Protecting your IP – Think outside the box but make sure the box is locked

Provided By EVERSHEDS SUTHERLAND

Eversheds Sutherland Represents The Coming Together Of Two Firms With A Shared Ethos And Commitment To Client Service Excellence. We Are Known For Our Business Savvy And Industry Intelligence And For Providing Innovative And ... **MORE**

By SARA-JANE PLUKE And GEORGIA BARNARD

Topics Intellectual Property Law

21 Jul 2021

It is vitally important to develop adequate safeguards around one's intellectual property, whether one is an individual owner of such IP or a company. Intellectual property is an asset after all, especially where such intellectual property is not capable of being protected by way of statute, for example copyright (other than cinematographic films), trade secrets, business and operation know-how, processes, expertise, improvements, specialised technical information and all such related 'life-blood' that sets an enterprise apart from its competitors.

One of the ways in which this type of intellectual property can be protected is by building adequate restrictions into appropriate contracts, for example employment agreements governing an enterprise's intellectual property and where such intellectual property is developed or created by employees in the course and scope of their employment. Other examples are restraints of trade and non-disclosure agreements and non-circumvention and confidentiality agreements where an enterprise engages with a third party who will have access to the enterprise's intellectual property.

The general position in respect of a work created by an employee under a contract of service in the course and scope of employment, is that such work is assigned to and resides with the employer from the date on which such work is created. However, discrepancies arise around this general principle, depending on the facts so it is always best to be proactive and cater for this in an employee's employment contract. Such contractual terms need to be highlighted to employees at the commencement of the employment relationship.

Obviously, where an individual or a company has intellectual property that is capable of statutory protection namely, trade marks (brand names, logos, strap lines, musical jingles, colours, distinctive smells, shapes and all such distinguishing material that is recognisable by consumers and competitors as belonging to you or the company), patents, designs, domain names and in some instances, copyrights such as cinematographic films; it is strongly recommended that such intellectual property be registered to protect and enforce one's rights in and to that intellectual property.

Similarly, the intellectual property of a company's clients (and competitors) must treated with the highest standard of care to avoid exposing the company to an action

with potential damages claims and resultant reputational harm where there is, for example, a leak of such client's or competitor's valuable intellectual property that was entrusted to the company. In the recent case of EOH Abantu v CCMA [2019] 12 BLLR 1304 (LAC), an employee was held to be negligent in distributing valuable intellectual property of a client to an unauthorised third party. The negligent distribution could have resulted in severe reputational harm for the company as the client may have reasonably concluded that its intellectual property was not in safe hands and was compromised. The employee was consequently dismissed, as the court held that his negligence and his carelessness merited a dismissal.

See also:

- Artificial intelligence created inventions – Patentable or not?
- The machines are here – 3D Printing: A genuine challenge to Intellectual Property laws and rights holders?
- Due diligence in Intellectual Property acquisitions
- Copyright protection for works created prior to 1978

(This article is provided for informational purposes only and not for the purpose of providing legal advice. For more information on the topic, please contact the author/s or the relevant provider.)

AGREEMENTS/CONTRACTS | CINEMATOGRAPH FILMS | COPYRIGHT | EMPLOYMENT | INTELLECTUAL PROPERTY (IP) | RESTRAINT OF TRADE

Sara-Jane Pluke

Sara-Jane heads up Eversheds Sutherland's Intellectual Property department and is a specialist in the field. She advises a variety of clients on various aspects of intellectual property, including but not... Read more about Sara-Jane Pluke

Click here to send a legal query to Sara-Jane Pluke

Georgia Barnard

Georgia Barnard is an associate Eversheds Sutherland's litigation group and has experience in litigation and arbitration and commercial law. She has experience particularly in collections, insurance, pension, trusts, estates and... Read more about Georgia Barnard

Click here to send a legal query to Georgia Barnard

Share

Intellectual Property Law articles by Eversheds Sutherland

- Due diligence in Intellectual Property acquisitions
- Schrems II: The impact on South Africa
- Protecting intellectual property during lockdown
- What's in a name? - Erroneous registration of company names

Intellectual Property Law articles on GoLegal

- Declaring a state of emergency has far-reaching effects for citizens' rights and for businesses
- Malaria, vaccines and the riddle of steel
- Artificial intelligence created inventions - Patentable or not?
- If the shoe fits: A Cinderella story for Valentino and their iconic Rockstud® shoe designs

PROVIDED BY:

EVERSHEDS SUTHERLAND

BY

Sara-Jane Pluke

Sara-Jane heads up Eversheds Sutherland's Intellectual Property department and is a specialist in the field. ...

Georgia Barnard

Georgia Barnard is an associate Eversheds Sutherland's litigation group and has experience in litigation and arbitration and commercial law. She has experience particularly in collections, insurance,...

SEND A LEGAL QUERY TO SARA-JANE PLUKE & GEORGIA BARNARD

EXPERTS IN INTELLECTUAL PROPERTY LAW

Adams & Adams

62 Relevant articles

Eversheds Sutherland

7 Relevant articles

Juta

3 Relevant articles

KISCH IP

167 Relevant articles

Sabinet

4 Relevant articles

SchoemanLaw Inc

1 Relevant articles

UPCOMING EVENTS

The ABCs of corporate governance – Unpacking essential tools

AUG 24 @ 2:00 PM - 3:00 pm

Unpacking SLA's – Service Level Agreements

AUG 26 @ 2:00 PM - 3:00 pm

Insourcing versus outsourcing – The resources required

SEP 22 @ 11:00 AM - 12:00 pm

Series: Three steps to becoming a better leader (Part 3)

OCT 21 @ 2:00 PM

Unpacking accountability structures and disciplinary proceedings – Directors and employees

OCT 25 @ 11:00 AM

Want the latest legal news and views in your box?

Your email address

Subscribe

ABOUT US

GoLegal is a leading industry news and information portal for the South African legal sector, catering to attorneys, corporate counsel, legal scholars, policy makers and other corporate and legal interest groups.

READ MORE >

OUR SERVICES

Promote Legal Conferences, Events and Seminars

Advertise with GoLegal

Privacy Policy

FOLLOW US