

1. What IP is and main IPRs

Intellectual Property (IP) is, in very simple terms, a set of exclusive rights granted¹ by State authorities to creators of new ideas. Under the general notion of IP, there are different types of exclusive rights, which are suitable for different types of creations. By way of example:

- **PATENTS** are used to protect new inventions, i.e. new products or processes that represent technical solutions to existing technical problems. Smaller and less revolutionary inventions are protected as **Utility Models**.
- **TRADEMARKS** are used to protect signs that distinguish the products/services of a company or a physical person from those of competitors. They can take the form of one or more words, a logo, an image or a mixture of all these elements.
- **INDUSTRIAL DESIGNS** are used to obtain exclusive rights over the ornamental shape of utilitarian products and are particularly useful to protect efforts to improve the visual appearance of products.
- **COPYRIGHT** protects original creations in the artistic and literary field. By way of example, your company's written materials such as brochures, advertisements, reports, the software that was produced on your behalf, and anything that you write or draw with your pen or computer are automatically protected by copyright. Instead, the exclusive rights of persons and companies that contribute to the spreading of copyrighted works (such as Performers, Phonograms Producers and Broadcasting Organisations) are protected by **Related Rights**.
- **GEOGRAPHICAL INDICATIONS** protect signs that indicate that a product originates in a given geographical area and its qualities, reputation, or other characteristics are essentially due to its geographical origin.
- **TRADE SECRETS** protect any confidential business information that provides a company with a competitive advantage (precisely because it is kept secret). By way of example, more effective after-sales or marketing strategies, list of customers with their contact details and commercial preferences, etc. qualify for protection as trade secrets.
- **DOMAIN NAMES** protect the core part of your internet address. Often, but not always, domain names encompass your (main) mark.

Each IP right above gives you **EXCLUSIVE RIGHTS** over the outcome of your innovation. In other words (and subject to certain exceptions):

- Your innovation will be protected from your competitors in the market;
- Your innovation remains yours, and no one else can use it; and
- Anyone wishing to utilize your protected IPRs will have to obtain your prior authorization (and, of course, you will be able to determine the corresponding economic conditions).

These exclusive rights are your compensation and reward for your innovative endeavours, which almost systematically involve not only creativity, but also significant costs. However, it is crucial to remember that IP rights are territorial in nature. This fundamental principle, known as **Principle of TERRITORIALITY**, implies that you are protected only in those countries where your IP rights have

¹ Or "recognized" in the case of copyright (in view of the principle of automatic protection).

been duly filed and registered. As a consequence, if you plan to export your products or services to a new country, make sure to protect your relevant IPRs there before commencing commercialisation. Otherwise you will not be protected in the new country and anyone would be able to copy your innovative product or service.

Yes, your IPRs, when registered, are equivalent to a ... LAND WITH A STRONG FENCE: YOU OWN WHAT IS INSIDE!



2. Legal Requirements

Each country provides in its domestic legislation a set of legal requirements for the validity of each type of IP right. The good news is that, in view of their widespread membership in IP international treaties and conventions, such requirements are more or less the same in all AANZFTA parties.

TRADEMARKS

In order to be valid in ASEAN countries, Australia and New Zealand, a trademark must comply with the following legal requirements:

■ Distinctive Character

Trademarks should be capable of distinguishing the goods and/or services of a certain company (or individual/s) from those of other companies (or individuals). The notion of “distinctiveness” is therefore at the core of the notion of trademarks. However, often this concept is not defined in domestic trademark laws, which instead indicate that, in order to be valid, trademarks should not be, inter alia, “merely descriptive” or “generic”.

These notions are based on the famous “principle of SPECIFICITY” (or “speciality”) whereby marks are considered distinctive, descriptive or generic depending on the specific goods and/or services for which the marks are protected. This principle is therefore based on the strong link between the mark and the goods/services that it covers. For information, all goods and services are classified in accordance with an international treaty called “International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement” (in short: “Nice Classification”). It consists of 45 classes: 34 for products and 9 for services. For more information, please see: <http://www.wipo.int/classifications/nice/en/>

Real life examples might help with understanding the difference between a “distinctive mark” (which means that the mark is valid, strong), a “descriptive mark” (meaning that the mark is non-valid or at least weak) and a “generic mark” (which is obviously non-valid). For instance, the invented mark PEAR (with a logo representing a pear) would be:

- Distinctive if used for ... electronic appliances;

- Generic is used to sell ... pears;
- Descriptive for fruit juices.

Obviously, trademarks that have no meaning (such as KODAK®) cannot be descriptive or generic.

The analysis as to whether a proposed mark is distinctive or not has to be carried out using as a reference point the **average consumer** of that particular product in the country concerned. If the average consumer knows the meaning of the mark and he/she esteems that there is a direct relationship between the meaning/message of the mark and the goods/services covered by the mark, then the proposed mark is descriptive.

However, not all descriptive marks are unlawful. Only marks that are **essentially or merely descriptive** should be considered as such. Other circumstances may render a partially descriptive mark more distinctive and therefore stronger and valid. By way of example:

- A non-descriptive logo may be added to the word mark;
- The mark may be filed and used in a special script (and not in standard capital letters) or in a special colour (and not in black and white)

Finally, it should be recalled that the level of distinctiveness of a mark is not constant over time. It may increase or decrease, depending on a number of occurrences including the type and frequency of utilization of the mark. In other words, a partially descriptive mark may become more distinctive if used for years in a consistent manner. This phenomenon is called “**secondary meaning**” or “**acquired distinctiveness**”. On the other hand, the distinctive level of a mark may also decrease and disappear. This is the so-called “vulgarization” or “genericization” of the mark.

■ NOT DESCRIPTIVE

As already explained in the point above, a mark should not merely describe the qualities, characteristics, the origin, the intended purposes, etc. of the products or services covered by the mark itself. By way of example, the following terms might be problematic as almost systematically descriptive:

- Adjectives (such as: cheap, faster, beautiful, future, etc.);
- Laudatory expressions (such as: the best, number one, super, the king of ... etc.);
- Geographical terms (the name of a town, village, or place, as this would describe the origin of the products in question).

However, as already mentioned, not all the terms above would automatically render a mark null and void. If coupled with other distinctive terms or logos, the mark may be valid (though not necessarily very strong).

■ NOT MISLEADING

A mark cannot mislead the relevant public as to the qualities, characteristics, or origin of the products or services covered by mark itself. In other words, a trademark cannot convey a message that is not true.

By way of example, a geographical term (such as “Mandalay”) might lead consumers to believe that the products come from that place, and if this is not the case, the mark will be misleading as to the origin of the products. Similarly, the same would apply to a mark that hints to the “freshness” of the milk contained in the packaging, while the product consists of powdered milk.

■ NOT GENERIC

As already mentioned above, a generic mark is a sign that corresponds to the ordinary term used by the relevant public to name a particular product. No intellectual property law or institution would ever accept to grant exclusive rights to a single company or individual over a generic name, as this would amount to excluding everybody else from using it. By way of example, a producer of shoes could never obtain a trademark on the word “shoes” per se.

■ NOT CONTRARY TO PUBLIC ORDER, MORALITY

Trademarks cannot offend the sensitivity of people, their values, their morality, their religion, and cannot be against any domestic legislative text.

By way of example, names of drugs and of weapons, names linked to terrorist organizations and organized crime, words or images that are sexually explicit or vulgar may be rejected as trademarks, even if applied for products that are completely lawful if the country concerned (e.g. COCAINE for garments)

■ NOT identical to a national flag and other State emblems

Nobody should use for commercial purposes as a trademark the name of a country, its flag, or other national emblems, etc. Only the State can decide who is entitled to use such symbols and under what circumstances.

■ NOT IN CONFLICT WITH PRIOR RIGHTS

A trademark should not infringe the exclusive rights of owners of prior marks or of other IP rights. This is the so-called “relative grounds” for the refusal of a mark (as opposed to the previous legal requirements that are referred to as “absolute grounds”). In order to find out if a proposed mark is available (i.e. it is “new”) a trademark search should be conducted by using a reliable databank such as:

- **ASEAN TMView** available at: <http://www.asean-tmview.org/tmview/welcome.html>. This database is very useful to verify if a proposed mark is available for registration in any of the ASEAN countries (with the exception of Myanmar).
- **TMView**, available at <https://www.tmdn.org/tmview/welcome>. This search tool is useful to check the availability of a mark in all EU countries and in numerous other partner offices (please see full list of participating countries at the above internet address).
- **WIPO Global Brands database**, covering trademarks registered in a wide number of countries parties to WIPO, and available at: <https://www.wipo.int/branddb/en/index.jsp>.

A trademark is not considered as available if in the same country:

- There are prior identical or similar signs,
- For identical or similar goods and/or services.

The notion of “identical” signs is pretty straightforward, and it does not require much explanation for identical goods/services. On the contrary, some explanations are needed in the case of “similarity” between signs or between goods/services. In particular, two signs/trademarks may be similar from a:

- **VISUAL** point of view, i.e. when the two marks look alike, because of a number of elements, like colours, shapes, letters, etc.;
- **PHONETICAL** point of view, i.e. when the two marks sound similar;

- **CONCEPTUAL** point of view, i.e. when the meaning of the two marks is the same (e.g. the English word “house” and the Khmer term “ptea” have the same meaning and therefore if used as marks, they would be conceptually similar).

On the other hand, two products (or services) can be considered similar if they have the same purpose or the same public; the same channels of distribution or they are inherently linked (like a wheel of a bicycle and a bicycle). They can also be deemed as similar if one can replace the other, should the first not be available.

PATENTS

In order to be validly registered as a patent, an invention must:

- **Refer to a patentable subject matter:** many countries provide that, for example, discoveries, mathematical and scientific methods, methods for doing business, games, plants and animals are forbidden from patentability. It is therefore advisable to check the precise list of non-patentable subject matters contained in the patent law of the countries where the invention has to be protected.
- **Be new:** this means that invention cannot be “anticipated by the prior art”. This technical expression in reality simply means that the invention is not new if it was already disclosed to the public anywhere in the world by way of written or oral disclosures. For example, a patent will not be granted because of the lack of novelty if the invention:
 - is already covered by another earlier patent (registered or applied for), or
 - was described in detail in a conference, a study, an assessment, or
 - was simply used by someone somewhere around the world.

In order to find out if an invention is new a “novelty research” should be carried out by a technical specialist.

- **Have industrial applicability:** this means that the invention must be useful and capable of being reproduced on a large scale (by any industry, agriculture or fishery).
- **Have an inventive step:** an invention possesses an inventive step if it cannot be considered as obvious for the “man skilled in the art”. In other words, standing in the shoes of somebody who holds some level of expertise in the relevant technical field, only inventions that represent a real technological advance as compared to what already exists will qualify for patent protection.
- **Be fully disclosed:** a patent must describe in detail the invention, failing which the patent will not be granted or it can be canceled at any time.

INDUSTRIAL DESIGNS

Most countries provide that the legal requirements for an industrial design, whether 2-D or 3-D, are:

1. **Be New:** i.e. if it has not been disclosed to the public, anywhere around the world, by publication, display or simply used in any other way, before the filing date. If you want to find out if a particular design is new or not, you have to carry out an availability search by using tools such as **DesignView** available at: <https://www.tmdn.org/tmdsview-web/welcome> (and **ASEAN DesignView**, at <http://www.asean-designview.org/designview/welcome>).
2. **Not dictated essentially by technical or functional considerations:** merely functional or technical shapes do not enjoy protection as industrial designs, but if anything, as patents or utility models.

3. **Not contrary to public order or morality:** the particular 2-D or 3-D shape cannot be vulgar, offend people, values and beliefs.

COPYRIGHT

The only legal criterion for protection under copyright is ORIGINALITY. A given creation will therefore qualify for copyright protection if it is the original expression of its author. In other words, there will be no originality if the author has copied somebody else's work.

3. IP & Innovation: a must for SMEs

In the ASEAN Region, in Australia and New Zealand, business is booming and is forecast to continue to grow. By 2020, the middle-class population in Southeast Asia is estimated to reach 400 million. This is undoubtedly great news for local SMEs. However, the opening up of markets and new regional business opportunities also implies numerous new challenges that if not adequately tackled may seriously injure your business. These include:

- a. More competition from worldwide companies
- b. Need to reduce costs
- c. Shorter life-cycle for products
- d. Stricter legislative requirements
- e. Enhanced awareness and expectations by customers

Let's now see what you can do to properly tackle all the above issues, in order to foster your business competitiveness. If you want to survive enhanced competition, and actually beat your competitors; if you wish to become more successful and make more money, then you need to ... INNOVATE.

There are multiple ways in which you can innovate. However, most prominently you can:

- Provide new, enhanced and better products and services, and/or
- Provide the same products or services, but at competitively lower prices.

Needless to say, if you can do both ... your chances of success will be greater.

Innovation should take place at all levels of your business, from the analysis of customer needs (looking for new trends and possible niches); to the conception and prototyping phases; to efficient production, to the marketing and after-sale services. Your innovative efforts may result in some or all of the following:

- Your products are more attractive and eye-catching,
- Your products or services enjoy higher quality, or possess more functionalities,
- Their branding is improved,
- Their price is lower,
- Your marketing strategy is well-conceived and successful,
- Your after-sale services are excellent and well-thought-out.

However, innovating is hardly cost-free. It systematically involves significant human and financial resources. The only way in which you can ensure that nobody exploits your innovation without your

authorization, that no one takes a free ride by copying you, and that you alone take full advantage of your innovative endeavours² is by protecting your creative efforts through the appropriate IP right.

By looking at the examples above, if you have:

- Improved the ornamental or aesthetic shape of your products, you should protect this new form as **INDUSTRIAL DESIGN**;
- Found ways to improve the quality of your products or services or their functionalities, or discovered more efficient ways to produce them while reducing costs, most probably you can protect this invention through a **PATENT** or (if smaller) a **UTILITY MODEL**;
- Adopted a new name or created a new logo for your products or services capable of distinguishing them from those of your competitors, then you should run to protect this sign as **TRADEMARK**;
- Adopted especially successful marketing techniques and after sale services, you should make sure that you treat them as **TRADE SECRETS**;
- Developed written documents (e.g. internal manuals, brochures for your company, advertisements, etc.), you will be pleased to know that they enjoy automatic protection under **COPYRIGHT**.

4. How IPRs can Support SMEs Business

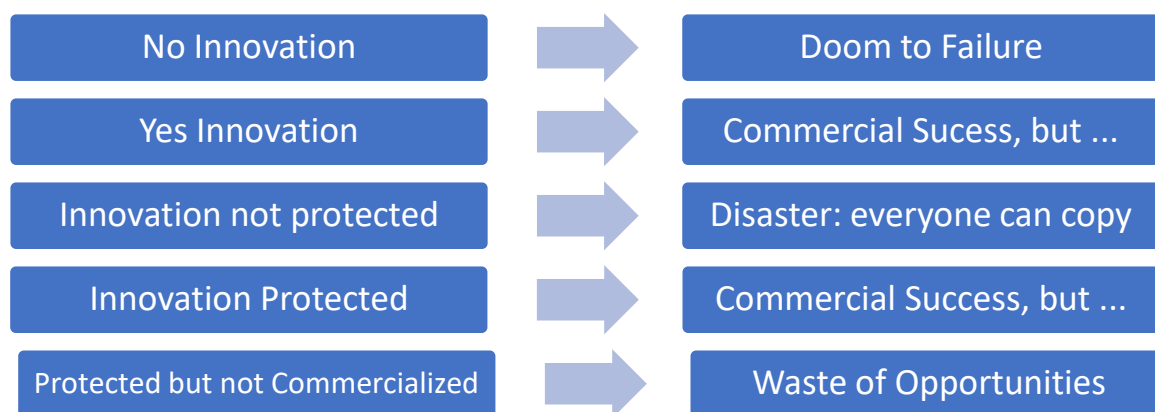
Now let's see the main advantages of IP, particularly for SMEs in the ASEAN region:

- First and foremost, as mentioned above, IP allows you to **protect the outcome of your creativity** and innovation. This means that, subject to some exceptions:
 - Nobody can copy what you have created,
 - Nobody can use it without your authorization,
 - You can set the conditions at which your goods will be sold and your services provided (and often this implies a premium price), and
 - Remember: you have exclusive rights! And this will give you, on the one hand, a stronger position on the market, and on the other, an excellent return on investment.
- Once protected, your IP rights can be **licensed-out** as many times as you wish, to numerous potential licensees (producers, distributors, agents, etc.) in various countries. This means that you can focus on your domestic market and relax at home, while your IPRs are operationalized in many countries and ... at the end of the month you will receive the corresponding royalties (see Handbook on IP Commercialisation, Section C.2 on Licensing).
- Conversely, if you don't have the necessary funds to undertake R&D to develop your own innovation and protect it under the relevant IPRs, then you still have a solution to innovate: identify the relevant innovative products or technologies which have been successfully developed by third parties in other countries, and obtain a license (is: **license-in**), under certain conditions (e.g. payment of royalties, etc.).
- Owning protected IPRs (whether developed by your company or acquired through a license) will allow your company to be a more credible and powerful partner in possible and profitable **cooperation and contractual agreements**. Through your IPRs, you will be able to attract investors and business partners from universities or research institutes to larger companies or other SMEs. Collaboration is important for SMEs in order to fill gaps in their own resources and

² Subject to a certain number of exceptions.

expertise, and to overcome their challenges in a strategic and resource-effective way, in areas such as:

- Product development;
- Improvement of innovative processes in all phases of the business cycle;
- Hastening of the commercialisation of new solutions;
- Reduction of the time to innovate;
- Increasing the scope of innovation; etc.
- In all these collaboration agreements and licenses (in and out), thanks to your IPRs, your company will have a stronger position and enjoy more **bargaining power**.
- Owning IPRs will make an SME more attractive to investors and more trustworthy to financial institutions. This is because IPRs have monetary value and can be used as collateral to guarantee loans. In other words, IP will enhance the company's **capacity to access capital and raise funds** (see Handbook on IP Commercialisation, Section A.4 on on raising capitals using IPRs).
- It is common knowledge that nowadays the **value of a company** is linked much more to its intangible assets (i.e. IPRs, whether registered or not), than to its tangible possessions and resources. By way of example, in 2019 the value of brands such as Amazon® and Apple® was estimated at USD 187.9 billion and USD 153.6 billion, respectively (see Handbook on IP Commercialisation, Section A.3 on IP Valuation).
- IP will also significantly help you in handling **litigations**, enhancing your chances of success, and reducing litigation risks (see Handbook on IP Commercialisation, Section IV of the on Enforcement).



However, unfortunately, many SMEs still struggle to take full advantage of IP. For many SMEs, it may be simply a question of ignorance of this relatively new topic that, at first, might seem of secondary importance and definitely less ... tangible! Other challenges for SMEs include:

- The costs for IP protection: registering your IPRs in many countries around the world can be a costly affair. However, it is an investment that it is well worth undertaking, as the return can be extremely valuable. Perhaps, if needed, consider partnering with other companies, institutions, SMEs, etc. to share the registration costs. Remember also that interesting discounted rates are applicable to applicants from Least Developed Countries.
- Widespread violation of IPRs (counterfeit and piracy) may discourage SMEs from obtaining protection, in view of the high potential of being unlawfully copied and considering the weaknesses of the domestic enforcement systems. However, the situation is getting better and better every day (see Handbook on IP Commercialisation, Section IV of the on Enforcement).
- Insufficient expertise in this legal field (both in terms of acquisition of IPRs and their management and Commercialisation). IP is not “rocket science”, but is quite unique, technical and complex in some aspects. In this context, we would advise you to:

- Carefully read the contents of this website section “IP for Business”, the “Handbook to IP Commercialisation”, and the “Business Guide to IP Institutions, Laws and Filing Processes in AANZFTA Parties”, available at AANZFTA website (<https://aanzfta.asean.org/>).
- Contact one of the institutions that provide free advice on IP, such as your national IP office, a chamber of commerce, IP and Innovation help desks; and
- Consult a specialist in your country (for these last two items, please refer to Chapter 3 of the Business Guide above).

II. COMMERCIALISATION OF IPRs

Introduction

IP Commercialisation is the process of bringing the IPRs to the market in order for them to be exploited in return for business profits and growth. In other words, there is no point in protecting your IPRs through registration, and then keep them locked in a drawer. In that case, your IPRs will have cost you money, but they would not bring you any income: not a wise choice. Instead, as soon as you have duly protected your IPRs, you should immediately commence their commercialisation so as to recoup the investment you made to develop or acquire them and protect them.

To reap the economic benefits from your IPRs, you have to make them available in the market, under particular conditions and for a particular return. This means that only if you put your IPRs on the market and exploit them to the fullest, you will be able to make money out of them and gain commercial success. In other words, **IP commercialisation is a must.**

As already mentioned, one of the greatest advantages of IPRs is that, in view of their intangible nature, they can be commercialized by several business actors at the same time, in different locations, through a variety of business models and contractual instruments. In other words, the return on investment can be phenomenal!



Commercialised IPRs



Non-Commercialised IPRs

In order to achieve business success, you will have to adopt a sound business strategy that encompasses all your IPRs and chose the most appropriate commercial tools for their commercialisation. This Section of the site will provide you with an “A to Z Guide” to make sure that:

- You are fully aware of what you have to do to start your commercialisation process (Section A), and what are the various options to protect your IPRs at home and abroad (Section B).
- You chose the most appropriate contractual arrangement to commercialize your IPRs (Section C).
- You properly manage your IPRs and avoid some common mistakes that could vanish your efforts to reach commercial success (Section D).
- You effectively use your IPRs online (Section E).
- You are capable of adopting the best technique to promote your business through branding, digital marketing, packaging, etc. (Section F).

Section A: YOUR FIRST STEPS FOR COMMERCIALISATION

1. Market Analysis

To guarantee the success of IP Commercialisation, a good market analysis should be carried out for all the markets where the new products or services will be commercialized. The term “markets” refers both to the geographical market (i.e.: the country where you want to commercialize your products or services that encompass your IPRs), as well as the specific product market (i.e.: the characteristics of the market relating to your products or services, such as the customers’ demand, the existence of competitors or substitute products, etc.).

Such market analysis should therefore entail an evaluation of:

- The value of your IP rights (see Section **A.3** on IP Valuation).
- Size of the potential market (is it a 4-million or 90-million people market?).
- Customers’ actual and potential demand.
- Customers’ purchasing power.
- Competing or similar products or services already in the market, or that might enter the market in the near future.
- Competitors’ size and capacity (actual and potential).
- Potential business partners – e.g. licensees or buyers.
- All relevant logistical issues to ensure that your products or services can effectively be delivered on that geographical market (e.g.: existence of infrastructure such as ports, airports, roads, delivery and transportation services, etc.).
- Domestic legal framework affecting your business.



WHY

SMEs should conduct a market analysis because it can help them to:

- Understand their competitive position in comparison to other players.
- Identify both the opportunities and threats that they might experience.
- Understand their and their competitors’ strengths and weaknesses.

- Acquire a solid idea of the industry/sectoral potential scenarios, including by identifying possible niches.

HOW

There are essentially three simple and yet very effective tools to carry out a market analysis. In all three approaches, IP considerations should play a crucial role.

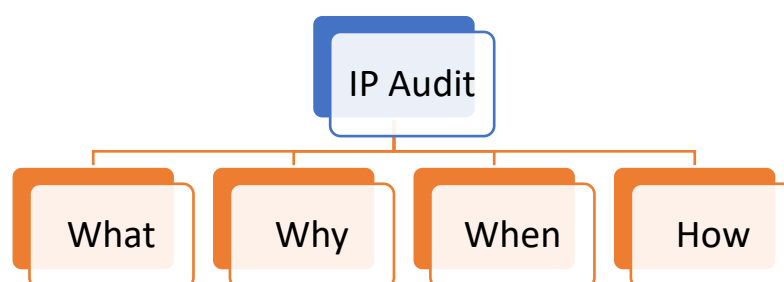


See Handbook on IP Commercialisation, Section A.1 for a description of how to conduct a SWOT Analysis and a PESTL analysis, how to implement the Competitive Forces Model (also known as the “Porter’s 5 Forces”), and how to use their results to draft your business plan.

2. IP Audit



A good solid comprehensive IP audit is most probably the first thing that it would be advisable to do, immediately after the market analysis. Let’s understand what that is and what it entails, why you should do it, and when and how you should do it. Please click on the icons below.



NB: Please put in LEVEL 3: WHAT, WHEN, HOW
If possible by clicking on the buttons above

WHAT

An IP Audit is a systematic review of all the intellectual property rights (whether registered or not) that you own, use or that you have acquired from a third party, or perhaps outsourced to a third party. It means taking a fresh look at all your company’s assets that are not tangible (i.e.: you have to exclude your premises, office equipment, machinery, vehicles, etc.) and focus on the outcome of

your creative and innovative efforts. This systematic review should cover:

- The name of your business that may or may not be already registered as a trademark (it may well be that it is simply exhibited outside your working premises, offices, or shop).
- The same applies for the name or designation or indication that you use to sell your products or services, and that, hopefully, you have already registered as a trademark - at least in your domestic market. Even if you have done so, you should include these items in your IP audit.
- Any new product or process that you might have invented. Such inventions and inventive practices may already be protected as patents or utility models, or simply applied in practice. In the latter case, they may, however, have a value as Trade Secrets, or Know-How.
- The ornamental shape of your products or of your packaging. Perhaps you have already protected those through Industrial Design, but if not, you may nonetheless enjoy protection under copyright.
- All your written documents, including contracts, memoranda, advertisement campaigns, software programmes, etc. should probably be automatically covered by copyright protection and therefore should be also included in your IP Audit.
- Lists of clients, their contact details and preferences, internal working, quality and compliance procedures, internal policies that proved to be successful - these should all be treated as Trade Secrets.

WHY

A good IP Audit will bring you many advantages and it will help you:

- Identify all intangible assets of your company.
- Determine the overall value of your company (beyond merely the tangible assets). This may also help you to use your IP assets as financing collateral to get loans from banks. NB: IP Audit is a fundamental step for IP Valuation (see Handbook on IP Commercialisation, Sections A.3 and A.4).
- Assess potential risks in your current way of doing business.
- Establish corrective measures and create new policies to prevent potential problems.
- Identify best practices and adopt strategies in IP asset management with a view to better managing your intangible assets and increasing your income.
- Monitor compliance of your contractual obligations (e.g.: deriving from licensing agreements).
- Ensure adequate protection of your IPRs by registering and renewing them, or by adopting best practices to protect your unregistered IP rights.
- Monitor possible violation of your IPRs and facilitate their enforcement.

... in short: DO IT!!!

WHEN

- A good and comprehensive IP Audit should be systematically carried out at least once a year.
- However, sometimes there are specific events that trigger the necessity to do an IP audit. By way of example, if you want to obtain a loan from a bank and you want to use your IPRs as collateral, or you are embarking on a merger or acquisition, or possibly you are disposing of part of your business, or you are about to commence commercialisation in other countries or through e-commerce, and so on.

HOW

- First of all, don't carry out the IP Audit alone (unless your company is really small, and you know

exactly how each part of the company works). You should instead involve your colleagues who are familiar with the details of the operations of every single aspect of your company's work. For example, if your business is based on a very technological product, you may need to involve a technical expert. A business and IP lawyer may also be helpful.

- Scrutinize every aspect of your business in order to determine the actual or potential role of IP: from its final outputs, to the processes to reach those outputs; from the contractual arrangements with employees, to any interaction with other stakeholders such as suppliers, service providers, clients, financiers, and even competitors.
- Start by identifying all trademarks, patents, utility models, domain names and industrial designs already registered in the name of your company and check:
 - If you are using them or not (if you don't use them, perhaps you should avoid renewing them);
 - If you are using them in exactly the same form as registered, or you have slightly changed it over time, for example because your logo has undergone some restyling, or because you have new corporate colour (in the latter cases, you might consider filing a new IP application);
 - When each IPR has to be renewed;
 - If you have in place all the required documentation to prove ownership (e.g.: proper registration certificates, evidence of renewals, etc.)
- Do the same with the IPRs that are not registered under your name, but that you are entitled to use by virtue of a contractual arrangement or written authorization, etc. with a third party. In this case, make sure you have copies of these contracts and of any other relevant documentation (e.g.: copies of the licensing or franchising agreements, copies of the certificates, etc.). You should take this opportunity to also assess whether you are complying with all your contractual obligations as stipulated in the above contracts, or not.
- Then, try to do the same with any unregistered IPRs. For example:
 - You might be selling your goods or provide your service under a given name or logo, without having ever protected this name or logo as a trademark. This would be unfortunate, but it happens, and it is never too late to "put your house in order". The same can be said for the name written on the signpost over your shop or business: check if it is registered as a trademark, and if not, get it protected before your entitlement to it might be compromised by a potential competitor.
 - Perhaps your company is innovative in the way in which part of the business is carried out (e.g.: you have a great business model, a creative business method, you found a way to reduce the time of production or to improve the outcome of your production). Ask yourself if these innovative practices may be protected as patents or utility models, or if they may be treated as Trade Secrets through the adoption of a number of well-thought-out confidentiality measures.
 - Take stock of all relevant written documents that may give you a competitive advantage and remember that these will more than likely enjoy automatic protection under copyright. This means therefore nobody can copy them. However, make sure you carefully and methodically classify all these written materials.
 - Identify any software developed on your behalf or by one of your employees, all types of databases (from the most complex, to simplest including lists of customers with their contact details), sales data and marketing information, prototypes, etc. Also, in this case, the automatic protection of copyright may enhance the value of your assets, and Trade Secrets might help you guarantee their secrecy and therefore your competitive advantage.
- For each identified IP right, whether registered or not, you must verify who is the real owner: at times, it is you; other times it might be a third party, and in that case, you need to have a written authorization to be able to use such IP right. Similarly, if the owner is one of your employees, a supplier, a licensor, or an inventor, etc., you have to make sure that you are entitled to use such right through the appropriate contractual arrangement. Copies of these documents must be scrupulously kept.

- Verify if any of the above IP rights has been or is being violated or infringed by third parties. Should this be the case, assess the best option to enforce your rights. Remember: you can make a lot of money by enforcing your IP rights!
- Do not forget to include in your IP Audit also your web site. Check what is yours and what is not, before you put your new website online. Protect what is your, and obtain permission for what is not. Do not violate others' IPRs with your website (see Handbook on IP Commercialisation, Section E).
- Finally, you should take a helicopter view of all your registered and unregistered IPRs, and assess whether, in practice, they are serving the strategic interests of your business. Should this not be the case, you could start considering corrective and mitigation measures, such as developing new products, or acquiring them through a license, entering into a partnership, or perhaps shifting your business focus. In this context, you should also assess potential risks linked to employees disclosing IP assets to your competitors, customers breaching licensing terms and conditions, and suchlike.

Numerous enterprises, particularly SMEs, may take the view that they have more to be doing than IP Audits and cataloguing and recording as indeed, the initial undertaking may be somewhat laborious. But, as mentioned, once it has been done for the first time, it will become a fairly straightforward exercise to carry out regular periodic reviews. Make sure that a workable and sensible system for recording and review is put in place, and you will possibly be surprised by the concealed additional and valuable wealth that is underlying your day to day processes and procedures, and have resulted over time from the efforts that you have been putting in. By their nature, entrepreneurs are inclined to look only at the bottom line ... that is to say, in-goings and out-goings, profit margins and suchlike. A good IP Audit can be the opportunity to stand back and acquire an appreciation of the intangible value that you have been building up and that is the underlying foundation of that good annual bottom line and, hopefully, many more to come!

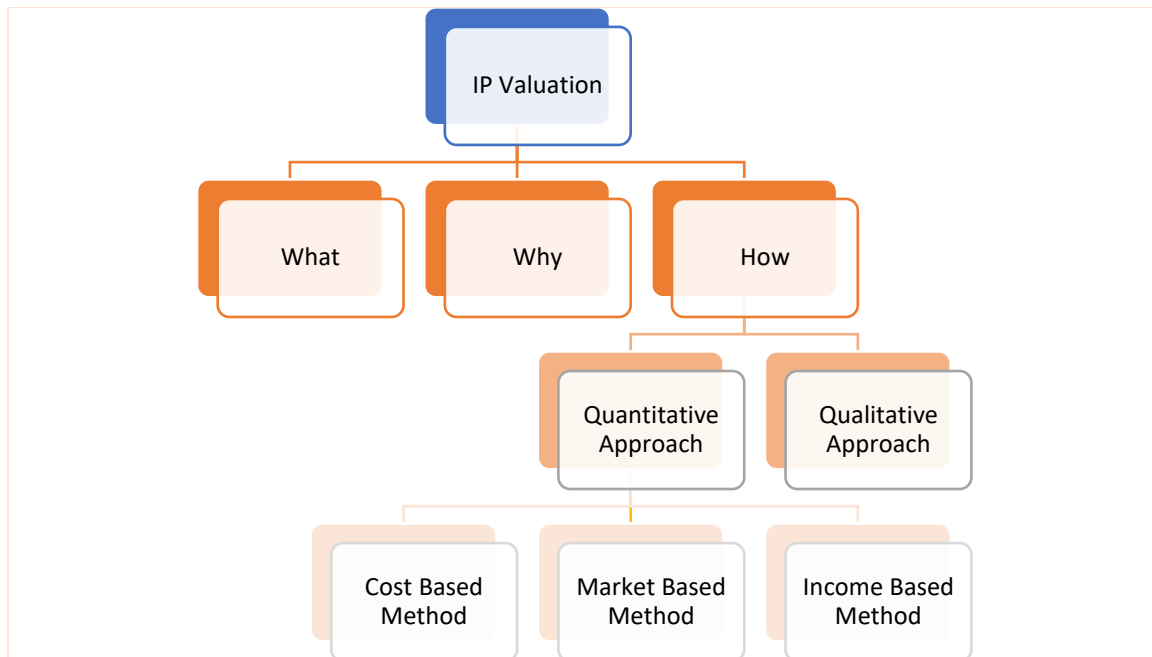
3. IP valuation

Once you have a clear picture of all the IP rights (registered and unregistered, developed by you or acquired by others), it will then be time to try to assess and quantify their economic value, in terms of the current and future/potential economic benefits that can or might be derived from such rights. Such economic benefits will be linked to the capacity of your IP rights to enable you:

- To exclude competitors from a particular market for a certain time, or more generally, to raise barriers to entry into the market by potential competitors, or
- To exploit them, either directly as the owner of the IP rights concerned, or through their assignment or licensing to or by third parties.



As already mentioned, intangible assets are often the most valuable component of a company.



WHAT

In simple terms, IP valuation is a process to determine the monetary value of your IP rights. Such IP rights can sometimes be the most valuable component of a business enterprise and should not be underestimated or overlooked. Just consider the difference between the value of a bottle of dark colored liquid for consumption, with no markings on the bottle, and another bottle of the same liquid when the bottle carries the mark for Coca Cola® or Pepsi®.

WHY

IP valuation is carried out for all the same reasons why you should conduct routine IP Audits, but also in the following specific circumstances:

- You are about to enter into a contract that includes the sale, licensing or franchising of one or more IP rights.
- You are involved in a dispute or litigation that involves IP rights and you have to assess the amount of damages.
- In case of bankruptcy of a company, when it may be necessary to calculate value of all assets under liquidation, including intangible assets.
- You want to use your IPRs as collateral to obtain a loan from a bank.
- You try to attract investors and you have to prove the value and the solidity of your business.
- You are involved in a merger or acquisition, divestures, spin-offs, joint venture or strategic alliance, or donation of IP assets.
- In the context of financial reporting and taxation.

HOW

There are different modalities for carrying out an IP Valuation. The selection of the most appropriate approach will depend on a number of factors, including:

- The purpose of the valuation: for example, is it in the context of a licensing agreement, or of a

- bankruptcy procedure? or
- The availability and reliability of data.

Generally, intellectual property valuation approaches are classified in two categories:

- **Quantitative approaches** to IP valuation: as the name suggest, they rely on numerical and measurable data;
- **Qualitative approaches** to IP valuation: they focus instead on the analysis and consideration of other perhaps more abstract characteristics of the IP rights in questions (such as the legal strength, vulnerability to attack, geographical coverage, and suchlike).

Please refer to Section A.3 of the Handbook on IP Commercialisation to learn more about the modalities to carry out an IP valuation and on the different criteria and methods.

4. Using IPRs to Raise Capitals

One of the major problems that SMEs around the world face is access to capitals to finance their business endeavours. This is particularly true, when they are just commencing their activities and they don't have yet a successful commercial track-record.

Banks and financial institutions around the globe are reluctant to lend money to individuals or small companies that don't possess assets that can be used as collaterals, to guarantee their loans. SMEs and start-ups normally don't have large bank accounts and often their physical assets (such as land, real estate, machineries, vehicles, inventories, etc.) are very limited. As a consequence, they might face significant challenges when trying to obtain a loan from a bank. Similar considerations are applicable when SMEs try to entice investors to finance part of its business.

However, innovative SMEs that own registered (or, at times also unregistered) IPRs may find themselves in a better position, as more and more banks and financial institutions now accept IPRs as a form of guarantee for their clients' loans, in case of default. Similarly, more and more investors pay attention to the IP portfolio of a company before investing their funds. In other words, if you own some IPRs, you may be able to use them as collateral to get a loan from your bank, and you can certainly be more appealing and persuasive to potential investors! Obviously, your bank and potential investor will have to quantify the value of your IPR, particularly in terms of future revenues that may be derived from your IP assets when commercialized (see previous Section A.3).

However, in many countries banks and financial institutions are still somewhat afraid to grant loans on the basis of intangible collaterals. This means that you might have to persuade them, by simplifying their job and making your IPRs more "attractive". By way of example, you could:

- Carry out a Valuation of your IPRs, clearly indicating the criteria on which you based your assessment (see Section A.3 on IP Valuation);
- Describe all future potentialities linked to the exploitation of your IPRs, such as the size and growth expectations of the markets for your IPRs;
- Provide indications as to the potential liquidation value.

In addition to the these "IP-Backed Loans" where IPRs are used as collaterals, companies may also obtain funds by selling to banks and financial institutions their expected future cash inflows deriving from the exploitation of an IPR, in exchange for an anticipated amount of money. In technical terms, this is known as "IP securitization". Banks and financial institutions are in general even more

sceptical to lend funds to companies on the basis of “securitization”, in view of the inherent difficulties in predicting the stable income that may be derived from the commercialisation of the IPRs in question.

As a final piece of advice: make sure that before you approach a bank or financial institution to obtain a business loan or before you contact a potential investor, you have appropriate and comprehensive documentation in place. By way of example, you should have:

- A comprehensive list of all your registered or applied for IPRs.
 - The results of novelty/availability searches to prove that your IPRs don't infringe prior rights.
 - Possible responses from IP offices to prove that your IPRs are valid.
 - All contractual arrangements that you already have to commercialize your IPRs (e.g.: licenses).
 - Possible valuation of your IPRs.
-

B. GETTING PROTECTED

1. Protecting IPRs at Home

Imagine a situation where you find someone using your trademark on his products without your permission. Not only is it disheartening, but it may also bring a bad reputation to your business. The good news is that if you have adequately protected your IPRs, then you can do something to confront and deal with this unpleasant and dangerous situation.

Protecting your intellectual property rights is not a difficult task; however, it needs some preparation, consideration, diligence and regular audit on your part. This section and the one below will help you understand how you can protect your IPRs, not only at home, but also in export markets. The last section highlights how to protect your unregistered IPRs.

The first step to protect your IP rights is by registering them with your National Intellectual Property Office. Such registration is by far the most effective protection for your IPRs, and it accords them a sort of “legal sanctity”. Registration basically means that your invention, trademark, work or design are yours and yours only (subject to certain exceptions and limitations). This implies that only you can decide by whom and how those rights will be used in the market. It also gives you powerful tools to fight against potential infringers. Registration gives everybody a very strong warning message: DO NOT TOUCH MY IP RIGHTS!

You should recall that while registration is compulsory for securing protection of patents, trademarks and industrial designs, in the case of copyright, registration is optional. Copyright works are automatically protected, and their registration (or more precisely: “deposit”) with your national Copyright Office is advisable particularly if, at some point, you have to prove that you are the owner of that copyrighted work. In other words, deposit is important to facilitate your burden of proof of your ownership.

Let’s now see how to register your IPRs. The first thing to do is to check the website of your national IP office. It systematically contains detailed information about what to do to file patents, trademarks and industrial designs. Most IP offices nowadays provide facilities for online registration. Inevitably, you will have to fill in a form (whether in paper or digital form), providing information about you, as IP owner, and about the IP right for which you seek protection. The procedure will vary depending on whether you are registering a mark, an invention or a design.

- In the case of **TRADEMARKS**, you will have to provide a sample of the mark and list the products and/or services for which the mark will be used (classified in accordance with the Nice Classification). In this context, there are some precious tools that we highly recommend using:
 - **ASEAN TMClass**, available at <http://www.asean-tmclass.org/ec2/>. This tool will help you easily identify the correct class/es of the Nice Classification for your products and/or services (or **TMClass**, available at: <http://tmclass.tmdn.org/ec2/> referring to the EUIPO, the offices of the EU Member States and of numerous other partners).
 - **WIPO equivalent**

- In order to discover if your proposed mark is available and does not infringe any prior registered marks, you should conduct an “availability” search by using one of the following research tools:
 - **ASEAN TMView** available at: <http://www.asean-tmview.org/tmview/welcome.html>. This database is very useful to verify if your proposed mark is available and free to register or not in any of the ASEAN countries (with the exception of Myanmar).
 - You can also use:
 - **TMView**, available at <https://www.tmdn.org/tmview/welcome> to check the availability of your proposed mark in all EU countries and in numerous other partner offices (please see full list of participating countries at the above internet address); or
 - **WIPO Global Brands database**, covering trademarks registered in a wide number of countries parties to WIPO, and available at: <https://www.wipo.int/branddb/en/index.jsp>

- In the case of **INDUSTRIAL DESIGNS**, in addition to information relating to yourself as applicant, you will have to provide also drawings, photographs or other adequate graphic representations of the industrial design, and an indication of the kinds of products for which the industrial design will be used, classified in accordance with the Locarno Classification. In this context, we suggest using the following tools:
 - **EUROLOCARNO**, available at: <https://oami.europa.eu/eurolocarno/> to easily identify the relevant class/es of the Locarno Classification in which your products are classified, and
 - **DesignView** available at: <https://www.tmdn.org/tmdsview-web/welcome> (and **ASEAN DesignView**, at <http://www.asean-designview.org/designview/welcome>) to assess if your proposed design is new or not (if it is not “new”, it would obviously not be eligible to be registered as a protected design).

- In the case of **PATENTS**, you will have to include in your application one or more so-called “claims” (that define the scope of protection that you are intending to seek for the invention), a description of the invention, drawings if appropriate, and an abstract. You will also have to indicate the relevant class of the Strasbourg Classification (available at: <https://www.wipo.int/classifications/ipc/en/>) in which your invention falls.

- The (non-compulsory) deposit for **COPYRIGHT** is normally a very simple and straightforward procedure and you should consult the site of your domestic Copyright office.

For more precise information about the filing processes in the various ASEAN countries, along with Australia and New Zealand, we would invite you to consult the ASEAN “Business Guide to IP Institutions, Laws and Filing Processes in AANZFTA Parties Guide”, available at <https://aanzfta.asean.org/> and the country profiles in Section B.3 below.

Registering an IP right is not terribly difficult, and often you may get free support from your national IP office. However, particularly in the case of filing patents and industrial designs, the process can be somewhat technical. In all cases, it would be highly advisable that you consult an IP lawyer or agent with solid experience and the expertise to assist you throughout the process

Remember a few important things:

- Your protection generally starts from the date of filing your application with your national IP office (or from an earlier priority date).
- Your registration lasts for a given period. Then, in some cases you can renew your registration:
 - Your trademark registration lasts 10 years and can be renewed for additional 10-year terms, indefinitely.
 - Your patent lasts 20 years and cannot be renewed.
 - Your industrial design registration lasts at least 10 years, but often more (please check duration of protection in your country). Fees are normally payable each five years, up to the maximum duration of protection provided in your domestic law.
 - Copyright is protected for the life of the author plus (normally) 50 years, and cannot be renewed after its expiry.
- If you file your IPRs with your national IP office, your IP registrations will only be protected domestically, and NOT in other countries. This is in line with the famous Principle of Territoriality (explained in Chapter I). Therefore, if you want to do business in other countries, you have to get your IPRs protected there before embarking on your export activities. See following Section.

2. Protecting IPRs in Export Markets

Market expansion is one of the most common strategies for growing and successful companies and SMEs. As mentioned, if you are looking to explore new markets, in other countries, you need to be cautious and take few steps to protect your IP rights abroad. In other words, ask yourself:

- Are you going to conduct business abroad?
- Are you going to export your products to foreign markets?
- Are you going to manufacture them in a foreign market?

If the answer to any of these questions is positive, then you need to protect your IPRs in ALL relevant countries, where you are intending to expand your business, before you actually enter those markets. Once again, please remember that IPRs are **territorial** by nature, and protect you only in the countries where you filed for protection (and not in others).

You also need to remember that TIME plays a crucial role in your efforts to obtain protection in other countries. While you can file applications for your trademarks in any country at any time (and in each country, your mark will be protected, if it passes the examination, as to the filing date in that particular territory), the situation is very different (and much more delicate) for patents and industrial designs. In the case of patents, you only have 12 months to file patent applications in other countries, from the moment you filed your first national application (in general in your home country). If you fail, the subsequent filings will be rejected, as devoid of novelty. Instead, if you comply with this 12-month deadline, your subsequent filings will be able to claim what is referred to as “priority” from your first filing, and their effects will be retroactive to the date of the earlier first filing. The situation

is very similar for industrial designs, except that the period for extending your national application lasts only six months.

There are essentially three possible routes to protect a patent, an industrial design or a trademark³ in other countries, depending on where you are going to do business and how you wish to obtain protection:



The National Route

The **national route** (described in the previous Section) is available to anybody. However, it is only advisable in two cases:

- Either your business is limited to your home country and you don't operate in other countries.
- Or the countries where you plan to do business and would like to obtain protection don't belong to any of the regional or international systems described below.

If this is the case, you will have to appoint a local expert in each country to file a national application, complying with the requirements of the various domestic laws, and paying fees in the local currency. It is doable, but very time consuming, cumbersome and certainly more expensive. The national route is definitely not your best option if you intend to protect your IPRs in countries members to these regional or international registration systems.

The International Route

Let's now look at the so-called **international route** for IPRs registration. There are three international registration systems administered by WIPO, namely:

- The Madrid system for the international registration of marks.
- The Hague system for the international registration of industrial designs.
- The Patent Cooperation Treaty (PCT) for international registration of patents.

These systems enable IPR owners to obtain protection in any country party to the relevant international treaty, by **simply filing one application, in one language (including English), with one set of fees and in one currency** (Swiss francs). Similar advantages exist when the registration has to be renewed or is assigned to a third party or when other changes, such as in name and/or address, have to be recorded.

In other words, these systems are a simple, economical and effective procedure that provides for:

- A centralized system for trademark, designs and patents filing and management in export market;
- A single set of simple formalities;

³ The situation is different for Copyright which is automatically protected as soon as you finish your creation.

- Lower registration fees (including a reduction of fees for SMEs from LDCs);
- No need to translate the application into several languages;
- The effects of an international registration are equivalent to those of a national registration.

However, it is important to remember that the Madrid, The Hague and PTC systems are merely **PROCEDURAL mechanisms** to facilitate the filing process (i.e.: they only cover the FORMAL requirements that have to be complied with when filing an IPR). The domestic legislations of the designated Contracting Parties set the SUBSTANTIVE conditions for the actual granting of the protection of the various rights.

In general, it is recommended to seek professional advice before filing an application through one of the WIPO-administered international registration systems. For more information about the international route and the three registration systems administered by WIPO, please see: <https://www.wipo.int/services/en/>.

The Regional Route

While there are other regional systems to obtain registration of your IPRs in a group of countries (such as the OAPI system covering the 17 francophone African countries; the ARIPO system for all anglophone African countries, the ANDEAN Community system with one unique IP legislation for the following Latin American countries: Bolivia, Chile, Colombia, Ecuador and Perú, etc.), we will focus on the most integrated, complete and fully-fledged regional system which would enable you to protect your marks and designs in the 27 EU countries: the **EU system**, administered by the EUIPO.

The EU system can be used by anybody (natural or legal person), without restrictions as to nationality or state of incorporation. However, as non-European, you will have to appoint a representative in the EU to file your mark or design with EUIPO.

The cheapest and fastest way for filing your mark or design is to do it electronically. The form is extremely simple: you have to provide all relevant information relating to the IP owner, a sample of the mark and the goods and/or services covered by your mark classified in accordance with the Nice Classification; or images or representations of your designs indicating the relevant class/es of the Locarno Classification. In this context, please remember to use the tools we mentioned above (under “national route”): TMClass, and TM View; and ASEAN TMView, etc.

The EU system is completely integrated and in order to obtain your EU certificate, your mark or design need to be valid in all 27 countries. In other words, it is enough to have problems in one EU country (in terms of the availability of the mark or design), to obtain a full refusal by EUIPO, which will be applicable to all countries. For more information on the EU systems, please refer to: <https://euipo.europa.eu/ohimportal/en>.

3. Protection for Unregistered IPRs

While the best option to protect your IP rights is by registering them at a national, regional and international level, there are some IPRs that cannot be registered, and yet can be protected. Trade Secrets and technical know-how⁴ are probably the most important for your business.

Trade-Secrets, as the name suggests, are the secrets that you use in your business. Unlike patents, trade secrets are not registrable with an IP office, yet they are protected. Generally, protection of Trade Secrets is provided by specific laws, or within the domestic IP laws. Other times, courts protect them under Unfair Competition law, Torts or on the basis of Principle of Equity, etc.

Examples of trade secrets include:

- Business information (e.g.: information relating to customers and suppliers, their names, addresses, contact details, preferences, buying records, contractual agreements, databases and compilations);
- Strategic information (e.g.: special techniques for marketing and for providing after-sale services, results of market surveys, market intelligence reports, training materials);
- Technical information (e.g.: tests results, quality control methods, products specifications, manufacturing information, research results, etc.);
- Financial information (e.g.: sales data, pricing lists, pricing information, financial forecasts).

From the above list, it is evident that trade secrets are extremely important and valuable for the operations of any company and play a fundamental role in their success. After all, patented inventions often require knowledge of Trade Secrets in order to be effectively operationalized. Similarly, the sale of products or services carrying a trademark and/or embodying an industrial design will be more successful if the relevant Trade Secrets are applied.



You need to keep in mind two things to protect your Trade Secrets:

- First and foremost, by definition, keep them secret, taking whatever reasonable precautions that may be necessary, and
- Secondly, Trade Secrets should essentially be of commercial significance to your business, precisely because they are not known to your competitors.

While protection of Trade Secrets does not cost any money, the main problem lies in the fact that their **protection will only endure as long as they remain secret**. If somebody, without violating the law, notices your products on the market and succeeds in understanding your precious secret and confidential information (which are not protected as patents or designs), you cannot then claim that your rights have been breached. In other words, you can only use your Trade Secrets against somebody acquiring them through an abusive or illegal act. In such event, you can approach the court to obtain an injunction against the infringer, and claim damages.

This means that you will need to be judicious in deciding the extent to which you need to expose sensitive information in the context of the commercialisation of your products — how and where is

⁴ The term “know-how” can be understood as a type of trade secrets, to cover issues of less strategic value, such as training materials, simple ways of operating machines or contacting customers, etc.

the information recorded and stored, who has access to it, what information is made available on your website, who has access to protected passwords, what protocols are in place for the reproduction or copying of such material, and such like. In short, do not use Trade Secrets to protect your main inventions!

See Handbook on IP Commercialisation, Section C.1 on Non-Disclosure Agreements, which are undoubtedly excellent tools to protect trade secrets.

4. Country Profiles

List of 12 countries

Level 2:

You click on each one of them and it connects to the page of the Guide.

D. MANAGING IPRS FOR BUSINESS EXPANSION

1. Practical suggestions not to weaken your IPRs and prevent problems

i. Use it or lose it!

This famous principle of “use it or lose it” applies also to IP and in particular to trademarks. Virtually, all trademark laws provide that owners have five years from the registration date to start using their mark, failing which anyone can initiate a cancellation action against these marks and possibly register them in their own name.

This principle applies to a certain extent also to patents: if you do not use your patented invention in a given country, the Government may commence proceedings to issue a “compulsory license” through which you will in fact lose the right to enforce your patent for a certain period of time. The Government in question will appoint a local company to produce your invention. This is however quite rare.

ii. Secondary Meaning & Genericization

The level of distinctiveness of your mark, and therefore its market power and capacity to be enforced, may change with the time. Extensive and consistent use over the years may increase the distinctiveness of your mark, through a process called “secondary meaning”, also known as “acquired distinctiveness”. By way of example, your rather descriptive/weak mark may become stronger and stronger and acquire higher levels of distinctiveness through use and time.



On the other hand, a mark’s distinctiveness may fade and even disappear through a legal phenomenon called “genericization⁵”. If the average consumer of a country starts using your mark not only to refer to your own products or services, but as a general term to indicate any product/service of the same category, then you may be in trouble. Should this be the case, any court could in principle declare the “genericization” of the mark in question, as it would have lost its capacity to distinguish the goods/services of one specific undertaking.

Here are some tips to make sure that you a) may benefit from “secondary meaning” and b) avoid at all cost the “genericization” of your mark:

- The more you use your mark, the more likely you are to increase its distinctiveness
- Use your mark as ... a mark, and not as a verb, noun, or as an adjective (by way of example, Google® is fighting to prevent the genericization of its mark, by systematically opposing to the utilization of “to Google” as a verb indicating “to research on the internet”).
- Use your mark consistently, without major variations as compared to the version that you originally filed.
- If you foresee the risk of genericization (for example because you have invented a new product), it might be wise to invent a generic term to indicate such a product. You will then use it together with your trademark. This will clearly indicate that the mark is not the generic name, and as such, it maintains its distinctive character.
- If you notice your marks being used in any context (tv, newspapers, etc.) as a generic term, you should take steps to inform the party in question that the term is a registered and protected mark and should only be used as such by its legitimate owner or with his/her consent.

iii. Be Your Own Watchdog

Keeping an eye on the market (both at home and abroad) is a fundamental step to ensure effective commercialisation of your IPRs. Far too often, business competitors attempt to infringe each other's IP rights by copying them, imitating them, in short, by cheating.



You should therefore monitor the market to see if anyone is selling products bearing your mark, or if the shape of their products is too similar to your registered industrial design. Check also the new products appearing on the market as they might contain your precious technology. This may imply checking shops and malls where products carrying your mark, design or patent may be illegally sold, monitoring the press, social media and the websites of companies using your IPRs without authorization, etc. Do this exercise periodically.

You can also use some online tools to help you monitor the market. Google alerts is one of them. It can notify you when words or phrases similar to your mark are mentioned online. In addition, there are private sector companies that offer nation-wide or world-wide watch-dog services.

Finally, you should make sure that nobody attempts to protect an IPR which infringes upon your own registered IPR. In this context, you can monitor the official gazettes or journals where the various IPRs are published after filing or after registration.

Once you detect a possible violation of one of your IPRs, then you have to defend your rights. Enforcing your IPRs is fundamental as not only it can represent a valuable source of revenues, but it gives a very strong message about your seriousness towards protecting your rights and dissuade further infringements. See Chapter IV of the Handbook on IP Enforcement.

iv. Use of ®, “TM”, “©” signs

Using the following symbols is highly advisable:

- ® or TM (or even “Registered Trademark”) for trademarks;
- ID or “Registered Design” for industrial designs;
- “Registered Patent” for registered inventions; and
- © for copyrighted works

It may work as a powerful warning message to potential good or bath faith infringers of your IPRs, and it educates your consumers to the fact that your IPRs are duly protected (registered or applied for).

Just one word of caution: do not use the word “Registered” or the symbol ® if your IPRs are simply applied for, but the registration process has not ended yet.

2. CONTRACTUAL ARRANGEMENTS TO MAXIMIZE GAINS

i. Introduction

Now that you have learned about the preliminary steps to commercialisation and understood how to protect your IPRs, it is time to think about how you can make money out of them. **YES, YOU CAN!** These Sections present various contractual arrangements that you can use to maximize profits for your business by strategically commercializing your IPRs.

As already mentioned, IP assets are similar to your other tangible assets. Thus, just as you can sell your apartment or rent it, you can also license, lease, transfer, or in short, commercialize your IP assets. The big advantage, in this regard, is that while you can rent your apartment only to one person, you have the possibility of licensing (which is the jargon term equivalent to “renting”) your IPRs to several different persons and companies at the same time, precisely because they are intangible and ...virtually non-exhaustible. For example, you may authorize three different persons to use your IPRs in your country. You could replicate this model for all the countries in which you are going to do business and you will receive royalties for having granted to third parties the privilege of using your IPRs.

However, a prerequisite for your successful exploitation and commercialisation of your IPRs is **A WELL DRAFTED CONTRACT**. So, your journey of monetizing your IP assets starts with a contract. These contracts are a crucial tool for various aspects of your business, in your relationships with your employees and your potential counterparts to whom you may want to license your IPRs, transfer your technology, or with whom you wish to enter into a joint venture or a franchising agreement, and so on. This part of the website should provide you with tips and suggestions to help you design your strategy for commercializing your IP assets through the most appropriate contractual instrument.



A small disclaimer: While this guide will help you understand various forms of contractual arrangements and their pros and cons, it is highly advisable to seek professional/legal advice when entering into any form of contract. Remember, once you sign a contract, you are obliged to follow it. There is no looking back.

ii. Non-disclosure Agreements

In order to do business with potential partners, you will have to disclose to them sensitive information on your protected or to-be-protected IPRs, on the preliminary results of your R&D, on your production processes, Trade Secrets and know-how, etc. While all your contracts will imperatively have to contain well-crafted confidentiality clauses that will protect this type of information, there is one crucial step you should take even before commencing your discussions with

a potential business partner, and certainly before you share with him/her your precious secrets and sensitive information: ensure that they sign a Non-Disclosure Agreement (NDA).

This is the only way you can ensure that your potential counterpart, who may or may not eventually sign the cooperation agreement with you, does not disclose to anyone your confidential information, or does it only and exclusively under the conditions agreed with you.

Please note that certain information, if disclosed without your authorization, may be fatal for your business. For example:

- You may not be able to protect your precious invention as a patent, because your IP law requires that inventions can only be patentable if absolutely “new”, i.e.: not already disclosed to the public. If you expose your invention before filing a patent application, and without previously signing an NDA, you may “kill” the novelty of your own invention.
- The same applies to your industrial designs.
- You may also lose your Trade Secrets that are protected only as long as they remain concealed and confidential. The same is applicable to your know-how.

Non-Disclosure Agreements, as the name suggest, are designed to prevent your potential business partners from disclosing any confidential information received by you in confidence and relating to your business. NDA may be bilateral or unilateral, depending on whether the obligations to maintain complete secrecy about certain information are undertaken by both parties, or by one party only.

A typical NDA contains the followings clauses:

- Definition of Confidential Information.
- Specification of the type of information not covered by NDA.
- Indication of the choice of law and jurisdiction.
- Listing of specific purposes for which the information can be used by the other party.
- Possible indication of the entities with which the confidential information can be shared under certain specified conditions.
- Provision of damages in case of unlawful disclosure of confidential information.
- Specification of the duration of the NDA.

Should the NDA be breached, then you can go to court to seek remedy and compensation. However, we all know that this may be an expensive and time-consuming affair.

iii. Licensing Agreements

In the introduction to this part of the site, we mentioned that the big advantage of IP rights is that, in view of their intangible nature, they can be “rented-out” as many times as you wish. This process is called “Licensing”.

While your apartment (as well as any other tangible property) can be rented out only to one person at the time, your trademark, patent, and other IPRs can be licensed to ... 5, 10, or 40 licensees in different geographical areas at the same time. Can you imagine the potential income for you?

IP Licensing is a process whereby the holder of an IP grants **permission to third parties to utilize his/her IP asset/s for a specified duration, for a specific purpose, on a particular territory, and under**

agreed upon conditions. These terms are agreed upon between both the parties and are stated in a contract: your licensing agreement.

Licensing is one of the most frequently used ways of commercializing an IP asset and earning money out of it. You might as well learn how it works!

Let's first see what are the most significant **advantages of licensing** if you are the Licensor, i.e.: the owner of the IPRs:

- You will be able to earn money in terms of licensing fees and royalties.
- You will be able to expand your business to new markets in other countries, that you would never be able to reach by yourself.
- If you choose the right licensees, you will be able to capitalize on:
 - Their local knowledge, network and expertise in their respective geographical areas;
 - Their distribution and/or manufacturing capacity;
 - Their capacity to introduce the necessary adaptations that may facilitate penetration of their local markets;
 - The valuable knowledge that they may generate from exploiting your IPRs.
- If you are lucky, your Licensees might even be able to improve the products or services encompassing your IPRs.
- You will be able to maintain oversight and control over the way in which your IPRs are used.

Let's now list the potential benefits and **advantages of acquiring an IP license** for the Licensees:

- You could start using advanced technological know-how and valuable brands without having to create them yourself, as this systematically entails significant investment in terms of money and time. In this context, remember that even bigger corporations do not carry out all the R&D by themselves, and prefer sometimes to acquire some IPRs from counterparts.
- You can therefore save time and money when you try to enter a new market with a better product.
- You may learn new skills that can help you in your business strategy.

For more information about licensing agreements, including the different types (exclusive / non-exclusive), remuneration issues, and many tips on how to negotiate an agreement that will allow your business to prosper, please refer to the Handbook on IP Commercialisation (Section C.2).

Last but not least, you need to remember that licensing agreements are among the most complex types of contracts. It is therefore highly advisable to consult an IP lawyer for their drafting.

iv. Technology Transfer Agreements

As the title suggests, technology transfer is a process whereby one party transfers its technology to other party for commercial purposes or for developing some new products. In other words, a technology transfer agreement is nothing but a type of IP license where the object of the contract is ... an item of technology (whether embodied in a product, or covered by a patent [registered or applied for], or in the process of being developed).

As compared to normal IP licenses, technology transfer agreements are often more complex and technical. This is because the contracts will not only have to cover all the legal issues that are described in section C2 of the Handbook, but they will also have to effectively deal with all relevant technical and scientific issues relating to the invention that embodies the technology. Often, the negotiation of this kind of agreement requires the presence not only of a good IP lawyer, but also of an experienced scientist or a person who has profound technological expertise.

Major issues to be considered here relates to the use and exploitation of the particular technology that is intended to be transferred. In addition, the issue of eventual improvements made by the person or enterprise acquiring the technology has to be carefully dealt with. The duration of technology transfer agreements is normally shorter than other types of licenses. This is clearly linked to the often-short life-cycle of technologies that sometimes become obsolete within few years.

Tips:

Technologies are often embodied in products that perhaps have an attractive shape, and that almost systematically carry a name and a logo. In other words, remember to negotiate in the same agreement the possibility of using also the registered trademark and industrial design that are going to be instrumental for the successful exploitation of the newly acquired technology.

Similarly, very frequently technologies are hard to operationalize, only based on the information contained in the patent. The effective use may need the disclosure of Trade Secrets and know-how, which you should remember to include in the same technology transfer agreement.

v. Joint Ventures Agreements

Nowadays, even the largest companies don't do everything by themselves. Partnering with other companies is not only a necessity in many cases, but it is also an excellent way to save time and money. When two or more partners come together to take up a new project with specific shared goals, in legal terms this is called "Joint Venture" (JV). Joint Ventures are often formed by creating a new and separate entity. Other times, they are simply established by way of a contract, whereby parties agree to work together and allocate roles and responsibilities.

In some countries that limit the possibility for foreigners to independently carry out business, entering into a JV with a local business actor is the only possibility. In other cases, this is not a legal requirement. However, Joint Ventures present significant advantages, including:

- Acquiring capitals or access to specific technologies;
- Enhancing the capacity to source raw materials or to use the best distribution systems in the new market;

- Capitalizing on local knowledge and network to foster acceptability.

In any event, a sound contractual agreement has to be established, providing for clear rules relating to management and decision-making responsibilities. When entering into a Joint Venture, partners start sharing risks, profits, assets, results etc. Their initial contributions may take the form of tangible and intangible assets, and many times, they also create new (tangible and intangible) assets in the process.

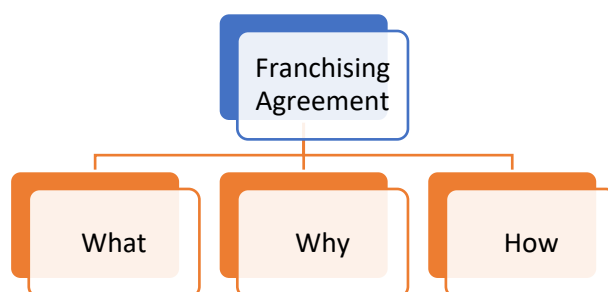
In this context, it is imperative to have a well-crafted contract with your partners, particularly with regard to:

- The contributions that each party is expected to make in terms of tangible properties, as well as in terms of IPRs (often referred to as **IP BACKGROUND**);
- The ownership, management and commercialisation, etc. of new intangible assets created by the Joint Venture (this is called **IP FOREGROUND**).

For more information about Joint Ventures, including the IP issues that have to be taken into consideration before entering in a JV agreement and during its implementation, please refer to the Handbook on IP Commercialisation (Section C.4).

vi. Franchising Agreements

One of the most interesting ways of commercializing your IP Assets is by entering into a Franchising Agreement. This Section briefly presents the “what, why and how” of Franchising, as well as a few things to remember in order to better understand the functioning of a franchising agreement and hopefully to help you decide on whether you want to become a Franchisor or a Franchisee ... or not.



WHAT

Franchising is a special type of licensing agreement, that allows for business expansion and product distribution without “reinventing the wheel”. This is because it enables the replication of a particular business format that has already been shown to be particularly successful. The precise definition of “Franchising” may vary from country to country. However, these are key elements that characterize a franchise:

- The Franchisor licenses to one or more Franchisees the right to use its intellectual property rights (and more in particular: its trademark and know-how);
- The Franchisee in return will pay royalties (and often also a lump sum at the beginning of the agreement) to the Franchisor;
- The Franchisor provides assistance to Franchisees (for example, by sharing the necessary know-how, training them on selling techniques, windows dressing, account keeping, etc.);

- The Franchisor enjoys significant control over the Franchisee's operations (and in particular over the way in which the Franchisees use its trademark).

In other words, the Franchisor who has developed a particularly successful business model, agrees to expand its business by granting to various Franchisees, in different locations, the right to replicate its method of doing business for a defined period and in exchange for payment of a financial consideration (often consisting of a lump sum and recurrent royalties). As part of the contractual package, the Franchisor licenses to the Franchisees the right to use its IPRs that systematically include trademarks, copyright, trade secrets and know-how, and in many cases also industrial designs and patents. The Franchisees will operate under the control of the Franchisor and in line with its directives. The Franchisor will also provide training and assistance to the Franchisees.

WHY

Franchising is generally a very interesting option both for the Franchisor and for the Franchisees. A Franchisee saves time in the development of a business from scratch, and will benefit from the Franchisor's goodwill and reputation as well as the use of the intangible assets of the Franchisor, including its trademark and logo. On the other hand, the Franchisor benefits from an expansion of its business to other geographical areas with limited investment, while continuing to maintain a significant degree of control over the way in which the Franchisees carry out the business. The other significant advantage for the Franchisor is represented by the often very substantial revenues generated by the franchising agreement.

Does it always work?

While Franchising might sound like a tempting option, it is not always a guaranteed model for success. Firstly, it might not be suitable for all types of businesses. Secondly, the trademark of the Franchisor should be sufficiently well-known to immediately attract customers for the Franchisees. Before entering into a Franchising agreement, the Franchisee should make sure to carry out a thorough feasibility study. The Franchisee should keep both short-term and long-term goals of its organisation in mind and analyse if the franchise model will be of benefit. Many countries have specific legislation on Franchising, and this might be quite stringent. Franchising requires also strict monitoring, from the Franchisor's viewpoint: even a small incidence of negligence or poor business conduct may have a severe impact on the Franchisor's name and goodwill, and of course, the value of the Franchisor's IPRs. Thus, both parties need to BE CAUTIOUS!

HOW

The Franchisor enters into a written agreement with its Franchisee/s for a fixed duration, whereby in exchange for monetary compensation, it provides them with the right to use:

- Its trademark and logo,
- Its technical know-how,
- Its Trade Secrets,
- Other possible intellectual property rights.

The Franchisor will also:

- Provide the necessary training to ensure that each Franchisee is capable of running the business in close compliance with the guidelines and instructions of the Franchisor; and
- Exercise strong monitoring and control over the Franchisees' operations.

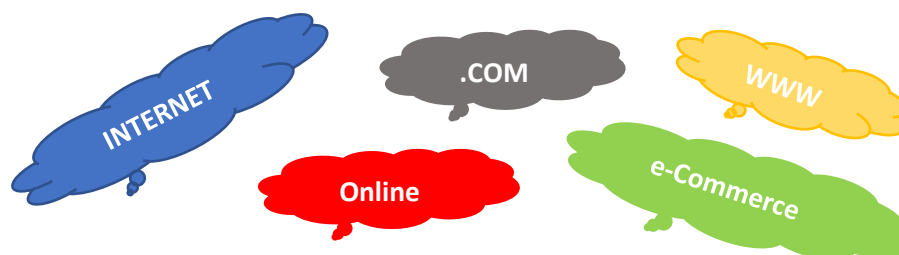
In virtually all Franchising agreements, the Franchisor establishes a very comprehensive “Manual of Operations” describing in detail every single aspect of the Franchisees’ way of implementing their business. Training on the Manual will be periodically organized, and “surprise visits” may be carried out by representatives of the Franchisor to ensure full compliance with all the instructions contained in the Manual.

Tips

- Do a due-diligence on a prospective Franchisee or on your potential Franchisor.
- Draft a detailed Franchising Agreement covering all clauses described in Section C.2 on Licensing Agreements, adding all relevant specific provisions relating to Franchising (e.g.: selling techniques, window dressing, specific duties of personnel, forms and types of control exercises by the Franchisor, etc.). Make sure you comply with the legislation of the countries in which you operate.
- Ideally, you may use one uniform agreement for all your franchisees. However, in particular cases, you may also decide to customize your contract to the specificities of the geographical area and/or of the Franchisee.
- Keep a regular check on Franchisees’ operations. Random audits or surprise visits may be considered to ensure compliance with quality standards.
- Provide regular training and support to franchisee.

E. IPRS IN E-COMMERCE

In today's world having a virtual presence online is equally important as having a physical presence in the marketplace. Having a dedicated website has now become an essential part of business strategy. In fact, in many cases, your website becomes the first point of contact for others (potential clients, partners, investors, licensees, etc.). Besides providing information, many businesses are also using their website for conducting online trade.



1. Domain Names

Did you know that, as in the physical world, your business can also have an 'address' in the online world? In IP jargon, the key component of this online address is called "domain name" (i.e. the word/s after the famous "www." and before the extension .com, .org, .countrycode, etc.). The Internet Corporation for Assigned Names and Numbers ("ICANN"), a global body, is basically responsible for the technical management of the domain name system.

Having a domain name is not mandatory, but ... definitely, very advisable. Domain names become the identity of your business online. Generally, as a first step, anyone trying to locate you online will enter the name of your company or the name of your product/s or service/s in a search engine in the hope that such name/s correspond to your domain name.

But how can you register a domain name? What name should you use to represent your business identity in an original and valid way? What if someone else starts using your domain name or a similar one by tweaking yours? Here are the answers to these very legitimate queries:

Selecting a domain name for your business

- While it might seem an easy task to select a domain name, one needs to be slightly cautious while zeroing in on a particular name. After all, this name will represent you to the world. You can start the process of selecting a domain name even before the registration of your company, and of your trademarks.
- A domain name can be any combination of letters and/or numbers. One has an option of combining these names/numbers with various extensions, such as one of the two-letter country codes, or .com, .org, .net, etc. Thus, you are free to choose any name, number or any combination as your identity on the internet.
- Depending on your choice, you may pick a common name or a distinctive and perhaps invented name. Remember, however, that if you wish to have your domain name correspond to your

trademark, then you better go for a distinctive domain name, as generic terms in most cases cannot be registered as a trademark.

- While finalizing the selection of your new domain name, you must check that it is not a trademark already in use by someone else.

How to register a Domain Name?

- Registration of a domain name is a fairly fast and easy task. There are many domain name registrars who provide services for registration of domain names. You can easily locate these domain name registrars online. Perhaps choose one in your country or your region.
- Generally, a domain name is registered for a specific time period, after which you will have to renew it by paying renewal fees.

For information about how to protect your trademark from someone using it as domain name, please refer to the Handbook on IP Commercialisation, Section E.1. , and visit WIPO website at: <https://www.wipo.int/amc/en/domains/>.

2. Web sites

The world of the internet offers numerous opportunities to expand your business, as the limitations of physical boundaries do not apply there. If you decide to take your business online, you need to keep a few things related to Intellectual Property in mind, to be able to enjoy the opportunities provided by the world wide web to the fullest extent.

- While you are developing your website, make sure that you own the content used on your website and the IP rights contained in or linked with it. To come up with the perfect website to suit your business, you may use pictures, text, documents, a database, links, music, videos, technical tools, etc. These may be protected by IP rights of third parties. This means that you cannot use them, unless you have explicit and written permission from the rightsholders.
- Things which are freely available and downloadable on the internet may nonetheless be protected by IP rights. Just acknowledging the source might not be adequate, particularly if you use them for commercial purposes and in a for-profit setting. You need permission from the right holder to use them.
- Even though the original content appearing on your website enjoys automatic protection under copyright, it is highly advisable to insert a copyright notice on your website indicating that the content available on your website is IP protected and no one may use it without your express permission. Such copyright notice may even be placed at the end of every page of the site, so as to clearly remind users that you are the exclusive owner of the content, format, appearance of your web site. The notice could indicate the name of a contact person in case authorization for use is sought.
- You can also control access to specific parts of your website by encryption, online agreements, or conditional access systems.
- To detect infringements of your website, you can take random parts of texts from your site and search for these parts using any search engine on the internet.
- Providing links and deep-links (i.e. links to specific pages of third parties' web sites as opposed to their front page) to other websites or works may be an infringement of IP. Obtaining permission for linking is therefore highly advisable.

- If a website collects consumers' personal information such as names, email addresses, gender, professions, preferences, etc. make sure you comply with the personal data protection legislation of the relevant countries, and adequately ensure the privacy of such information.
- In several countries, the name, face, voice and image of a person is protected by privacy rights. Therefore, before using such elements on your website, it is necessary to check the applicable laws and request permission, where needed.
- Finally, you have to decide what is best to show to the world, and what is not. This decision is important, particularly because in some cases it may have legal repercussions precisely related to your intellectual property rights. Thus, having your IPRs duly protected before disclosing your products on the internet is vital.

For more information about the IP considerations relating to websites, please refer to the Handbook on IP Commercialisation, Section E.2 and 3.

5. PROMOTING YOUR IPRs

1. Branding

While there is not a universally accepted definition of “branding”, in general this term is taken to refer to all the techniques that producers and business people adopt to differentiate their products or services from those of their competitors, and to attract consumers, gain their trust and establish their loyalty towards their products/services. Marketing techniques and tools play undoubtedly a crucial role in this regard. Branding can also be seen as a set of (positive) associations that a particular product (or service) is capable of generating in the mind of target consumers. Finally, branding certainly talks about the “personality” of your company, its essence and values. In short, it is a strategy to capitalize on your strengths and captivate current and potential consumers.

In the current global economy, consumers can choose their products or services from a wide variety of sources. The criteria that will guide their choice include price, technical features, aesthetical considerations, better quality, and so on. Once consumers have had a positive experience with a given product or service, they develop a level of trust and some sort of loyalty towards its producer or provider. This reciprocal trust between producers and consumers is at the core of branding, which may represent the key to your commercial success.

Advantages of Branding							
Can make your business standout	Loyalty, Credibility and Trust by Customers	Better Income & Increased Sales	People Expect to pay more for branded products	Increased Public Recognition	Continue "Rapport" with customers	Makes sales less sensitive to price increase	Makes business less sensitive to new competitors

Therefore, if you want to enhance the chances for success of your company, not only at home but also abroad, make sure you embrace a carefully conceived branding strategy. This will include the adoption of a trademark (that will enthuse potential consumers and make them proud of being associated with your product), and a clear focus on the ornamental and aesthetic shape of your product (protected as industrial design), making it so beautiful that consumers around the world will prefer yours as compared to those of your competitors. In some specific sectors, you may also take advantages of the image and reputation associated with a given geographical indication. Undoubtedly, you will have to adopt a domain name, which is somewhat linked to your trademark to enable consumers to locate your business online.

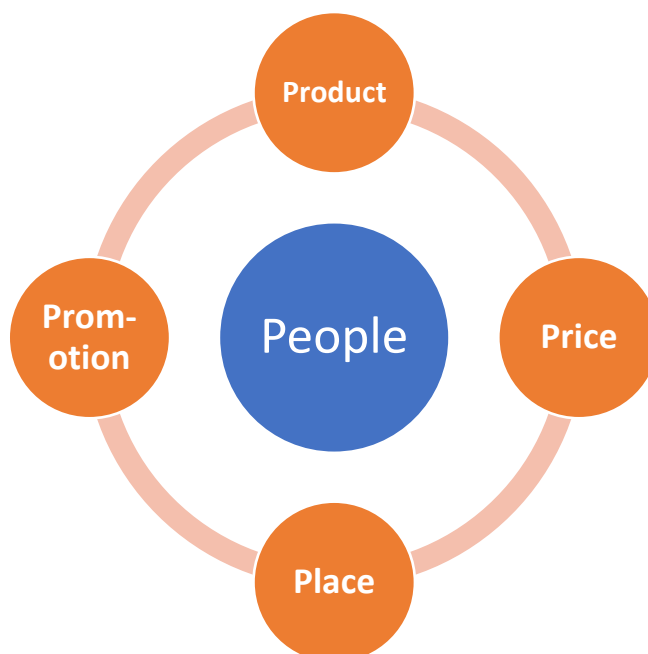
However, branding is not only about IP and IP rights. It requires also capacity to effectively market your products or services through the most appropriate means (including advertisement in traditional media such as TV, radio and newspapers, as well as digital marketing), adopting the right type of packaging, etc., and sending out the right kind of message that you want to have associated with your mark or design - value, sophistication, durability, style and suchlike.

Branding requires ongoing human and financial efforts to advertise and market your products and services, to develop new and improved products. However, successful companies realize that branding is not a liability, but a potentially very rewarding investment. See following sections on Marketing, Packaging, and Advertising.

2. Marketing

Many people, often erroneously, believe that marketing only consists of advertising and selling products and services. However, these two elements are only part of what marketing really entails. Marketing may be in fact defined as **the entire management process of getting the right goods or services to the right people (consumers) at the right place, time and price, by using the right promotion techniques and the right people to provide the appropriate customer services.**

Unfortunately, far too many SMEs, often due to lack of awareness or limited resources, still operate without a well-crafted marketing strategy. Here are some key principles for an effective marketing strategy. These are described in the short explanation of Jerome McCarthy's famous "**5Ps of Marketing**" below. These straightforward principles will undoubtedly help you start reflecting upon and conceiving your new marketing strategy:



In short, SME owners in ASEAN countries have to recognise the importance of marketing, and of having a well-crafted marketing strategy in place. There are ways to make the 5Ps of Marketing work for you, even with limited resources.

- You should consider starting with sound and reliable market research, which will determine the identification of the right product, which in turn will satisfy the needs of the targeted consumers.
- The right product should be offered at the right price (i.e. one which the consumers are willing and able to pay), and available at the right place for the consumers (both in terms of countries and distribution channels).
- You should promote your (right) product, at the right price and place, using the most adequate marketing and promotion techniques.
- Any marketing strategy or plan ought to be flexible and should be readily adjusted depending on the ever-changing needs and wishes of the consumers.
- Please refer also to Section below on Packaging, as it plays a fundamental role in the success of your marketing strategy.

For a more detailed explanation of the “5Ps model” please refer to the Handbook on IP Commercialisation, Section F.2.

3. Social Media Marketing

The term “social media marketing” refers to the application of social media platforms to promote a product or a service online. Companies use social media platforms to post information about their products and services not only with the objective of promoting them, but also with a view to:

- Tracking the number of views;
- Identifying trends on how the general public engages with their products and services;
- Collecting data and information on the demographics of the users that have engaged with their post, including location, age, etc.;
- Reaching the maximum number of potential customers and effectively spreading the message to their target audiences, at a very minimal cost.

Social media websites and platforms allow companies to interact with their actual and potential customers and viewers in real time. They can post their products online and get “feedback” in the form of reviews from their customers and consumers. Platforms also allow users to “re-post”, “share”, or “re-tweet” information about the products and services, by sharing links to the original posting. This creates traction and online traffic for the product or service to the wider audience.

Companies can, through the data analytics offered by these platforms, track how many times their original post was shared, and monitor how many views it has received, which gives a good indication of the audience reached.

In 2014, SocialMediaToday reported that “... Business retailers experience about 133% increase in revenues after marketing their business in the mobile market that promotes social media marketing value for their business ... The majority of successful brands have a social media page in order to widen their marketing coverage of making their brand more accessible among the social media users.”⁶ The relevant numbers are of course much higher today!

⁶ <https://www.socialmediatoday.com/content/impact-social-media-marketing-trends-digital-marketing>

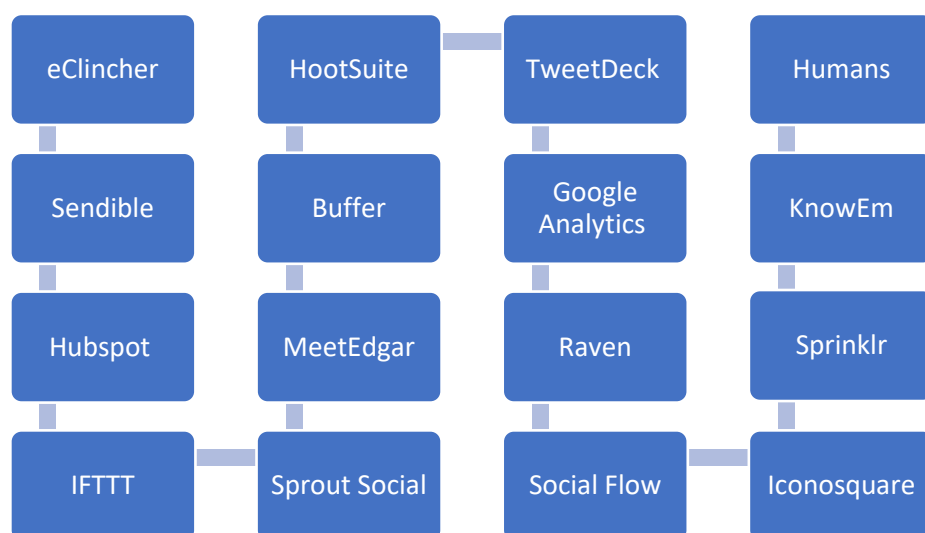
The most effective way to promote your products and services, particularly if you have limited budget, is undoubtedly to avail yourself of the array of social media platforms. The most famous and widespread social media platforms include:



- Facebook
- Instagram
- YouTube
- LinkedIn
- Pinterest

As you might imagine, managing all these social networks can be time consuming and challenging. If you intend to introduce and promote your products or services to consumers using a variety of social media platforms, you should then consider adopting some “**social media management tools**”, that automatically aggregate all the platforms that you would like to utilize for your online marketing. Such tools can help you push new content and information to your customers either all at the same time, or in a sequenced manner (through systems of auto-posting or smart queuing). These platforms also suggest best ways to post and react to posts to improve efficiency and effectiveness, and help you gather and analyse data from the users’ engagement with the posts/content so that you can understand if and why your customers like or dislike your products.

Some of the most famous social media management tools include



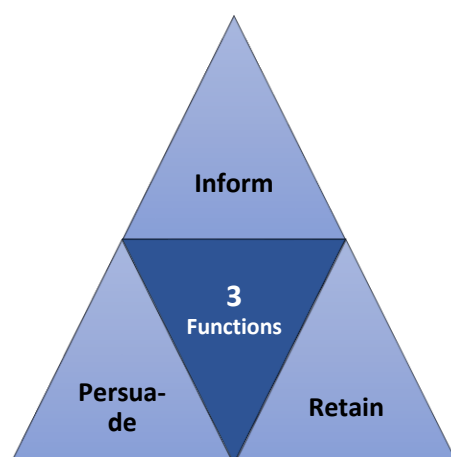
4. Advertising

Believe it or not, advertising is an extremely enduring discipline. There are examples of advertisements in ancient Egypt, where traders would write the names of their products and slogans

on papyrus to increase their sales. However, if the rationale behind advertising remains the same, the modalities have significantly changed, particularly with the advent of internet and social media.

It is hard to find one unique definition of “advertising”. Perhaps, advertisement can be understood as a **mechanism of drawing people’s attention towards certain products or services with a view to increasing their sales.**

Advertisement is therefore designed to increase awareness of certain products and services, by conveying (usually flattering) information to the relevant target audience (which may be the general public or specific sectors), through various media. The higher the number of people receiving the message within the shortest time frame, the better the potential growth of the business.



In this context, the use of social media and digital advertisement has become a fundamental tool for any company around the world, but even more for SMEs who often lack the necessary funds to use traditional advertisement channels (such as TV, radio, newspapers, etc.).

To understand some of the steps that you need to undertake to come up with the right advertisement campaign or approach, please refer to the Handbook on IP Commercialisation, Section F.4.

Now let’s list some of the most frequent and successful modalities to advertise, bearing in mind that if you have sufficient funds and human capacity, you can use them all at the same time.

1. Newspaper and Magazine Ads
2. Television Ads
3. Outdoor Ads
4. Celebrity Ads and Sponsorship
5. Radio and Podcasts Ads
6. Social Media Ads (most social media platforms, such as Instagram, Facebook, Pinterest, LinkedIn, etc., offer advertising opportunities).
7. Video Ads
8. Post & Mail Ads
9. Email Marketing

As they say: the first impression counts. If you package well your products, you will significantly increase their chances of being selected by consumers. In other words: packaging is crucial for your success in the marketplace. Undoubtedly, unique, well thought-out, and eye-catching packaging contributes not only to increasing the capacity of a product to distinguish itself from competing products, but also adds to its value and chances of success.

Generally, the term “packaging” refers to all activities relating to the visual design and production of the **container** for a product.

In other words, packaging should **not only function as a container or as protection for the product, but also as a marketing and promotion tool** that can significantly affect the sales of the product it contains. Therefore, before rushing to put your products on the market in ... whatever container, please consider the:

- Four Functions of Packaging:
 - Protection, Storage and Transportation
 - Convenient and Easy-to-Use
 - Communication
 - Information
- Five Characteristics of Packaging:
 - Graphics
 - Colours
 - Size
 - Shape
 - Environmental considerations

There are essentially two ways to protect your creative packaging through the strategic use of IPRs: industrial designs and trademarks.

- The first is by far the most common and perhaps what we would suggest as a first step: if your packaging is new and it complies with the other possible legal requirements, file immediately an industrial design application in your country (and in the countries where you intend to expand your business).
- The second option (i.e. trademarks) is excellent. However, many IP offices tend to reject 3-D marks (and packaging is typically a 3-D mark) as devoid of sufficient distinctive character, unless you can prove that that particular shape has acquired distinctiveness through use. Should this be the case, please consider first protecting your packaging as industrial design. After a number of years and certainly before the design expires, you can file the 3-D mark with your IP office, proving acquired distinctiveness through use of the industrial design.

For a more detailed information about packaging, its functions and characteristics, please refer to the Handbook on IP Commercialisation, Section F.5.

III. GETTING HELP WITH YOUR COMMERCIALISATION PLANS

1. Who can help you to commercialize your IPRs?

As mentioned before, your commercialisation plans should follow a logical order:

- The first step consists of carrying out an IP Audit and an IP Valuation.
- Then, you should ensure your IPRs are duly protected (at home and abroad).
- The following step is to enter in the right type of contract that will help you better commercialize your IPRs.
- Finally, you need to enforce your IPRs.

The bad news is that the DIY (Do It Yourself) approach may not work for you in this case, and for most of the above tasks, you may need to rely on the technical and strategic support of the right expert. The second bad news is that you may need to hire different types of experts depending on the step at which you are. Please don't get discouraged.

For example, while you might be able at a stretch to carry out your own IP Audit, it is unlikely that you may be capable of assessing the value of your IPRs (or of those of your counterpart). Particularly, the first times that you undertake these two important steps toward the commercialisation of your IPRs, you may want to involve an IP expert, who has proven experience in these types of activities.

For the second step, the situation is relatively easier: most of countries provide for lists of accredited IP Agents (or Representatives) that can act on behalf of clients and file your IPRs at national level. If that is the case, contact a few of them to try to assess the quality of their services, their past experience and, of course, their fees. If you are interested in exporting to other countries, then you have to protect your IPRs in those countries. Make sure that the IP Agent you choose in your country:

- Has experience in using WIPO international registration systems (i.e.: the Madrid, The Hague and the PCT systems), and
- Possesses a good network of IP associates in the countries where you want to obtain protection, in case you may need to react to possible refusals or official actions by their domestic IP offices.

Finding the right professional to help you with the third step of IP commercialisation is probably the most challenging. We already mentioned that the IP commercialisation contracts (i.e. licensing, technology transfers, franchising, etc.) are EXTREMELY complex. Do not attempt to draft them yourself. In addition, a normal/traditional lawyer may not possess the right experience to draft such contracts. You will have to search for somebody who has profound experience in:

- Commercial and business law
 - Contract law
 - IP law and practice
 - And possibly proven prior experience in drafting similar types of contracts
- ... Good luck!

The situation is again quite straightforward for the last step. Enforcement of IPRs can only be carried out by lawyers. Also, in this case, you may not look for a general lawyer (and perhaps not even a business lawyer), but an experienced IP lawyer with proven track record in IP litigation.

As already mentioned, before selecting a particular professional to help you out in a particular step of your commercialisation plan, make sure that he/she has a very large network of associates that will be able to assist you, for example, in:

- Securing protection of your IPRs to their countries, by responding to refusals or requests for modifications by their respective IP offices;
- Drafting the right commercialisation contract, or adapting your existing contracts to the specificities of their countries (including to comply with their domestic legal requirements);
- Enforcing your IPRs in their countries.

Please see list in Section III. 2.

2. List of IP attorneys

S.No	Country	Link
1.	Australia	https://www.ipaustralia.gov.au/about-us/doing-business-us/ip-professionals-and-other-sites
2.	Brunei	While there is no official list, information regarding Intellectual Property Law Firms in Brunei can be found at: https://www.hg.org/law-firms/intellectual-property/brunei.html . More information can be found by searching on the internet.
3.	Cambodia	Information in this regard is available at: http://www.cambodiaip.gov.kh/DocResources/e56e3c8a-2798-4a36-8a82-fb47e39293e8_570a7d12-3503-4fb9-af04-cd5c1dbb66ef-kh.pdf
4.	Indonesia	No official list available. However, national IP attorneys can be found by searching on the internet.
5.	Lao PDR	No official list available. However, national IP attorneys can be found by searching on the internet.
6.	Malaysia	While there is no official list, information regarding Intellectual Property Law Firms in Malaysia can be found at: https://www.hg.org/law-firms/intellectual-property/malaysia.html . More information can be found by searching on the internet.
7.	Myanmar	While there is no official list, information regarding Intellectual Property Law Firms in Myanmar can be found at: https://www.hg.org/law-firms/intellectual-property/myanmar.html . More information can be found by searching on the internet.
8.	New Zealand	Information in this regard is available at: https://www.ttipattorney.gov.au
9.	The Philippines	While there is no official list, information regarding Intellectual Property law firms in Philippines can be found at:

		https://www.hg.org/law-firms/intellectual-property/philippines.html . More information can be found by searching on the internet.
10.	Singapore	Please see official list at: https://www.ipos.gov.sg/docs/default-source/default-document-library/1-april-2019-official-register-of-patents-agents_updc5d01a77c2d0635fa1cdf0000abd271.pdf
11.	Thailand	While there is no official list. Details in this regard can be found at: https://www.hg.org/law-firms/intellectual-property/thailand.html . More information can be found by searching on the internet.
12.	Vietnam	While there is no official list, information regarding Intellectual Property Law Firms in Viet Nam can be found at: https://www.hg.org/law-firms/intellectual-property/vietnam.html . More information can be found by searching on the internet.

3. Links to ASEAN Technology Transfer Offices

S.No	Country	Particulars
13.	Australia	While there is no official national technology transfer office, however, most research organizations have established dedicated units or companies to facilitate technology transfer. For more information, please visit: https://www.alrc.gov.au/publications/17-technology-transfer/technology-transfer-offices . More information in this regard can be found by searching on the internet.
14.	Brunei	The Brunei Economic Development Board (BEDB) is one of the major agencies in Brunei which facilitates Technology Transfer. In addition, many research organizations have established dedicated units or companies to facilitate technology transfer. More information about BEDB is available at: https://www.wipo.int/edocs/mdocs/aspac/en/wipo_reg_ip_sin_14/wipo_reg_ip_sin_14_t8_b.pdf . More information in this regard can be found by searching on the internet.
15.	Cambodia	While there is no official national technology transfer office, however, most research organizations have established dedicated units or companies to facilitate technology transfer. . More information in this regard can be found by searching on the internet.
16.	Indonesia	While there is no official national technology transfer office, however, most research organizations have established dedicated units or companies to facilitate technology transfer. . More information in this regard can be found by searching on the internet.
17.	Lao PDR	While there is no official national technology transfer office, however, most research organizations have established dedicated units or companies to facilitate technology transfer. .

		More information in this regard can be found by searching on the internet.
18.	Malaysia	Malaysia has a network of Technology Innovation & Support Centers (TISCs) which facilitate technology transfer. In addition, most research organizations have established dedicated units or companies to facilitate technology transfer. More information about TISCs is available at: https://www.wipo.int/tisc/en/search/search_result.jsp?country_id=124 . More information in this regard can be found by searching on the internet.
19.	Myanmar	There is no official national technology transfer office. However, most research organizations have established dedicated units or companies to facilitate technology transfer. More information in this regard can be found by searching on the internet.
20.	New Zealand	There is no official national technology transfer office. However, most research organizations have established dedicated units or companies to facilitate technology transfer. More information in this regard can be found by searching on the internet.
21.	The Philippines	Philippines have a network of Technology Innovation & Support Centers (TISCs) which facilitate technology transfer. Other bodies like Innovation Technology Support Office (ITSO) also provides for the technology transfer facilitation. In addition, many research organizations have established dedicated units or companies to facilitate technology transfer. More information about TISCs is available at: https://www.wipo.int/tisc/en/search/search_result.jsp?country_code=PH . More information in this regard can be found by searching on the internet.
22.	Singapore	Some of the main Singapore Public Institutions with Technology Transfer Activities: <ol style="list-style-type: none"> 1. A*STAR (Agency for Science, Technology & Research) 2. BMRC (Bio Medical Research Council) 3. GIS (Genome Institute of Singapore) 4. IMCB (Institute of Molecular and Cell Biology) 5. SERC (Science and Engineering Research Council) 6. DSI (Data Storage Institute) 7. ICES (Institute of Chemical and Engineering Sciences) 8. IHL (Institute of Higher Learning) <ul style="list-style-type: none"> • NUS (National University of Singapore) • NTU (Nanyang Technological University) • SMU (Singapore Management University) • Polytechnics More information in this regard can be found by searching on the internet.
23.	Thailand	The technology transfer consortium helps in the transfer of Technology. In addition, many research organizations have established dedicated units or companies to facilitate technology transfer. For example: National Science and Technology Development Agency have their own technology licence office.

		Details at: https://www.sciencepark.or.th/index.php/en/technology-licensing-office-tlo/ More details about Technology Transfer Consortium can be found at: https://www.wipo.int/edocs/mdocs/aspac/en/wipo_ip_han_11/wipo_ip_han_11_ref_29.pdf . More information in this regard can be found by searching on the internet.
24.	Vietnam	There are numerous centres and offices that engage in technology transfer. The full list is available at: https://www.wipo.int/tisc/en/search/search_result.jsp?country_code=VN . More information in this regard can be found by searching on the internet.

4. Relevant Websites

S.No	Name	Link
1.	AANZFTA	aanzfta.asean.org
2.	ASEAN Intellectual Property Office	https://www.aseanip.org/
3.	ASEAN TM View	http://www.asean-tmview.org/tmview/welcome
4.	ASEAN PATENTSCOPE	http://ipsearch.aseanip.org/wopublish-search/public/patents;jsessionid=7D05B6901265ECDEC0968CBA4DD7031E?0
5.	ASEAN Design View	http://www.asean-designview.org/designview/welcome
6.	ASEAN Geographical Indication Database	http://asean-gidatabase.org/gidatabase/
7.	ASEAN IPA	http://www.aseanipa.org/
8.	ASEAN IP Helpdesk	http://www.asean-iprhelphdesk.eu/
9.	ASEAN IP Exchange	http://www.asiaipex.com/Home/Index_EN
10.	World Intellectual property Organization (WIPO)	www.wipo.int
11.	WIPO Small and Medium Sized Enterprises	www.wipo.int/sme
12.	WIPO Arbitration and Mediation Center	http://arbiter.wipo.int
13.	Directory of IP Offices worldwide	http://www.wipo.int/directory/en/urls.jsp
14.	World Trade Organization	http://www.wto.org
15.	European Patent Office	http://www.epo.org/
16.	European Union Intellectual Property Organization (EUIPO)	https://euipo.europa.eu/ohimportal/en
17.	European IP Helpdesk	http://iprhelphdesk.eu/news/ip-web-how-can-my-website-be-protected
18.	European Trade Mark and Design Network (ETMDN)	https://www.tmdn.org/
19.	TM Class	http://tmclass.tmdn.org/ec2/

20.	TM View	https://www.tmdn.org/tmview/welcome
21.	International Trade Mark Association	http://www.inta.org
22.	Max Planck Institute for Intellectual Property, Competition and Tax Law	http://www.intellecprop.mpg.de/enhanced/english/homepage.htm
23.	<u>Magister Lucentinus - University of Alicante Master of Intellectual Property and Information Society Programme</u>	http://www.ml.ua.es
24.	Digital marketing	https://www.socialmediatoday.com/content/impact-social-media-marketing-trends-digital-marketing
25.	Digital marketing	https://eclincher.com/blog/social-media-management-marketing-tools/

5. Key IP events

S.No	Name of Event	Link
26.	International Trademark Association (INTA)	https://www.inta.org/Programs/Pages/main.aspx
27.	MARQUES	https://www.marques.org/events/
28.	Pharmaceutical Trade Marks Group (PTMG)	https://ptmg.org/conferences/
29.	The International Association for the Protection of Intellectual Property (AIPPI)	https://aippi.org/events/
30.	Licensing Executives Society (LES)	https://www.lesusacanada.org/events/event_list.asp
31.	ASIAN Patent Attorneys Association (APPA)	http://apaaonline.org/events/
32.	International Federation of Intellectual property Attorneys (FICPI)	https://ficpi.org/events-and-training
33.	Intellectual Property Business Congress (IPBC)	http://www.ipbc.com/2019
34.	World IP Forum (WIPF)	https://www.worldipforum.com/
35.	Business of Asia IP Forum	http://www.hktdc.com/ncs/bip2019/en/main/index.html
36.	Intellectual Property Office of Singapore (IPOS)	https://www.ipos.gov.sg/media-events

37.	IP Academy Singapore	https://www.ipacademy.com.sg/legal-programmes
38.	IP & Innovation Researchers of Asia Network (IPIRA)	http://ipresearchersasia.org/
39.	APNIC	https://www.apnic.net/events/calendar
40.	ASIA IP	http://www.asiaiplaw.com/events/