are not bound to follow the prior decisions of superior courts, although 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

Overview

Commercial contracts are generally governed by:

1. Federal Law No. 2 of 2015 (Commercial Companies Law)
2. Federal Law No. 18 of 1993 (Commercial Transactions Law)
3. 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. 18 of 1981 (as amended) (Agency Law).

COPYRIGHTS

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." The work must be original, but the threshold for originality is low - essentially the work must not be copied from another work.

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, registration is likely to be a prerequisite for a successful enforcement action in the UAE courts.

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

For most categories of works, 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 first day of the year following the year of first publication.

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 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

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 the detention of the infringer for no less than two months as well as order him/her to pay a fine of no less than AED 10,000 (approx. USD 2,700). 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 / TOPOGRAPHIES**

**Nature of right**

Mask works do not benefit from specific protection under the law in the UAE.

**Legal framework**

Not applicable.

**Duration of right**

Not applicable.

**Ownership / licenses**

Not applicable.

**Remedies for infringement**

Not applicable.
PATENTS

Nature of right

When it comes to product patent, the right to exploitation includes the manufacture, sale and use of the product or its import for the purpose of manufacture, sale or use.

In the case of industrial process or method patent, the right to exploitation include the use of the process or method itself as well as the rights to use or sell the product obtained directly by means of the process or method.

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

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

Federal Law No. 17 of 2002 on Patents (as amended) (Patent Law) governs patents. Patents may also be protected in the UAE through a Gulf Co-operation Council (GCC) Patent (administered by the GCC Patent Office in Saudi Arabia, and governed by the GCC Patent Law).

The UAE is a member of the Patent Cooperation Treaty 1970 (PCT) and WIPO Paris Convention for the Protection of Industrial Property 1883 (Paris Convention).

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. Producing false documents to obtain a patent, utility certificate, know how or an industrial design or drawing registration

ii. Declaring false information to obtain a patent, utility certificate or know how or an industrial design or drawing registration

iii. Copying an invention, a process, an element of know how or an industrial design or drawing

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 prohibitory injunctions (either on an interim or a final basis), which would order the defendant to stop the infringing acts. The claimant also has a right to claim damages in respect of the infringement.

**TRADEMARKS**

**Nature of right**

Registration of trademarks in the UAE is voluntary, but in practice, is highly advisable because the rights attaching to unregistered trademarks are limited (especially for marks which are not well-known internationally).

Registration 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). The UAE has adopted the 10th edition of the Nice Classification.

The owner of a registered trademark is considered the exclusive owner of the mark in the UAE.
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 10th 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

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.

The court can make an order for the cancellation of a mark for non-use. The party/ies must prove 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 and any user of the trademark should be recorded as such at the Ministry of Economy. For recordal purposes, 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.

The term of the license must not exceed the term of the registration. All licenses are non-exclusive unless expressed to be otherwise.

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.

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 committed. However, civil proceedings must be commenced very quickly afterwards which limits the effectiveness of this type of Order.

Involvement in counterfeiting is punishable under the Anti Commercial Fraud Law. Penalties include imprisonment and fines up to AED (one) 1 million (approx. USD 270,000) for pharmaceutical and food products and AED 250,000 (approx. USD 68,000) for other products. Penalties can be doubled in case of repeat violations.

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 destruction of goods bearing unlawful marks and/or 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.

**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, in accordance with custom or the timeframe specified in 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 and may be ordered to pay 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.

Article 127 of the Labor Law indirectly protects intangible assets in the form of confidential information (e.g., clients and business secrets) by permitting an employer to include a restrictive covenant in the contract of employment. Employees can be subject to a ban on working for a competitor within a specified location, business and period although great care should be taken in drafting to ensure that the terms are reasonable. Such clauses are usually enforced by an action in damages and as such, liquidated damages clauses are often coupled to the restrictive covenant. The Civil Code states that liquidated damages clauses attached to restrictive covenants must not be “exorbitant” and this is usually linked to both the realistic losses but also the ability of the employee to pay any award.

**Legal framework**

Trade 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 (approx. USD 5,450).

**OTHER KEY IP RIGHTS**

**Nature of right**

Not applicable.

**Legal framework**

Not applicable.

**Duration of right**

Not applicable.

**Ownership / licenses**

Not applicable.

**Remedies for infringement**

Not applicable.

**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, “agency” agreements that are exclusive and concluded with either an Emirati individual or a company which is 100% Emirati can be registered with the Ministry of Economy as a commercial agency under the Agency Law. In this context, “agency” has a broad meaning and will include any contract for the offer, sale or distribution of goods or services (e.g., franchise and distribution agreements and trademark licenses).

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 any choice of law or jurisdiction 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

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 AED 5,000...
(approx. USD 1,360) 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)

iv. Issue civil proceedings against the principal for breach of contract and breach of the Agency Law to:

- Claim compensation
- Claim the commissions made by such agents on any sales of the products made in their territories

Where the agreement is registered, 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, which meets the criteria for registration) 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 being treated as a registered agreement and 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.

**Country-specific issues for online content**

Not applicable.

**Enforceability of online/clickwrap/shrinkwrap terms**

Article 12 of the Copyright Law provides that the assignment of rights to commercial exploitation pertaining 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, eg. 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 indemnification

Under UAE law, absolute exclusions of liability in contracts are null and void. Restrictions on the ability of one contracting party to recover losses arising from fault by the other contracting party are not generally enforceable in the UAE, unless this fault is the result of fraud or gross misconduct. Moreover, 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 permitted 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.

Electronic signatures

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.
UNITED KINGDOM

INTELLECTUAL PROPERTY FRAMEWORK

Overview

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 currently part of the European Union (EU), some of its intellectual property law derives from EU legislation.

The UK’s vote in June 2016 to leave the EU has no immediate consequences and does not affect the position of the UK as an EU member state. There are no immediate changes to IP rights in the UK; however, the scope and status of these rights are addressed in the draft agreement for the UK’s withdrawal and, if the draft cannot be finally agreed, will be subject to other changes, in particular as regards EU-wide rights such as the EU trademark.

COMMERCIAL CONTRACT FRAMEWORK

Overview

The UK has three distinct legal systems:

  i. English law applicable in England and Wales

  ii. Northern Irish law applicable in Northern Ireland

  iii. Scots law applicable in 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, ie, 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.

**COPYRIGHTS**

*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 typographical arrangements of 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 interdicts 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 generally 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 certain infringements.

MASK WORKS / TOPOGRAPHIES

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, eg, 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 layer of semiconductor product
   ○ A layer of material in the course of and purpose of the manufacture of a semiconductor product

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

Provided the design qualifies for protection, protection arises automatically on creation of the design.

Protection expires 15 years from when the design was first recorded or an article made to it, or, if the design or an article made to the design is made available anywhere in the world during that 15-year period, it expires 10 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.
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

Principal remedies are injunctions (or interdicts 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 usually a reasonable license fee. Aggravated damages for flagrancy are possible.

It is also possible to prevent the import of infringing copies.

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:

- Be novel
- Involve an inventive step over the prior art
- Be capable of industrial application (which will be satisfied in almost all cases)
- 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 technical contribution to the art over and above the fact it is a business method or computer program.

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). There are also preparations to introduce a new European patent with unitary effect and a single Unified Patent Court. For more information consult the dedicated UPC page.

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 feature of the invention for putting the patented invention into effect in the UK is also prohibited.

**Legal framework**


**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. For medicinal and plant patents, supplementary protection certificates are available and extend duration up to the lesser of five years after expiry of the patent or 15 years from first marketing authorization.

**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, eg, 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 controls on sublicensing.

**Remedies for infringement**

Remedies for infringement can include injunctions (or interdicts 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. No statutory damages are available. The starting point for the damages calculation is generally a reasonable license fee.

It is also possible to prevent the import of infringing products.

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 European Union Trade Mark (EUTM) that applies to all EU member states.

A trademark is infringed by use of an identical sign for identical goods or services for which the mark is registered, or 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 an EUTM 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 Regulation EU/2017/1001 on the European Union Trade Mark (EUTMs), both as amended.

**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 (UKIPO) and EUTM registry (EUIPO) have a "first to file" system, though the registration may be refused or revoked if it conflicts with prior rights including unregistered rights.

There are certain advantages to be obtained from registering assignments or assignations and licenses, eg, 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 controls on sublicensing.

**Remedies for infringement**

Remedies for infringement include injunctions (or interdicts in Scotland), damages, an account of profits, orders for erasure, removal or obliteration of offending sign, orders for delivery up or destruction. No statutory damages are available. The starting point for the damages calculation is generally a reasonable license fee. Criminal penalties are also possible for certain types of infringement. There is also a customs seizure regime.

There is an actionable right in the UK against those who make unjustified threats of trademark infringement including if relying on EU Trade Marks as well as UK national marks. Companies should take care when writing to a third party alleging infringement or use of a similar mark.

**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, another obligation of confidentiality, or a common law action for breach of confidence.

A common law action for breach of confidence is based on 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," eg, 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).

In May 2016, the European Council adopted the EU Trade Secrets Directive, which EU member states (including the UK) were required to implement by May 2018. The Directive was implemented in the UK through the Trade Secrets (Enforcement, etc.) Regulations 2018, although these do not significantly change existing case law.

The Directive defines a trade secret as information that:

- Is secret (ie, not generally known or readily accessible to persons within circles that deal with such information)
- Has commercial value as it is secret
- Has been subjected to reasonable steps by the person in control to keep it a secret

The meaning of "reasonable steps" will be developed as the courts apply this law. Labelling something a trade secret is unlikely to be enough of itself.

The Directive prevents unlawful acquisition, use or disclosure of trade secrets (including unauthorized access). "Unlawful" requires the act to be unauthorized, or contrary to honest commercial practices.

Legal framework

Trade secrets are governed by the Trade Secrets (Enforcement, etc.) Regulations 2018 and case law.

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.

Ownership / licenses

Trade secrets are protected by the common-law tort action of breach of confidence. They do not give rise to property rights or "ownership" in the conventional sense. They may be exercised by anyone who is able to establish the necessary conditions (described above). Contractual licences to use trade secrets may be granted; while there is no legal requirement for these to be in writing or signed by either party, it is generally desirable for them to be signed and in writing, for certainty and evidential purposes.

Remedies for infringement

Injunctions (or interdicts in Scotland), damages, an account of profits, and delivery up or destruction of records of confidential information illegitimately retained are possible remedies for misappropriation

OTHER KEY IP RIGHTS

Nature of right

Passing off

The tort (or delict in Scotland) of passing off 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-up."

The "classic form" of passing off is generally defined by reference to three requirements:

- Goodwill in the UK attached to goods or services
- A misrepresentation by the defendant to the public (intentional or not) leading the public to believe its goods or services are those of (or connected with) the plaintiff
- The plaintiff suffers or likely to suffer damage due to that misrepresentation

However, the misrepresentation may be as to other matters, such as:

- That the plaintiff's goods are those of the defendant (reverse passing off)
- Misrepresentations as to quality
- 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.

An extended form of passing off requires:
• A misrepresentation

• Made by a trader in the course of trade

• To prospective customers or ultimate consumers

• Which is calculated to injure the business or goodwill of another, ie, such injury must be reasonably foreseeable

• Which causes actual damage to a business or goodwill

 Designs

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 parts of products, icons, maps, web design etc.

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 EUIPO (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 or configuration 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. The UK unregistered design right does not protect methods or principles of construction and is subject to an exception for use in relation to products which must fit or must match the protected design.

Legal framework

Passing off

Case law governs actions for passing off and they are not the subject of legislation although it is possible to rely on passing off to oppose trade mark applications by third parties under trade mark law.
Designs

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

Passing off

There is no duration; however, goodwill must still subsist. It is possible that a business may have residual goodwill, even if no longer trading and in some cases can be resumed at a later date.

Designs

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 design protection expires 15 years from when the design was first recorded or an article made to it or, if the design or an article made to the design is made available anywhere in the world during that 15-year period, it expires 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.

Unregistered Community design protection lasts for three years from the date that the design is made available to the public.

Ownership / licenses

Passing off

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.

Designs

Both the UK and EU registries 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 General 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
Passing off

Available remedies include injunctions (or interdicts in Scotland), damages, an account of profits and delivery up, seizure or destruction or modification of packaging, products, marketing materials and similar.

Designs

Available remedies include injunctions (or interdicts 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. Companies should therefore take care when writing to a third party alleging infringement or use of a similar mark.

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.

Some commercial agreements may need to be disclosed in certain circumstances, for example, in relation to public companies and contracts with public sector authorities.

There is 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 executed as a deed requires additional formalities to be satisfied but does not require consideration to pass between the parties in order to be binding (as is the case for a simple contract).
Documents governed by Scots law are not executed by way of a deed and do not require reference to the concept of "consideration." Statute sets out formalities which can be followed in order to ensure documents are self-proving: for commercial contracts to be formally valid, a document should be subscribed by an authorized signatory in the presence of a witness.

**Recognized language of commercial agreements**

There is no general requirement that contracts need to be in the English language in order to have legal effect. As a basic principle, in relation to consumer contracts and notices a trader must ensure that the written terms of the consumer contract and written consumer notices are in plain and intelligible language. The courts may strike out limitations or similarly onerous provisions in consumer facing contracts which are not worded sufficiently clearly or with sufficient prominence (or are otherwise blacklisted or deemed unfair by relevant legislation).

**Country-specific issues for online content**

Not applicable.

**Enforceability of online/clickwrap/shrinkwrap terms**

The legal enforceability of shrinkwrap terms has historically been somewhat debated by academics (though common commercial practice). The Consumer Rights Act 2015 now sets out a consumer's rights and obligations under business-to-consumer supply contracts for digital content (business-to-business being out of scope). Consumers now have statutory rights against the business supplier regarding the quality and title of digital content supplied, whether that be downloaded online or supplied as part of physical goods such as DVDs and CDs.

There are a number of requirements which relate to online terms which govern transactions entered into or services provided over the internet. For example, the Electronic Commerce (EC Directive) Regulations 2002 and Consumer Contracts (Information, Cancellation and Additional Charges) Regulations 2013 set out details of the information that must be provided by the trader.

Certain information regarding the new European Online Dispute Resolution platform must now also be provided by online traders on their website and in their terms, if that trader is statutorily obliged to use this alternative dispute resolution procedure.

**Governing law**

Parties are free under Scots 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 uphold an express choice of law. However, such freedom of choice is unlikely in the case of a consumer contract. Moreover, 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 after 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, in Scotland, Arbitration (Scotland) Act 2010. There are also a number of alternative
dispute resolution procedures. These include mediation, early neutral evaluation and adjudication. Typically, traders now have access to alternative dispute resolution (ADR) providers in their sectors, should they choose to resort to ADR, to resolve any contractual disputes with consumers.

**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 some but not all of these implied terms. The terms implied by the SGA include a condition that the seller has the right to sell the goods (Section 12), that the goods conform to their description (Section 13), that the goods are of satisfactory quality (Section 14 (2)) and a condition that the goods supplied will be reasonably fit for purpose (Section 14 (3)).

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 (Sections 3 and 11C) and the quality (Sections 4 and 11D) 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 with the supplier will pay a reasonable charge. Sections 13 and 14 are covered by common law rather than statute in Scotland.

The extent to which terms implied by the SGA and the SGSA may be excluded is largely controlled by the Unfair Contract Terms Act 1977 (UCTA). In a commercial contract, some of the implied terms, such as those relating to quality or fitness for purpose, can be disclaimed (commonly referred to as "excluded") but only insofar as this is "reasonable." A typical approach is to expressly exclude an implied term, replacing it in the commercial contract with a more specific express term to cover the same issue. For example, the contract might exclude implied terms as to quality/fitness for any particular purpose but expressly include terms agreeing that the goods will conform with the bespoke specification.

The restrictions in UCTA do not apply to international supply contracts (where contracting parties have places of business in different countries and the goods either cross from one country to another, or offer and acceptance take place in different countries).

The rules set out above in this section do not apply to consumer contracts. The Consumer Rights Act 2015 sets out a consumer’s statutory rights over the quality of the goods, services and digital content that are supplied and the consumer’s statutory remedies for the trader’s breach of the supply contract. For example, the same quality requirements of the SGA and the SGSA referred to above are treated as the terms of the consumer supply contract for goods and services, and while similar, but different, rules apply to digital content. There are a number of terms in consumer contracts which cannot be excluded. The terms of consumer contracts and notices may also be considered unfair and not binding on consumers.

*Enforceability of exclusions/limitations of liability indemnification*

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...
Parties cannot, however, exclude or limit liability for:

- Certain implied warranties (for instance any clause which purports to supply goods without the right to do so)
- Death or personal injury caused by their, or their employees, negligence
- Fraud and fraudulent misrepresentation

Other common provisions seeking to exclude or limit liability (be they certain types of actions, such as negligence, or certain losses or claims, such as wasted management time) may need to pass the "reasonableness" test set out under UCTA in order to be valid and enforceable; 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 (in addition, please see the comments as to international supply contracts included in enforceability of warranty disclaimers).

English and Scottish contract provisions are construed Contra Proferentum (against the party that drafted them); therefore, care should be taken to ensure clarity and 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 its 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, terminated or expired, 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. As explained above, such a cap on liability may be subject to the reasonableness test depending on the circumstances.

**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.

**Electronic signatures**

The making of electronic contracts online is commonly accepted and there is no general prohibition at law to using electronic signatures to execute contracts. However, using electronic signatures can be difficult where there is a legislated set of formalities for executing contracts, such as in transactions involving the sale of real property...
or in the execution of deeds (including a deed of guarantee), and it is still commonplace for these agreements to be executed manually (in writing).

An electronic signature is widely defined under the Electronic Communications Act 2000 and can be anything that is incorporated into or associated with any electronic communication or electronic data for establishing the authenticity and/or integrity of that communication or data. Electronic signatures can be in a variety of forms, such as:

- By typing the signatory's name in an electronic document or email
- By scanning a written signature
- By clicking on a button on a website
- By using a signature made on a screen or entering some other form of digital signature that is unique to the signatory

Regardless of its form, it must be clear that the electronic signature is authentic and that the signatory intended to be bound by that communication or data. In 2018, the Law Commission in the UK launched a consultation which sought to address certain legal uncertainty surrounding the electronic execution of documents. The consultation closed on November 23, 2018 and, as at the date of writing, further information on the responses is awaited.

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INTELLECTUAL PROPERTY FRAMEWORK

Overview

As a general matter, intellectual property rights are governed by Federal statutes with certain exceptions, such as trade secrets, that are also governed by state law.

COMMERCIAL CONTRACT FRAMEWORK

Overview

There are no Federal statutes that govern commercial contracts generally. There are Federal statutes that may be relevant to certain commercial arrangements, eg, antitrust laws, and there are industry-specific regulations at the Federal level that may be applicable to contracts in particular industries. There are also state regulations applicable to specific industries that may be 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 that was drafted by private organizations as a recommendation on harmonizing the laws applicable to commercial transactions. The UCC governs transactions in goods, eg, buying and selling, security interests, letters of credit and other commercial transactions. Because each state has adopted its own version of the UCC, laws may differ slightly from state to state.

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 not adopted by more than just a few states (Virginia and Maryland).

The interpretation and enforceability of commercial contracts is generally a state law matter, governed by the laws of the state 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.

**COPYRIGHTS**

**Nature of right**

Copyrights are available for original works of authorship fixed in a tangible medium of expression. The rights arise at the time the original work of authorship is fixed in a tangible medium of expression, and registration is not required to validate the copyright. Registered copyrights are denoted by the symbol ©.

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

**Legal framework**

Title 17 of the US Code governs copyrights. The United States became signatory to the Berne Convention in 1988. However, though the Berne Convention grants authors moral rights, moral rights are not recognized in the US Copyright Act. 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. For 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 the copyright can be terminated within a five-year period beginning 35 years after the initial grant. If the rights granted include the right to publish, then the assignment can be terminated 35 years after publication or 40 years after grant of publication right, whichever is first.

**Ownership / licenses**

Joint ownership of copyrights is recognized, with each owner holding an independent right to use or license the use of the copyright in the work without the need to obtain the consent of the other co-owners. Each co-owner of a copyright has an obligation to account to the other co-owner(s), but the duty to account can be waived by contract. Implied licenses are also 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 US$750 to US$30,000 per work, at the discretion of the court. In cases where the plaintiff can prove willful infringement, damages can be as high as US$150,000 per work; conversely, in cases where the defendant can prove the infringement was innocent, the court can reduce the damages award to a sum of not less than US$200 per 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. Injunctive relief is also a possible remedy, including the ability to enjoin importation of infringing goods.

Criminal penalties are also possible.

MASK WORKS / TOPOGRAPHIES

Nature of right

The Copyright Act provides legal protection for original mask works fixed in semiconductor chip products.

Mask works are defined as a series of related images, however fixed or encoded:

- 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
- 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

- 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
- 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, which is administered by the Copyright Office, but is different from copyright protection.

Duration of right

The duration of protection is ten years from registration (terminating at the end of the tenth calendar year).
Registration must be filed within two years of first commercial exploitation.

**Ownership / licenses**

Joint ownership of mask works is recognized, with each owner holding an independent right to use or license the use of the mask work without the need to obtain the consent of the other co-owners. Each co-owner of a mask work has an obligation to account to the other co-owner(s), but the duty to account can be waived by contract.

**Remedies for infringement**

Statutory damages can be up to US$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.

Injunctive relief is also a possible remedy, including the ability to enjoin importation of infringing goods.

Criminal penalties are possible under certain circumstances.

**PATENTS**

**Nature of right**

Patents are a statutory right, granted consistent with a mandate in the 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 filed on or after June 8, 1995 have a term of 20 years from the earliest filing date of the application on which the patent was granted. For patents filed prior to June 8, 1995, the term of the patent is either 20 years from the earliest filing date, or 17 years from the issue date, whichever is longer. The US is a "first to file" system as of March 16, 2013.

For design patents, applications filed on or after May 13, 2015 have a term of 15 years from the issue date. Design applications filed before May 13, 2015 have a term of 14 years from the issue date.

**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*

The Lanham Act provides federal protection for unregistered and registered marks. Registered marks are signified by the symbol ®. Federal registration requires use in interstate commerce.

Common law marks are enforced by state law, and are signified by the symbol™.

State registrations are available for marks used in individual states.


*Duration of right*

Federal trademark registrations are in effect for ten years and are 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. Costs and reasonable attorneys’ fees can be recoverable 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.

TRADE SECRETS

Nature of right

On May 11, 2016 the Federal government enacted the Defend Trade Secret Acts (DTSA). The DTSA provides a federal claim for misappropriation of trade secrets. Until then, trade secrets have been protected only at the state level, with most states (other than New York and Massachusetts) adopting their own version of the Uniform Trade Secrets Act (UTSA).

States adopting the Uniform Trade Secret Act (UTSA) impose liability for improper acquisition of trade secrets; use or disclosure of a trade secret is not required for liability, though additional damages can accrue.

The UTSA defines trade secrets under a two-prong test:

- "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"

- 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

The DTSA creates a trade secret action under federal law that is intended to supplement, rather than preempt, state laws.

The UTSA has been adopted by 48 states, the District of Columbia and the US Virgin Islands. Some states have slightly broader or narrower definitions of trade secrets than others. The remaining states (New York and Massachusetts) 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.

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. The imposition of reasonable royalties instead of an injunction is permitted under exceptional circumstances.

Criminal penalties are possible under certain circumstances.

Similar remedies are also available under the DTSA, as well as a process by which plaintiffs may ask courts to order the seizure of property "necessary to prevent the propagation or dissemination of the trade secret."

OTHER KEY IP RIGHTS

Nature of right

Not applicable for this jurisdiction.

Legal framework

Not applicable for this jurisdiction.

Duration of right

Not applicable for this jurisdiction.

Ownership / licenses

Not applicable for this jurisdiction.

Remedies for infringement

Not applicable for this jurisdiction.

INTELLECTUAL PROPERTY IN EMPLOYMENT CONTEXT

Employees

It is customary for employees to sign inventions assignment and confidentiality agreements. However, 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.

The DTSA requires that employee inventions agreements that are executed or updated (ie, amendments or modifications to existing agreements) beginning on May 12, 2016 include notice of certain immunities provided under the law. The law gives an employee immunity from civil and criminal liability under state and federal law for disclosing a trade secret if the disclosure was made to report or investigate an alleged violation of law and the new law requires that companies include notice of such immunity in any agreement with an employee that governs the use of trade secret or confidential information. Failure to provide this notice would result in the company not being able to recover exemplary damages or attorneys' fees from the employee if the company were to sue the employee for misappropriation of trade secrets.

**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.

Contractor agreements with individuals (not contractors or consultants that are entities) must include the same notice described above under the DTSA for employee agreements in order for an employer of an individual contractor or consultant to preserve its right to recover exemplary damages or attorneys’ fees in a claim for misappropriation of trade secrets under the DTSA.

**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 specifically "plain English" that is consumer-friendly, is preferred, particularly in consumer-facing commercial agreements and terms.

**Country-specific issues for online content**

The Digital Millennium Copyright Act (DMCA) is a US copyright law that implements two 1996 treaties of the World Intellectual Property Organization (WIPO). The DMCA instituted criminal penalties for the production and distribution of technology, devices, or services intended to bypass technological means for controlling access to
copyrighted works.

The DMCA features a safe harbor provision for Internet service providers and other intermediaries to avoid liability for copyright infringement claims arising from transmitting, routing, or providing connections to infringing content, provided that the service provider registers a designated agent with the Copyright Office. Designated agent registrations must be made electronically, timely updated and renewed every three years.

**Enforceability of online/clickwrap/shrinkwrap terms**

Online, clickwrap and shrinkwrap agreements are generally viewed as enforceable if they are conspicuous and users have an opportunity to review and indicate affirmative assent, eg, 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 and 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 indemnification**

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.

**Electronic signatures**

The Federal ESIGN Act grants electronic signatures the same legal standing as pen-and-paper signatures in transactions affecting interstate and foreign commerce. Certain exceptions under the ESIGN Act include the creation and execution of wills, codicils or testamentary trusts and transactions governed by the Uniform Commercial Code.

At the state level, the Uniform Electronic Transactions Act (UETA) governs business, commercial, consumer and governmental transactions in 47 of 50 states (except Illinois, New York and Washington), as well as the District of Columbia, Puerto Rico and the U.S. Virgin Islands. The UETA contains exceptions similar to those under the ESIGN Act. The states that have not adopted UETA have nonetheless adopted rules that validate and govern electronically signed contracts.
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