

# PROTECTION OF INTELLECTUAL PROPERTY IN SHIP CONSTRUCTION

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# PROTECTION OF INTELLECTUAL PROPERTY IN SHIP CONSTRUCTION

## PRESENTATION STRUCTURE

**I.** INTRODUCTORY IDEAS

**II.** LEGAL FRAMEWORK ON IP RIGHTS IN MARITIME SECTOR

**III.** CONTRACT PROTECTION OF IP RIGHTS

# PROTECTION OF INTELLECTUAL PROPERTY IN SHIP CONSTRUCTION

## INTRODUCTORY IDEAS

### **First idea**

- . Protection means leadership and competitiveness
- ..Protection of "intangible" values

**Patents+Industrial Design+Trade secrets+Trademarks+Copyright**

### **Second idea**

- . Limited use of IPR in Shipping industry
- .. Summarized reasons:
  - . Confrontation: protection *IPR vs. Free competition*
  - . The Patent system "basis"
- ... How the "weakness" is compensated?
  - . IPR without official registration
  - . Secret information: contract clauses

# PROTECTION OF INTELLECTUAL PROPERTY IN SHIP CONSTRUCTION

## INTRODUCTORY IDEAS

### **Third idea:**

- . WIPO definition of Industrial Property**
- .. Why "industrial"?
- ... Register IPR vs. Not registered IPR
- .... Intellectual property (Copyright) protection

### **Closing remark:**

- . Technical regulations vs. Construction and Ship design**
- .. International Conventions (IMO)
- ... ISO Standards
- .... Classification Rules

# PROTECTION OF INTELLECTUAL PROPERTY IN SHIP CONSTRUCTION LEGAL FRAMEWORK ON IP RIGHTS IN MARITIME SECTOR: INTERNATIONAL

- **Paris Convention Protection of Industrial Property**
  - .. 1883 + 177 States + Objectives
- **Agreement on Trade Related aspects of IPR (TRIPS)**
- **Paris Convention regulation related to ships**
  - . Art. 5, ter, i)

## Article 5ter

[Patents: Patented Devices Forming Part of Vessels, Aircraft, or Land Vehicles]

In any country of the Union the following shall not be considered as infringements of the rights of a patentee:

1. the use on board vessels of other countries of the Union of devices forming the subject of his patent in the body of the vessel, in the machinery, tackle, gear and other accessories, when such vessels temporarily or accidentally enter the waters of the said country, provided that such devices are used there exclusively for the needs of the vessel;

- .. Relevance: Interpretative key other IPR
- ... Notes of its origin

## PROTECTION OF INTELLECTUAL PROPERTY IN SHIP CONSTRUCTION LEGAL FRAMEWORK ON IP RIGHTS IN MARITIME SECTOR: INTERNATIONAL

- 3 Requirements to apply the exception Art. 5, ter, i)

The patent must have as its **object** the hull of the ship, machinery, tackle, gear and other accessories

+

The objects covered by the patent **must be used** exclusively for the needs of the vessel

+

The vessel has **temporarily or accidentally enter** the waters of the country

### .. Conclusions:

"the current regulatory framework does not allow national authorities to take action against a ship that has a component built in violation of a patent and that lands in a port where said patent is registered and protected."

**Impact in shipbuilding sector + impact on competition**

# PROTECTION OF INTELLECTUAL PROPERTY IN SHIP CONSTRUCTION LEGAL FRAMEWORK ON IP RIGHTS IN MARITIME SECTOR: EUROPEAN

## Patents

- . Art. 5 ter, i) in national legislations (art. 61,e) LP)

## Industrial Design

- . Protection of external appearance of products
- .. Importance in Shipping industry
- ...Possible ways to protection: register vs. unregistered
- .... Art. 20.2 COUNCIL REGULATION (EC) No 6/2002 of 12 December 2001  
Origin + Differences with Paris Convention + Other systems

## • Trade secrets and confidentiality agreements

- . Not Paris Convention
- ..Art. 39 TRIPS Agreement
- ... Directive(EU) 2016/943  
Secret information + Not exclusive right + Reasonable measures

## • Copyright and Unfair competition rules

- . Term of "creation"
- . Systematic imitation

# PROTECTION OF INTELLECTUAL PROPERTY IN SHIP CONSTRUCTION

## CONTRACT PROTECTION OF IP RIGHTS: WHAT IS PROTECTED?

### **SAJ FORM 1974**

- . "Patent, trademark and copyright"
- .. Specific regime for builder rights linked with design and construction of the vessel

### **NORWEGIAN STANDARD FORM 2000**

- . "Patent rights"

### **AWESFORM 1999**

- . "Patent rights"

### **CMAC STANDARD NEWBUILDING CONTRACT SHANGHAI FORM 2011**

- . "Patents, trademarks and copyrights"

### **NEWBUILDCON FORM 2008**

- . "Copyright, trademark, patent or similar rights"



# PROTECTION OF INTELLECTUAL PROPERTY IN SHIP CONSTRUCTION

## CONTRACT PROTECTION OF IP RIGHTS: WHO IS PROTECTED?

### **.Most usual operation:**

- . Shipyard design
- .. Shipyard provides materials and equipment
- ... Supplier transfer right to shipyard

### **.Other case:**

- . Design company elected by buyer
- .. Design company transfer rights to buyer
- ... Buyer transfer rights to shipyard

### **.Third hypothesis:**

Buyer provide Hi Tech equipment with patent to shipyard

# PROTECTION OF INTELLECTUAL PROPERTY IN SHIP CONSTRUCTION

## CONTRACT PROTECTION OF IP RIGHTS: WHAT MEASURES?

### **.Some forms(A+B+C)**

A )Express warranty. Shipyard:

- Ship built without IPR infraction
- Delivered free of such claims

### **.All forms(B+C)**

B) Express indemnity

C) Cost and expenses of process

### **.Most common case**

Facts: infringement of IPR by Shipyard

Consequence: third claim against buyer

Compensation:

- include direct and indirect damages
- other issues: arrest. Replacing equipment

**THANK YOU SO MUCH FOR YOUR ATTENTION**

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