



# EXCO MEETING, ZURICH

## 10-14 APRIL 2016

### LAW AND PRACTICE

The Executive Committee Delegates were asked to briefly list any recent important cases or changes in law or practice in the field of IP in their country or region. This included measures relating to the practice of IP law as a profession as well as substantive issues.

If you would like more information on any topic listed below, please contact [secretariat@ficpi.org](mailto:secretariat@ficpi.org).

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## ARGENTINA

Iván Poli

- 1 A new Civil and Commercial Code became effective on August 1, 2015 (Law No. 26,994 enacted October 1, 2014), which directly or indirectly bears on many IP areas, such as trade names, conjugal property, statute of limitations, comparative advertising, jurisdiction, personality rights (right to control use of one's image), lapsing (including lapsing of IP rights), joint ownership (including IP rights), liability for unjustified breakdown of negotiations, pre-formulated standard agreements, estoppel (*venire contra factum proprio non valet*), leasing, franchising and assignment agreements, liens, legal liability, good faith, preventive remedies and international private law.

ARGENTINA: Security for costs is no longer required for foreign nationals

One immediate effect of the new Civil and Commercial Code is that according to its Section 2610 citizens and permanent residents of foreign countries no longer need to post a bond to guarantee payment of legal costs, even if they are nationals of a country which is not a party to the 1954 Hague Convention on Civil Procedure.

- 2 The third event is a non-event: Argentina did not amend its industrial models and designs law, as envisaged by a bill which brought the current law up to date.

## AUSTRALIA

Stephen Krouzecky

- 1 D'Arcy v Myriad Genetics Inc [2015] HCA 35

The High Court held that an isolated nucleic acid, coding for a BRCA1 protein, with specific variations from the norm that are indicative of susceptibility to breast cancer and ovarian cancer, was not a "patentable invention" within the meaning of s 18(1)(a) of the Patents Act 1990 (Cth) ("the Act").

The Court held that an isolated nucleic acid, coding for the BRCA1 protein, with specified variations, is not a manner of manufacture. While the invention claimed might be, in a formal sense, a product of human action, it was the existence of the information stored in the relevant sequences that was an essential element of the invention as claimed.

- 2 Cantarella Bros Pty Limited v Modena Trading Pty Limited [2014] HCA 48

The issue was whether the Italian words "ORO" and "CINQUE STELLE" were inherently adapted to distinguish coffee and related goods. The High Court, by a 4-1 majority, held that the trade marks "ORO" and "CINQUE STELLE" registered in respect of products including coffee were inherently adapted to distinguish the goods for which they were registered from the goods of other persons, within the meaning of section 41 of the Trade Marks Act 1995 (Cth).

The High Court decided that ORO and CINQUE STELLE would not be understood by persons in Australia concerned with coffee products to be directly descriptive in relation to such goods. Accordingly, there was no legitimate need for other traders to use ORO and CINQUE STELLE in respect of their own coffee products. This decision clarifies the test for 'inherent distinctiveness' of foreign language marks.



### 3 Research Affiliates LLC v Commissioner of Patents

This case looked at whether a claimed invention method to create a securities index by means of a computer is a patentable invention and is considered a manner of manufacture within the meaning of section 18(1) (a) of the Patents Act 1990 (Cth). The Full Federal Court upheld a decision of the Federal Court and overturned the appeal concluding that the claimed method clearly involve what may well be an inventive idea, but was an abstract idea. The specification made it apparent that any inventive step arises in the creation of the index as information and as a scheme, and there was no suggestion in the specification of the claims that any part of the inventive step lay in the computer implementation.

The decision clarifies that a mere reference to computer implementation in patent claims is not sufficient to make the invention patent eligible. Consequently, inventions involving business methods and software where a computer is “inextricably linked with the invention itself” still appear to be patentable in Australia.

### 4 Commissioner of Patents v RPL Central Pty Ltd [2015] FCAFC 177 (11 December 2015)

In a unanimous decision, the Australian Full Federal Court overturned the primary judge's initial decision and concluded that the claims of RPL Central's invention directed to a “method of gathering evidence relevant to an assessment of an individual's competency relative to a recognised qualification standard” did not represent patentable subject matter. The Court concluded that the claims were directed to a scheme or business method that is not patent eligible subject matter. For computerised business methods, the invention must lie in that computerisation. It is not sufficient to simply implement the business method using the computer for its well-known and understood functions

The decision clarifies the distinction between a technological innovation versus a business innovation and sets out additional specific guidelines to assist in determining when business methods include patentable subject matter under Australia's “manner of manufacture” test.

### 5 Pre-examination notification process for patent applicants

IP Australia is currently trialing a pre-examination notification process for patent applicants. Under this new trial, which commenced on 25 January 2016 and applies to approximately 1000 pending applications, IP Australia will issue a pre-examination notification two months before a patent application is to undergo formal examination. This notification provides the applicant with two months to make pre-examination amendments to the application as well as written submissions for the examiner's consideration prior to examination of the patent application.

### 6 Productivity Commission inquiry into Intellectual Property Arrangements

On 18 August 2015, the Productivity Commission announced that they would be conducting a review into Australia's intellectual property arrangements, including the laws relating to copyright, patents, trademarks, geographical indications, registered designs, moral rights, performers' rights, plant breeders' rights and circuit layout rights.

The Commission will also take into consideration the impact of the US Free Trade Agreement and the Trade-Related Aspects of Intellectual Property Rights. The inquiry will look specifically at:



- competition policy issues in intellectual property arising from new developments in technology and markets; and
- the principles underpinning the inclusion of intellectual property provisions in international trade agreements.

## 7 Lisbon Agreement

The Geneva Act of the Lisbon Agreement on Appellations of Origin (AO's) and their International Registration was adopted on 20 May 2015. The Regulations under the Lisbon Agreement came into force on 1 January 2016.

The Lisbon Agreement provides for the protection of appellations of origin, that is, the "geographical denomination of a country, region, or locality, which serves to designate a product originating therein, the quality or characteristics of which are due exclusively or essentially to the geographic environment, including natural and human factors".

The Agreement significantly expanded the scope of the Lisbon Agreement from just AO's (narrower subset of Geographic Indicators).

Australia questioned the compatibility of the Geneva Act with their existing national systems for GI protection. Although Australia is not a signatory to the agreement, Australia fought to ensure that use of common food names does not harm export markets to countries who are signatories to the agreement. The Australian dairy industry fears the Agreement could have a negative impact on exports.

## BRAZIL

David Merrylees

- 1 A limited trial PPH agreement with the USPTO in an attempt to reduce the examination backlog
- 2 A limited expedited examination procedure for Brazilian patent applicants with applications abroad.
- 3 A limited expedited examination procedure for Brazilian small-entity patent applicants

## COLOMBIA

Ximena Castellanos

- 1 RESOLUTION No. 3719 OF 2016 OF THE SUPERINTENDENCE OF INDUSTRY AND COMMERCE: Conversion, division and merger of patent applications.

The conversion, division or merger of patent applications shall be filed at any point of the application process, even within an administrative appeal. There is no need for an objection on the grounds of lack of Unity of Invention to be raised, in order for the applicant to be able to file a divisional application.

- 2 RESOLUTION No. 3719 OF 2016 OF THE SUPERINTENDENCE OF INDUSTRY AND COMMERCE: Requirements for non-patentability or non-compliance of requirements for patent concession.



The applicant has the right for a maximum of three patentability examinations to be carried out (if deemed necessary by the National Office), as long as they are paid for and requested within a period of no more than 18 months, for patents of invention and 9 months for utility model patents, counted as from the date of publication.

## CHILE

Bernado Serrano

### 1 UNIVERSITY OF PITTSBURGH OF THE COMMONWEALTH SYSTEM OF HIGHER EDUCATION

Patent entitled: "Benzoyl-methionine benzoyl-serine substituted derivative compounds, isoprenil transferase protein inhibitors, pharmaceutical compositions from such compounds and use of the compound and composition in the treatment of cancer, restenosis and/or atherosclerosis".

We successfully overcame before the Second Instance Court a resolution which rejected the application for not involving an inventive step.

During second instance, the Special Court of Appeals stated that the analysis of cited documents D3 and D4 do not allow finding any suggestion or motivation that allows, alone or in combination, to deduce the compounds of the patent application, since they have determining structural differences, and the claimed compounds, the chemical compositions of said compounds and the use of the compounds and the composition for the treatment of cancer, restenosis and/or atherosclerosis involve an inventive step.

Hence, as a result of the success of the appeal recourse, the IP Court revoked the first instance rejection granting a patent.

### 2 G.D. SEARLE LLC. / PFIZER CHILE S.A

Patent entitled: "Pharmaceutical composition which comprises from 10mg to 1.000 mg of Celecoxib, with a particle size (D90) lower than 200  $\mu\text{m}$  and its preparation process through via wet granulation, useful for preparing a medicament for the arthritis treatment".

This case refers to a patent cancellation action which holder (our client) is one of the best seller pharmaceutical drugs. Plaintiffs claim that the patent has been issued in contravention of patentability requirements and that it is not novel and does not involve an inventive step. Main adversarial argument is that Celecoxib was an obvious step to achieve a high-availability because reducing the particle size increases in theory the contact surface with the solvent, and thus the rate of dissolution of the active principle. Contrary what is sustained by the adversarial parties, the experiments that were developed by the inventors show that the compositions in this patent provide a significantly improved bio-availability compared to the non-ground and unformulated Celecoxib.

### 3 MACKAY & CIA. ABOGADOS

The importance about this opposing prosecution lies on the dispute between two attorneys' offices (our client MACKAY & CIA ABOGADOS LTDA. and the Attorney Mr. Federico Mckay Alliende) over the trademark precisely for "legal services" in class 45: "MCKAY & CIA ABOGADOS" been accepted by the Chilean PTO (at first instance) the opposition from our client MACKAY & CIA ABOGADOS LTDA. based on the grounds of an uninterrupted use of its non-registrar trademark MACKAY & CIA ABOGADOS, decision



which was appealed by the applicant Mr. McKay Allende waiting for the oral hearings in front of the Special Trademark Court Of Appeals.

This trademark dispute could be considered as a “key case” for attorneys’ offices due that this decision could change the approach of giving a name to an office only base of the use of a family name without any other consideration.

## CANADA

John Knox and Louis-Pierre Gravelle

### 1 Privilege for patent and trademark agents

Bill C-59 (An Act to implement certain provisions of the budget tabled in Parliament on April 21, 2015 and other measures) received Royal Assent on June 23, 2015.

This legislation includes provisions for protecting confidential communications between clients and their patent/trademark agents from forced disclosure during litigation, as well as provisions allowing CIPO to extend deadlines in cases of force majeure, thereby helping to avoid unintentional loss of IP rights. The privilege provisions (sections 54 and 66) of C-59 will be in effect as of June 23, 2016.

This significant legislative milestone would not have been achieved without the tireless efforts of FICPI, AIPPI and the Intellectual Property Institute of Canada (IPIC).

### 2 Jurisprudence

Google Inc. v Equustek Solutions Inc., [2015] SCCA No. 355

The Supreme Court of Canada granted leave to appeal in the case of Google Inc. v Equustek Solutions Inc., et. al, an appeal from a British Columbia Court of Appeal decision, in which a broad worldwide injunction was granted restraining Google, a non-party to the action, from including the defendants’ websites in Google’s search results. This appeal brings several interesting issues before the Supreme Court of Canada, including: (1) Under what circumstances may a court order a search engine to block search results, having regard to the interest in access to information and freedom of expression, and what limits (either geographic or temporal) must be imposed on those orders? (2) Do Canadian courts have the authority to block search results outside of Canada's borders? (3) Under what circumstances, if any, is a litigant entitled to an interlocutory injunction against a non-party that is not alleged to have done anything wrong?

MC IMPORTS INC. v AFOD LTD., 2016 FCA 60.

This appeal is about the validity of a trade-mark when that mark is a geographical location. The appellant, MC Imports Inc., imports and sells food products under the trade-mark LINGAYEN. Lingayen is a municipality in the Philippines known for its bagoong shrimp paste products characterized by their distinct aroma and flavour. The Judge agreed with the respondent that the appellant’s trade-mark was not registrable at the time of registration and was thus invalid, because it was clearly descriptive of the place of origin of the wares (the current Act uses the word goods) in relation to which it was used, contrary to paragraph 12(1)(b) of the Act. The Federal Court of Appeal dismissed the appeal.



Lum v Dr Coby Cragg Inc, 2015 FCA 293

The Federal Court of Appeal considered whether a trademark having a geographic component is registrable when the services of interest originate from the region associated with the trademark. Given the Court's reasoning, it may now prove more difficult for one to register a mark having a geographic component if the goods or services of interest actually originate from that geographic location, irrespective of whether the location is known for such goods or services.

Philip Morris Products S.A. v Marlboro Canada Limited, 2016 FCA 55

In the Federal Court of Appeal dismissed the appeal, thus maintaining a discretionary Order of a judge of the Federal pursuant to paragraph 27(1)(c) of the Federal Courts Act, R.S.C., 1985, c. F-7. The Judge had ruled that Marlboro Canada Limited and Imperial Tobacco Canada Limited (the respondents) were entitled to elect an accounting of profits or all damages sustained as a result of the infringement of their rights in the registered trade-mark MARLBORO. The Judge also ordered that pre and post judgment interest would be determined by the reference judge, should the respondents opt for accounting of profits.

Brown c Canada, 2016 CAF 37

The Federal Court of Appeal upheld the Federal Court's conclusion that the inventor was a "public servant" within the meaning of the Public Servants Invention Act (PSIA), but concluded that failure to disclose one's status as a public servant does not invalidate a patent. The Federal Court of Appeal found that such disclosure is not required under either the Patent Act or the Patent Rules after conducting a detailed analysis of the interaction between the Patent Act and the PSIA. The Federal Court of Appeal also reviewed past amendments to the Patent Act and the PSIA, which were part of IPIC's submissions, to conclude that Parliament did not intend that a patent could be void for a failure to disclose public servant status.

## CHINA

David Cheng

- 1 Hongda Vs Shijiazhuang Shuanghuan Auto Co; Design Patent Infringement before Supreme court. In the case how to justly use warning letter for harmonizing the standard for use of Warning letter in China.

## DENMARK

Claus Elmeros

None

## FINLAND

Kim Finnilä, Folke Johansson, Paula Sailas

Expedited examination of first filed patent applications has been available since December 2014. This pilot program has worked well in 2015 and has been extended into 2016. There is no official fee for filing such a request.



## FRANCE

Didier Intès – Eric Le Forestier

- 1 Implementation of a “fast track” examination process for patents: no fee due; request must be made within 10 months from filing; accelerated publication must be requested at the same time; applicable to patent applications filed electronically only.
- 2 Draft law on biodiversity excluding genetic components of excluded products from patentability.
- 3 Decree on geographical indications protecting industrial/artisanal products.

## GREECE

Helen PAPACONSTANTINOY, Athanasios TSIMIKALIS and Constantinos KILIMIRIS

- 1 There is a new code of civil procedure aiming to expedite judicial proceedings (including infringement and nullity suits) as of 1/1/2016,

## HUNGARY

Adam Szentpéteri

- 1 No substantial changes last year

## ITALY

Paolo Stucovitz and Carlo Luigi Iannone

None

## IRELAND

David Brophy

- 1 Glaxo Group Ltd v Rowex Ltd [2015] IEHC 368: Court refused to stay Irish proceedings when a declaration of invalidity had been submitted to OHIM, finding “special grounds” under Art 104

## INDIA

Sharad Vadehra, Swarup Kumar, Jaya Bhatnagar and Vikrant Rana

- 1 IMPORTANT CASES

### PATENTS

IPO rejects Compulsory Licence application against Astrazeneca’s Anti diabetic drug Saxagliptin

Hyderabad based drug maker Lee Pharma had filed a request dated May 13, 2015, seeking the grant of a Compulsory Licence under Section 84 of the Indian Patents Act for manufacturing and selling the compound Saxagliptin, granted Patent No. 206543 in the



name of Bristol Myers Squibb Company (BMS). BMS by virtue of an Assignment Deed, transferred/assigned the ownership rights to AstraZeneca AB.

The Controller of Patents recently issued on January 19, 2016. The CGPDTM in his Order rejecting the application cited that “the Applicant has not shown what is the reasonable requirement of the public with respect to Saxagliptin in India in the context of number of Type-II DM patients requiring Saxagliptin. .... On the face of their submission, there is no way to understand the exact requirements of Saxagliptin in Indian market and to decide whether or not the Patentee/ Respondent is meeting the reasonable requirements of the public in respect to patented invention.....”

Further, the CGPDTM rejected the Applicants’ plea of the drug not being available to the public at reasonably affordable price due to lack of supporting concrete data evidencing the same.

Thus, due to lack of evidence and consequential failure to satisfy the Controller regarding any of the grounds pleaded, as specified above, the CGPDTM held that a prima facie case was not made out for allowing the application for grant of compulsory licence.

Prior to the Hearing scheduled on December 15, 2015, Astrazeneca had also filed an intervention petition under Section 80 of the Act seeking an in- person hearing before the final determination regarding a prima facie case being made out in said case. The CGPDTM rejecting such petition held that the Petitioner does not hold a locus standi in the Compulsory License proceedings unless there is an adverse order under Section 87(1) that a prima facie case has been made out for making of an order under Section 84.

#### THE BASMATI ROW

In August 2010, application of Agricultural and Processed Food Products Export Development Authority (APEDA) to register Basmati as a GI under the GI Act, was opposed by 6 opponents from the State Madhya Pradesh (MP), pleading various grounds and contentions. The pleadings were completed and all the oppositions except the one filed by the State of MP were finally heard in June 2013. The Opponents argued that 13 districts in the State of MP should have been included in APEDA’s application.

While the parties were awaiting a hearing to be fixed in the State of MP’s opposition, the Assistant Registrar (AR) of Geographical Indications issued a common order in all the six oppositions on December 31, 2013 (common order). The main findings in the common order are as follows:

- “Popular perception” has no statutory sanction as a basis for GI protection.
- The AR had looked into documents which are 50 years old and the same create a factum of Basmati cultivation in the State of MP and APEDA gave no reasons for excluding other state which have been producing Basmati since 1900s.
- It is vital to demarcate actual producing area even up to the level of village panchayat and not even a micron point space of actual cultivation area should be left uncovered.
- From the data published by the Directorate of Rice Development (DRD), Patna, it is clear that some of the States like MP, Rajasthan, Bihar have been cultivating Basmati rice and the said areas are left uncovered in APEDA’s application



Accordingly, the AR held that not even a “micron point space” of actual cultivation area should be left uncovered and directed APEDA to file an amended application by including “the uncovered area” within 60 days of the order.

APEDA appealed against the AR’s order in IPAB. IPAB heard the appeal during extensive hearings held in Chennai on November 3-5, 2015. As such, the IPAB held that APEDA “is entitled to get GI Tag for Basmati rice” in respect of the areas stated in its application. Accordingly, it directed the AR to issue a certificate of registration within four weeks of receipt of a copy of its order. As for the inclusion of the areas claimed by the Opponents, the IPAB directed the AR to reconsider the matter afresh by affording a reasonable opportunity to both sides within 6 months from the date of receipt of the IPAB’s order.

As per certain sources, a writ petition has now been filed by MP Opponents against the aforesaid IPAB Order. The Madras High Court has passed the following orders stating that “Till a decision in the writ petition (is taken) no precipitative action will be taken by APEDA in respect of the produce (basmati rice) from Madhya Pradesh in respect of existing areas where such rice is alleged to have been growing.”

#### Merck v. Glenmark

In the instant case, the Delhi High Court decided in favour of the plaintiff and held that the generic version of the drug manufactured by Glenmark infringed Merck’s patented anti-diabetic Sitagliptin. . The Court affirmed that merely because defendant, who is manufacturing generic version, is selling a tablet at a lower price than that of plaintiffs cannot be made ground to decline injunction against the defendant, who has been found to have been infringing the invention of the plaintiffs, is as much as, a competitor of the plaintiffs. The grounds of lack of inventive step, industrial applicability as well as insufficiency of disclosure put forward by Glenmark were not accepted by the Court Also, crucially enough the Court reiterated the recent precedent (the Koninklijke Phillips Electronics decision) on Section 8 and held that non-compliance with Section 8 would only lead to revocation if the court viewed the omission of information as deliberate, which was not so in the instant case. The judgment of the Delhi High Court was seen by many as highlighting the patent jurisprudence of Indian courts and depicting that Indian courts have no bias in favour of generic drugs and their manufacturers.

#### Roche Vs Cipla

Roche Emerges victorious in a hard fought victory this past November when a Delhi High Court Division Bench ruled that Cipla’s drug Erlolcip was indeed infringing Roche’s Indian patent 196774 for the compound erlotinib hydrochloride marketed as Roche’s lung cancer drug Tarceva.

The Bench, however, did not grant any injunction in favour of Roche saying its patent would expire in March 2016 and since no such order had been passed by the single judge, Cipla had continued to manufacture and sell Erlolcip. Instead it decreed that Cipla would be liable to render accounts and directed that the Joint Registrar record evidence pertaining to profits made by Cipla concerning the offending product. Like the Merck vs. Glenmark (sitagliptin) decision, this judgment emphasises India’s commitment to safeguarding patent rights and paves a clearer road for patent litigation, especially for pharma patents.



### National Institute of Immunology v. The Asst. Controller of Patents and Designs

In the instant case, the Intellectual Property Appellate Board passed a landmark decision when it allowed a second divisional application, i.e., a divisional application arising out of a first divisional application.

The Asst. Controller had disallowed the second divisional application stating that it was arising out of a first divisional application and that it was time barred since it was filed after the grant of the parent patent application.

The IPAB observed that the filing of the second divisional application was not time barred as the first divisional application was filed after the issuance of first examination report in the matter of the parent application and before its grant, and also the second divisional application was filed after the issuance of first examination report in the matter of the first divisional application and before grant of the same.

The IPAB observed that when in the first examination report related to the first divisional application the Controller raised the objection regarding multiplicity of inventions, the applicant was not left with any other option but to file a second divisional application. In the interest of justice, such second divisional application is allowed.

### Bata v. Vitaflex Mauch GMBH

In the instant case, the High Court of Delhi held that only a patentee can issue threat/legal notice to an alleged infringer asking him to restrain from such action of infringement.

The facts of the case are such that Vitaflex Mauch GMBH (herein referred to as the 'Defendant') issued a Legal notice on April 03, 2006, to Bata India Limited (herein referred to as the 'Plaintiff') claiming that the shoes being manufactured by the Plaintiff are infringing upon the Defendant's trade mark and patent rights. The Defendant had filed Indian patent application No. 1521/CHENP/2003 on September 26, 2003 entitled "An inner sole for shoes". The said patent application was granted on September 05, 2008 (Patent No. 223184). The Plaintiff filed a suit against the Defendant seeking declaration that the threats made by the Defendant with respect to patent infringement are groundless, unjustifiable and wrongful.

The Court observed that a conjoint reading of Section 48, 52 and 70 of the Patents Act shows that in order to be successful to claim infringement, there must be granted a patent to the person who has issued the threat/legal notice that the Plaintiff should not violate the rights of the patentee. Since the Defendant had been unable to show that it has a valid patent pertaining to five pressure points/reflex points, the Defendant was restrained to issue any groundless threats through circulars or advertisements or by communication to the Plaintiff with respect to five pressure points/reflex points. It was thus declared that the threats made by the defendant to the plaintiff are groundless, unjustifiable and wrongful.

### TRADEMARKS

#### Neon Laboratories v. Medical Technologies

In the instant case, the Supreme Court was looking at an issue of grant of ad interim injunction. The centre of controversy was the defendant's drug by the name of 'PROFOL'. The appellant was also in the business of manufacturing and selling a drug containing the same compound as in the defendant's drug by the name of 'ROFOL'.



While the defendant started using the drug in 1998, it didn't register the trademark. On the other hand, the appellant got the mark 'ROFOL' registered in the year 1992 but only started using it in the year 2004. Thus, while the defendant's mark had a prior user, the appellant's mark had a prior registration.

The issue before the Apex Court was that whether the goodwill earned through the use of defendant's mark override the fact of prior registration of the appellant's mark.

The Court held that the prior use of the defendant's mark will be considered important in relation to the prior registration but non-use of the appellant's mark.

*Pidilite Industries Ltd. and Anr v. Vilas Nemichand Jain and Anr*

In the instant case, the Bombay High Court was deciding a case of passing off in relation to a descriptive mark. The mark in question was 'LEAKGUARD'. Both the plaintiff and the defendant sought to register the mark for 'solvent chemicals'.

Deciding the case, the Court observed that it was necessary to establish prior user in a case of passing off, but such prior user ought to be continuous and consistent as well. The Court further stated that for the plaintiff to succeed in a suit for passing off, it must establish that the mark in question had acquired secondary meaning.

Further, the Court held that it is essential for the plaintiff to establish that the defendant's goods are being mistakenly associated with the plaintiff's mark, resulting in deception of unsuspecting customers, irrespective of the fact that such deception is with any mala-fide intention or not.

Also, the Court held that the long acquiescence to the use by the defendant of the impugned mark went against its claims for passing off.

Finally, the Court held that there was no passing off on the part of the defendant.

*Indchemie Health Specialties Pvt. Ltd. v. Intas Pharmaceuticals Ltd. & Anr.*

In the instant case, the Bombay High Court was adjudicating an interlocutory application in a trademark infringement suit.

The plaintiffs were the registered proprietors of the 'Cheri' mark for pharmaceutical preparations while the defendants started producing a dietary supplement with the name of 'Multi Cherry', which was not a pharmaceutical preparation.

The Court observed that since the good of the plaintiff was related to a pharmaceutical preparation and the good of the defendant was related to a dietary supplement, there was no infringement.

*Lal Babu Priyadarshi Vs. Amritpal Singh (2015) 43 SCD 082,*

In a recent decision, the Supreme Court of India has held that that the names of gods or holy books cannot be trademarked to sell goods and services as allowing such a thing could offend people's sensibilities and thus is forbidden under Section 9(2) of the Indian Trademarks Act, 1999.

In the issue at hand, the appellant had applied for registration of the mark "Ramayan" with the device of a crown in relation to incense sticks and perfumeries. The Court held that "The word 'Ramayan' represents the title of a book written by Maharishi Valmiki and is considered a religious book of the Hindus. Thus, using exclusive name of the book



'Ramayan' as a trademark for any commodity cannot be permissible under the (Trade and Merchandise Marks) Act".

However, the court very specifically added that if there was a prefix or a suffix to the word Ramayan which was of the same "length of the word Ramayan then Ramayan may lose its significance as a religious book and it may be considered for registration as a trademark."

#### Mangalore Ganesh Beedi Works v. CIT

The Supreme Court of India held that intellectual property (specifically 'trademarks, copyrights and technical know-how') would come within the definition of 'plant' under the Income Tax Act, 1961.

The apex court ruled held that intellectual property (specifically 'trademarks, copyrights and technical know-how') would come within the definition of 'plant' under the Income Tax Act. The Court further observed that for the purposes of a large business, control over intellectual property rights such as brand name, trademark, etc., is absolutely necessary and that the acquisition of such rights and know-how is acquisition of a capital nature.

#### Havells India Ltd. Vs Eveready Industries India Limited

Havells India Limited, a billion dollar electrical equipment company, filed a suit for permanent injunction against its competitor Eveready Industries India Limited to restrain an advertisement which compared the 'Eveready LED Bulb' with the 'Havells LED Bulb' and stated: 'check lumens and price before you buy'. Application for an interim injunction was also filed. As per Havells, the advertisement at issue only invited a consumer to compare two attributes of a bulb - lumens and price - whereas there were several other parameters involved in judging the quality of LED bulbs. Such selective comparison, in its opinion, allowed Eveready to convey the misleading impression that it offered a customer better value for a lesser price.

On its part, Eveready claimed to have made only such comparative representations which could be derived from the product packaging of both entities. In fact, commonly mentioned information on all LED bulb packages (indeed several other brands were also mentioned in the advertisement at issue) was lumens and price, making the representation in its advertisement quite true and justified.

The High Court of Delhi dismissed Havell's application for an interim injunction. In its view, Eveready's advertising campaign was not misleading and there was no denigration of Havell's mark. Moreover, it found the factors compared in the advertisement to be relevant, verifiable and representative features of the products of both parties.

#### Mona Agarwal v Glossy Color & Paints

In a recent appeal in a trademark infringement dispute, the Delhi High Court has dealt with the issue whether the numeric trademark '6004' is an infringement of the numeric trademark '1001'. The Plaintiff/Respondent i.e. Glossy Color & Paints Pvt. Ltd adopted the trademark '1001' back in 1946, whereas the Defendant/Appellant adopted their trademark '6004' only in 2011, with both the parties dealing in paints, distemper and varnish.

The Court held that a trademark can be represented by numerals, however, use of numeral as a trademark by one party does not monopolize it in a way that another party cannot use a trademark of different numerals. In a situation what has to be seen is whether the mark taken as a whole i.e. combination of numeral, color scheme, get-up layout are



deceptively similar. The new proposed trademark of the appellant was found to be distinct from the label as used by the Respondent, hence would not amount to passing off or infringement of the registered label or trademark of the Respondent.

#### Assam Roofing Ltd. v JSB Cement LLP

In a suit for infringement and passing off filed before the Calcutta High Court by the Plaintiff, Assam Roofing Ltd., the Court granted an injunction against the Defendant's use of the mark 'RHINO' for cement goods. The plaintiff is engaged in the business of manufacturing galvanized iron sheets, asbestos, cement sheet and roofing accessories.

Referring to a plethora of judgements for substantiating its observation and in view of Plaintiff's first use of the mark in the market and other factors, the Court granted injunction to the Plaintiffs.

On the use of deceptively similar mark, the court ruled that if a word forming part of a mark has come into use in trade to identify the goods of the owner of the mark, then it is an infringement of the mark itself to use that word as the mark or part of the mark of another trader, simply as confusion is likely to result.

On the use of cognate/allied goods falling in similar class, the court held that the physical or chemical attributes of the goods were not relevant to determine whether the goods fall in the same class or would fall in the same description. The test in such cases has to be 'what is the trade channel through which the goods reach the consumer and which is the class of consumers purchasing the goods. The court further was of the view that although cement could be an ingredient for manufacturing of asbestos and cement sheet, the goods are not similar. However, both asbestos and cement were used for building purposes and were likely to be sold through the same trade channel.

#### DOMAIN NAMES

##### Info Edge India v. Rakesh Kalia

In the instant case, Info Edge (India) Ltd. (hereinafter referred to as "Plaintiff") had prayed to restrain Mr. Rakesh Kalia (hereinafter referred to as "Defendant") from infringing its trademark, passing off, unfair competition and infringement of copyright.

The Plaintiff claimed that over the years, the impugned portal had grown to be the country's leading job portal having, as on June 30, 2015, a database of about 42 million job seekers. That the word "NAUKRI" forms the most significant and distinctive part of the Plaintiff's subsidiary, Naukri Internet Services Private Limited, which was incorporated in the year 1999.

That the Defendant, who is an Indian national, had registered a deceptively similar domain name [www.naukrinews.com](http://www.naukrinews.com).

The Delhi High Court, in view of the submissions and averments made in the plaint alongwith the evidence placed on record, prima facie found that the Plaintiff was entitled to grant of an ex parte ad interim injunction. Thus the Court, till the next date of hearing, restrained the Defendant from using the marks NAUKRINEWS.COM, NAUKRINEWS.CO.IN, NAUKRINEWS.IN or any other mark comprising of the word, "NAUKRI" that is likely to deceive the public into believing that the Defendant's services are in some manner connected with the Plaintiff's registered trademark "NAUKRI" and/or job portal.



Hola, S.L. v Viraj Malik

The Complainant, Hola, S.L., is a company registered in Spain and a leading international publisher of magazines and periodicals. The Complainant filed a complaint with NIXI (National Internet Exchange of India) for recovery of the disputed domain name <hellotv.in> registered by the Respondent, as it incorporates the well-known and registered mark HELLO! of the Complainant.

In view of the facts and evidences presented before the Arbitrator, it was observed that the Complainant has applied for registration of the trade mark HELLOTV! and also has a domain registration and operating the website www.hellotv.com. The Arbitrator held that the disputed domain name <hellotv.in> is identical with and confusingly similar to the name and trade mark HELLO/ HELLOTV! of the Complainant.

The Arbitrator further held that the Respondent has not been commonly known by the domain name <hellotv.in> and is making commercial use of the disputed domain name which incorporates the trade mark of the Complainant. Therefore, the Respondent has no right or legitimate interest in the disputed domain name.

The Arbitrator while coming to a decision observed that the Respondent registered the domain name <hellotv.in> in the year 2009 subsequent to the registration of the trade mark of the Complainant in the United Kingdom and India in 1987. Further, no permission has been granted by the Complainant to the Respondent to use its trade mark HELLO! and register the domain name <hellotv.in>. Therefore, such un-authorized registration of the domain name by the Respondent is in bad faith.

In light of all of the above facts and circumstances in the matter, the Arbitrator allowed the complaint directing that the Respondent's domain name <hellotv.in> be transferred to the Complainant.

## DESIGN

Faber Castell v. Cello

In the present case, the Plaintiff filed a suit for infringement of design, copyright and passing off, etc., against the Defendant in the Bombay High Court. The Plaintiff alleged that the Defendant had infringed the three-sided crayon design and also attempted to pass-off them as being that of the Plaintiff.

The Plaintiff based its contentions with regard to the distinctiveness of its crayons, on the ground that, it had a novel and unique shape, i.e. trigonal, the packed product including 24 crayons and moreover the twin series of paralleled line of dots on each stem of the three sides on the crayons. The Plaintiff further stated that their crayons were unique with regard to its presentation, wherein two sunken plates are facing each other inside a bigger outer ampule.

The Court observed that from the view point of the target audience of a child or a harried parent, there was no distinction between the two products. The Court further stated, "that every single feature that has been used in a unique fashion by the Plaintiff in creating their products was replicated, down to the last millimetre, in Defendant's product."

Thus, the Court held that due to the Defendant's inability to prove functional uses for Plaintiff's pastel crayons, their design of crayons was the only conceivable design and that the products of the parties were confusingly similar. Accordingly, the Court granted an



injunction against Defendant, noting that if the Defendant's pastel crayons were to persist in the market, it would result in monetary loss to the Plaintiff.

*Midas Hygiene Ind Pvt. Ltd. v. Sudhir Bhatia*

In an appeal under Section 72 of the Copyrights Act before the High Court of Delhi against an order of the Copyright Board expunging the registered copyrights of the Appellant, the Court held that product packaging could not be protection under the Designs Act.

The Appellant (Midas Hygiene Industries) claims to be pioneers in insecticides and pesticides in the form of chalks in India. They obtained registration of the trademarks "Krazy Lines" and "Laxman Rekha" dating back to 1989 and a copyright registration of the packaging of products.

The Court restricted itself to the issue of design registration capability of the artistic work/labels used by the Appellant to market its products i.e. whether the Appellant's labels will be hit by Section 15(2) of the Copyright Act, 1957 and hence the copyrights vested therein will become invalid due to their reproduction more than 50 times?

The Court while coming to its decision observed that the Copyright Board had erroneously ignored the definition of "design" which excludes, inter alia, artistic works under the Copyright Act and labels as defined under the Trade Marks Act.

The Court further observed the subject work is a label. There is no express indication in the Design Rules that a label fixed or printed on a package becomes capable of design registration. The statutory definition of designs excludes "artistic work" and "labels used as trademarks". The label is both a trademark (indicating the source of goods) as well as a copyright (a combination of colours, stylized lettering and image of cockroach) and excluded from the definition of "designs". If every object based on a drawing were granted design registration, soon, objects of common utility - containers, furniture items, etc. could not be replicated.

A package design is essentially a promotion of the "trade dress" of the package, and may become a significant asset for market entrenchment and product valuation. Instances of some such product packaging synonymous with the article itself are TOBLERONE chocolate packaging, certain liquor bottle containers and packages; chocolate and cheese wrappers etc

In finality, the Court concluded that the finding of the Board that the Appellant's copyright registrations have to be cancelled or cannot stand, because they are capable of design registration and consequently covered by Section 15(2) of the Copyright Act, are untenable. With regard to whether the work could qualify for protection as an artistic work, matter remitted to the Board for fresh hearing of parties, and findings.

## COPY RIGHT

*Krishika Lulla & Ors. v/s Shyam Vithalrao Devkatta & Ors.*

The main issue was whether copyright could subsist in a title given to the synopsis of a story. Several precedents were analysed before pronouncing judgment including Delhi and Madras High Court decisions holding no copyright existed in film titles. But citing an 1881 English decision - *Dick v. Yates* - the Supreme Court did state that 'there might be copyright in a title as, for instance, a whole page of title or something of that kind requiring invention'. It also observed that 'if a well known title of a film is used without authority,



the owner's remedy is likely to lie in passing off' and that 'protection by registration as a trade mark may be available provided the title is sufficiently distinctive'.

## 2 CHANGES IN LAW AND PRACTICE AS WELL AS PROPOSED CHANGES

### Patents

Indian Patent Office published Revised Guidelines for Examination of Computer-related Inventions (CRIs) on February 19, 2016. Vide office order December 14, 2015, Controller of Patents put on hold the final guidelines for examination of CRIs, which were previously issued on August 21, 2015, due to objections from certain quarters.

We herein below highlight the changes which have been brought about in the revised guidelines on CRIs:

Positive examples illustrating cases which may not fall under category of "mathematical method" has been deleted.

A paragraph in the previous guidelines interpreting term "ancillary thereto" and "developed thereon" has been removed from the revised guidelines.

The part of guidelines dealing with "Determinants" has been deleted. The previous version of the guidelines specifically mentioned that "A novel computer programme with known hardware which goes beyond the normal interaction with such hardware and affects a change in the functionality and/or performance of the existing hardware", which stands deleted.

Instead, the revised guidelines mentions "If the contribution lies in the field of computer programme, check whether it is claimed in conjunction with a novel hardware and proceed to other steps to determine patentability with respect to the invention". The revised guidelines further mentions if the contribution lies in both the computer programme as well as hardware, proceed to other steps of patentability.

The previous version of the guidelines contained six indicators to determine technical advancement. The revised guidelines do not mention these six indicators.

There is a re-introduction of "means plus function" in the revised guidelines. The guidelines requires that "means" mentioned in the claims shall clearly be defined with the help of physical constructional features and their reference numerals to enhance the intelligibility of the claims. The claims in the means plus function form shall not be allowed if the structural features of those means are not disclosed in the specification.

The revised guidelines contain several negative illustrations as what is not patentable under Section 3(k) of the Patents Act, 1970 (as amended). However, no positive illustrations under Section 3(k) have been given.

In an effort to attain uniformity in accessibility and processing of patent applications by all Patent Offices in India, it has streamlined and standardised the numbering system for Patent Application and Request for Examination filled in Indian Patent Office. A new format of numbering has been implemented with effect from 1st January, 2016. On December 31, 2015 the Controller General of Patents unveiled a numbering format (YYYYJTNNNNN) to be followed from January 1, 2016 wherein the first 4 characters denote the year of filing, the numeral that follows indicates the patent office branch where an application is filed, followed by a numeral reflecting the type of application (ordinary, divisional etc.) and the last 6 characters representing an application's unique serial



number. In requests for examination, this numbering format is preceded by the characters 'R' or 'X' (where an express request for examination has been filed). Existing applications and requests for examination will also be renumbered to conform to the new format, but this exercise will have no ramifications on their current status or processing.

Indian Patent Office has published a new fees schedule as applicable with effect from January 1, 2016 for International Applications under the PCT

In November, 2015, the draft Patents (Amendments) Rules, 2015 were published by the Indian Patent Office.

Significant proposed amendments:

- Agents/ Applicants to mandatorily furnish their postal address for service in India along with their email ID and mobile number.
- Patent agents to submit documents only through electronic mode using their digital signatures.
- Only in the case of a natural calamity will the Indian Patent Office be obliged to condone the delay in filing of any document and that too, only upon providing of evidence of such calamity by the Applicant.
- No refund of excess fee paid. The fee paid for request for examination (RFE) may be refunded to the extent provided in the first schedule on an application made under sub-rule (1A) of rule 24B and consequently, such RFE shall be deemed to have not been filed.
- Introduction of Form-30 – to be used when no other forms are specified for any purpose.
- Withdrawal of RFE can be made through filing Form-29.
- The new draft Rule 24C provides for an expedited examination of applications meeting some conditions viz. if IPO has been designated as ISA and/or IPEA, or manufacturing of invention in India.
- The time for putting application in order for grant under Section 21 has been reduced to 4 months from the date on which first statement of examination issued which is extendable for a period of two months on request for extension in Form-4 along with prescribed official fees before the expiry of 4 months period.
- Controller has been obligated to dispose of the application within a period of 6 months from the date of receipt of the last reply to FER or within a period of 6 months from the last date to put the application in order for grant under Section 21 of the Act, whichever is earlier.
- By amending Rule 55(5) of the Patents Rules, 2003, opposition proceeding has been de-linked from the grant/rejection of the patent application. Now, a pre-grant opposition may be decided separately from the grant/rejection of the application.
- In case of a response to first examination report filed before the coming into force of these rules, the application needs to be disposed within 2 years of receipt of the said response.
- Process of recruitment of patent examiners on regular and contract basis is on.

Trademarks:

- In view of the pendency of Opposition/Rectification matters at Trade Mark Registry, Delhi, the office of Controller General of Patents, Designs & Trade Marks (CGPDTM) in collaboration with Delhi State Legal Service Authority (DSLISA) has undertaken to initiate a project to liquidate such pendency



through Mediation /Conciliation based on Mediation/Conciliation Rules framed under the Legal Services Authorities Act, 1987

- The CGPDTM provides Online Search Facility for Classification of Goods and Services for the purpose of Registration of Trademarks
- On November 9, 2015, Draft Trade Marks (Amendment) Rules, 2015 have been published for Public Comments

#### Significant proposed amendments:

- Major changes have been introduced in the formats of Forms for filing of trademark applications and various Forms required to be filed for all other trademark matters.
- A substantial increase in the official fees (approximately double in comparison to the existing official fees) has been proposed by the Indian Trademarks Registry.
- The term, “graphical representation” now includes “represented or capable of being represented in paper form or in digitized form”. A new provision with respect to submission of a sound mark in MP3 format, not exceeding a length of 30 seconds, clearly audible and accompanied with a graphical representation of its notations has been introduced.
- The definition of “publish”, meaning publication in the Trademarks Journal, has been broadened to include within its ambit availability of information on the official website of CGPDTM also.
- A strict requirement regarding trademark applications claiming user date prior to the filing date has been introduced wherein, the Applicant shall have to file an Affidavit testifying to such use along with supporting documents.
- A new provision namely “Expedited processing of Application” has been introduced which includes the existing provision of Expedited examination along with the expeditious processing of the application till the final disposal of the same, upon payment of five times the fees of the application fees.
- The proposed Draft Rules expressly provide for filing of the counter statement upon the online availability of the Notice of Opposition in contrast to the existing provision to file the counterstatement within two months from the date of receipt of the same in physical.
- As per the draft Rules, a right holder will be able to make a request to the Registrar of Trade Marks to determine a trademark as a “well-known” mark. The request will need to be supported with a statement of case and evidence.
- An official communication sent via email by the Registrar will amount to the applicant being served with such document; so long as the email is sent to the email address provided by the applicant/agent.
- Process of recruitment of Trademark Examiners for Indian Trademark Registry is on.
- On December 7, 2015, India joined ‘TMclass’. When applying to register a trade mark, applicants need to describe the goods and/or services for which trade mark protection is sought. TMclass is a free online tool which aids applicants in searching, translating and classifying goods and services according to terms that appear in the classification databases of each of the offices participating in the TMclass initiative.
- In a notice dated February 19, 2016, the Registrar of Trade Marks announced a project aimed at liquidating the large opposition backlog – currently tens of thousands of opposition matters remain pending before the Registry. A list of 500 oppositions has been chosen as the ‘pilot batch’ and interested parties



asked to give their consent for mediation of their opposition matters before the Delhi State Legal Service Authority (DSLISA).

### Design

- There has been augmentation of manpower as well as streamlining of procedure in the Design Wing of Indian Patent Office which will result in speedier disposal of the design application.
- CGPDTM has issued a clarification regarding Section 5(3) of the Designs Act, 2002 on August 20, 2015. Indian Design Office has clarified that an application under Section 5 of the Act for registration of Design can be made for any one or all the articles in that particular class, irrespective of the sub-class therein. It was further clarified to register the same design in more than one class of article, a separate application shall be made in each class of article and the application shall contain the number or numbers of the registration or registrations already effected.
- The CGPDTM announces that the Designs wing of Indian Patent Office has been awarded the ISO 9001: 2008 on 13/04/2015 with certificate no. FM634081 by BSI India for the protection and maintenance of Industrial Design through Registration relating to article of manufacture & any substance under the provisions of The Designs Act, 2000.

### General:

- Mr. O.P. Gupta took charge as new Controller General of Patents, Designs and Trade Marks (CGPTDM) on November 16, 2015.
- The Ministry for Commerce and Industry to approach the Union Cabinet to seek its nod for the national Intellectual Property Right (IPR) policy. A government-appointed think-tank on IPR has prepared the draft policy, which seeks to encourage innovation by providing tax incentives and modifying intellectual property rights.
- The Government of India launched "Scheme for Facilitating Start-UPS Intellectual Property Protection (SIPP)" to promote awareness and encourage IPR protection amongst Start-Ups
- The Office of the CGPDTM strides to the next level of knowledge dissemination by launching a Twitter service for the stakeholders. You can reach us on @IPO\_India or @IndianIPOor @CGPDTM
- The CGPDTM announced that the Geographical Indications Registry, Chennai has been awarded the ISO 9001: 2008 on March 12, 2015 with certificate no. FS 633537 by BSI India as the Registry operates a quality management system which complies with the requirements of ISO 9001: 2008 for Registration and better protection of Geographical Indications of relating to goods.
- Indian Finance Minister (FM) in his 2016 budget speech introduced a special patent regime with 10 per cent rate of tax on income from worldwide exploitation of patents developed and registered in India in order to encourage indigenous research & development (R&D) activities in India.
- Accordingly, now where the total income of the eligible assessee income includes any income by way of royalty in respect of a patent developed and registered in India, then such royalty shall be taxable at the rate of ten per cent (plus applicable surcharge and cess) on the gross amount of royalty. It is believed that such assesseees will not be charged higher income tax or corporate tax on such income by way royalty. However, there is considerable ambiguity regarding the definition of eligible assessee. To quote the relevant text:



- "For the purpose of this concessional tax regime an eligible assessee means a person resident in India, who is the true and first inventor of the invention and whose name is entered on the patent register as the patentee in accordance with Patents Act, 1970 and includes every such person, being the true and the first inventor of the invention, where more than one person is registered as patentee under Patents Act, 1970 in respect of that patent."
- From the above quoted text, it appears that concessional tax regime is applicable only to true and first inventor who is resident of India. It is not clear whether in case of assignment of rights from the true and first inventor to a legal entity, which has been entered as patentee in the patent register, shall also be eligible for such a concession.
- The Department of Industrial Policy and Promotion (DIPP), a department under Ministry of Commerce and Industry, Government of India, has prepared –Discussion paper on Standard Essential Patents and their availability on FRAND terms, with the objective of inviting views and suggestions from the public at large to develop a suitable policy framework to define the obligations of Essential Patent holders and their licensees. This paper aims to sensitize the stakeholders, concerned organization and citizens towards need and importance of regulating SEPs as well as facilitating their availability at Fair, Reasonable and Non-Discriminatory (FRAND) terms.
- DIPP invites views from the concerned stakeholders regarding issues concerning adequacy of existing legislation to address the issues relates to SEPs, and their availability on FRAND terms; IPR policy of Indian Standard Setting Organizations in developing Standards; need of guidelines on working and operation of Standard Setting Organizations by Government of India; basis for deciding the royalty rates in SEPs; capping of royalty payment etc.
- An important news from the perspective of IP litigation is the passing of Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts Act, 2015 (the "Act"). The Act provides for setting up of Commercial Divisions in high courts already exercising ordinary original civil jurisdiction such as Delhi, Bombay, Calcutta, Madras and Himachal Pradesh high courts, and Commercial Courts at District level where the high courts don't have original civil jurisdiction, to deal with commercial disputes of a specified value, such value being not less than Rs.1,00,00,000. IPR disputes come within the definition of commercial disputes as provided in the Act. All appeals from the orders of the Commercial Court/Commercial Division would lie before the Commercial Appellate Divisions to be set-up in all High Courts.
- In a recent case of Guinness World Record and Ors v. Sababbi and Ors, a single judge of Delhi High Court has ruled that cases pertaining to Trade Marks Act, 1999, Copyright Act, 1957, Designs Act, 2000, Patents Act, 1970 and Geographical Indication of Goods (Registration And Protection) Act, 1999, pending before the High Court will continue to be heard by the High Court irrespective of value, despite the coming into effect of the Commercial Courts Act. To provide a brief context, a challenge was presented to the order of Delhi High Court transferring all IPR matters worth less than Rs. 1 Crore to relevant District Courts. In the challenge, it was submitted that said direction of the High Court was in direct contravention with the proviso of Section 7 of the then Commercial Courts Ordinance which provided that all suits and applications relating to a commercial dispute filed before a High Court of original jurisdiction shall be heard and disposed by the Commercial Division of said High Court. Upon passing of the said Ordinance, only one addition was made to said proviso, i.e., the phrase "or pending" was added therein. The Court, analyzing the intention of legislature



behind the addition of phrase “or pending”, held that any pending suit or application relating to a commercial dispute shall be heard by the Commercial Division of High Court having original civil jurisdiction, irrespective of value.

## JAPAN

Yoshikazu Tani and Takeshi Aoki

### 1 Patents

- (1) The new post-grant opposition system came into force on April 1, 2015 (Articles 113...120-8).

Note: The JPO announced that 405 oppositions in total had been filed until January 12, 2016.

- (2) The amendments of the Patent Law to (i) modify the system of the right to obtain a patent for an employee's invention (Article 35); (ii) reduce application/annual fees (Article 107); and (iii) introduce the procedural matters for the patent practice in accordance with PLT provisions (Articles 5, 36-2, 38-2..38-4, 43, etc.) were promulgated on July 10, 2015 and will come into force within one year from its promulgation.

Note: The above amendment (iii) will provide overseas applicants more user friendliness in prosecuting patent applications before the JPO.

- (3) Supreme Court rendered two decisions on Claim Construction of Product-by-Process Claim (Pravastatin Sodium case, Heisei 24 (Ju) 1204 and Heisei 24 (Ju) 2658, judged on June 5, 2015).

The main holding by the Supreme Court is as follows:

- (i) A Product-by-Process claim shall be construed as product per se; and
  - (ii) A Product-by-Process claim satisfies the clarity requirement only when the product was “impossible” or “extremely impractical” to be defined by its structure or properties as of the filing date.
- (4) JPO revised Examination Guidelines for Patent and Utility Model and Examination Handbook for Patent and Utility Model to clearly and logically explain examination practices and procedures and provide ample case examples and court precedents. The Examination Guidelines and the Examination Handbook are effective on and after October 1, 2015 and available both in Japanese and English from the JPO website.

### 2 Trademark

Under the revised Trademark Law which came into effect on April 1, 2015, sound, moving, hologram, color and position marks are protectable.

Note: Up to March 4, 2016, 1168 non-traditional marks were filed and 51 marks were registered as follows:

Non-Traditional Marks Registrations	Number of Applications	Number of
-------------------------------------	------------------------	-----------



1	Sound	368	23
2	Moving	81	22
3	Hologram	14	1
4	Color	455	0
5	Position	250	5
	Total	1,168	51

### 3 Design

Japan joined the Geneva Act of Hague Agreement Concerning the International Registration of Industrial Designs on May 13, 2016.

An International Design Application having multiple designs is not deemed to be rejected in the JPO, while the Japanese Design Law maintains a "Single design per Application" system. Each design will be treated as separate Japanese applications in the JPO.

Note: Up to December 31, 2015, 1,226 designs designating Japan were filed and Japanese filed with WIPO 381 designs under the Geneva Act.

### 4 Perfection of Geographical Indication

The Act for Protection of Names of Designated Agricultural, Forestry and Fishery Products and Foodstuffs (Geographical Indication (GI) Act) entered into force on June 1, 2015.

If a GI registration has been obtained, the following GI mark can be used:



The above GI mark was filed worldwide.

Note: Up to February 2, 2016, 10 GIs, including Kobe Beef, Yubari Melon and others were registered.

### 5 Unfair Competition Prevention Law

The revised Unfair Competition Prevention Law to enhance the protection of trade secrets (criminal penalty, etc.) entered into force on January 1, 2016.

### 6 Copyright

TRIPP TRAPP case, Heisei 26 (Ne) 10063, judged on April 14, 2015 by IP High Court

The case relates to copyrightability of the TRIPP TRAPP children's chair (see the figure) for a practical use, which is considered as a "work of applied art". Copyright Law does not



have any explicit provisions concerning copyright protection for applied arts, although works of applied art can be protected under Design Law.

The IP High Court held that the TRIPP TRAPP chair can be protected as an "artistic work" under Copyright Law as long as it satisfies the copyrightability criteria, that is creativity of expression, described in the Article 2 (1) (i).

## MEXICO

Mariano Soní

None

## NEW ZEALAND

Jim Piper, Delegate

Gallagher Group Ltd v Robertson Engineering Ltd – 2015 NZHC 1321 – Designs, Infringement, Temporary Interim Injunction.

Burden v ESR Group (NZ) Ltd – 2015 NZHC 1649 – Copyright, Customs Detention, Interlocutory Application for Release Refused.

Chief Executive of MBIE v Swastik Solution Ltd – 2015 NZHC 1913 – Fair Trading, Copyright, Domain Name, Misleading and Deceptive, Extra-Territorial, Interim Injunction Allowed.

Daimler AG v Sany Group Co Ltd – 2015 NZCA 418 – Trade Marks, Opposition, Device Mark, Insufficient Visual Similarity.

Probus South Pacific Ltd v Probus NZ Inc – 2015 NZHC 2250 – Trade Marks, Incorporated Societies, Deceptive or Undesirable Names Ordered Changed

Eight Mile Style LLC v New Zealand National Party – 2015 NZHC 2409 – Copyright, Procedure, Joinder, Jurisdiction, New Zealand Appropriate Forum for Trial.

Crocodile International Pte Ltd v Lacoste – 2015 NZHC 2432 – Trade Marks, Copyright in Logo, Would Use Infringe, Acquiescence, Delay.

Assa Abloy NZ Ltd v Allegion (NZ) Ltd – 2015 NZHC 2760 – Patents, Procedure, Discovery, Proportionality of Effort.

Hoyle v Hoyle – 2015 NZHC 3001 – Copyright, Discovery, Privilege.

Tasman Insulation New Zealand Ltd v Knauf Insulation Ltd – 2015 NZCA 602 – Trade Marks, Infringement, Fair Use, Use as a Trade Mark, Genericism, Fair Trading, Misrepresentation.

Hoyle v Hoyle – 2015 NZHC 3282 – Patents, Jurisdiction to Revoke.

Peterson v Lucas – 2015 NZCA 627 – Designs, Relitigation Attempt, Abuse of Process.



The agricultural compounds and veterinary medicines amendment bill 2015 will extend the maximum term of protection for confidential information relating to innovative registered product formulations from 5-years to 8-years after registration. The additional 3-year term can only be obtained via 1-year increments for each new use authorised as a result of successful variation applications. The bill will also create protection for confidential information relating to non-innovative product formulations. These will have a term of up to 3-years from the date of registration, although likewise an additional 3-year term can be obtained in 1-year increments for each new use authorised as a result of a successful variation application.

The copyright (infringing file sharing and cellular mobile networks) order 2015 repealed section 122s(2) of the copyright act 1994 from 30th September 2015. This has the effect of making the exemption for internet protocol address provider's obligations in respect to alleged infringements occurring over cellular mobile networks open-ended.

In October 2015 MBIE commenced a study to gain a better understanding of the creative sector and how it interacts with the copyright and designs regimes. The study will culminate in a series of reports to be issued in late 2016 looking at how the copyright and designs regimes are used by the various creative industry subsectors in a changing technological landscape.

New Zealand's membership of the recently signed trans-pacific partnership agreement will require the following amendments to its intellectual property legislation:

- Copyright terms change from 50-years to 70-years.
- Accession to the wipo copyright treaty and the wipo performances and phonograms treaty.
- Allowing only narrow exceptions to the circumvention of technological protection measures.
- Reintroducing extension of term provisions for unreasonable delays in patent examination or getting regulatory approval for pharmaceutical patents.

Within three years of the date of entry into force of this agreement for New Zealand either accede to upov 1991 or adopt a sui generis plant variety rights system that gives effect to upov 1991. New Zealand can also adopt measures to protect indigenous plant species.

New Zealand has exempted patent attorney services from the cross border provision of services provisions of the tpp agreement, which guarantee market access and non-discriminatory treatment.

The patents (Trans-Tasman patent attorneys and other matters) amendment bill 2015 will:

- Allow for a single patent application process and a single examination process for Australian and New Zealand patent applications – such applications being examined according to the law in each country.
- Establish a joint registration regime with Australia for patent attorneys, along with a Trans-Tasman disciplinary board.
- Remedy a drafting error in the patents act 2013, which currently allows applications to be opposed with a unity of invention objection despite such a ground being ruled out as a ground of revocation.

The geographical indications (wine and spirits) registration amendment bill 2015 will amend the non-commenced geographical indications (wine and spirits) registration act



2006, and specifies that any provisions of the main act that are not in force by 18th July 2018 will commence on that date.

The bill deems 'New Zealand', 'North Island', and 'South Island' to be enduring geographical indications. Other geographical indications will be subject to a 10-year term, renewable for further 10-year terms. Provisions will also allow the registrar to refuse registration of geographical indications that are likely to be offensive.

Divisional patent applications need to be made before acceptance of the parent application. Where the parent application was filed under the patents act 2013 the maximum time limit for filing a request for examination of a divisional application is the earlier of 5-years from when its complete specification is filed or is treated as having been filed. In effect, this restricts the filing of divisional applications to 5-years from the filing date of the original parent complete specification. Submissions will be made requesting amendment to this policy in order to increase the timeframe in which divisional applications can be filed.

Following the select committee's report on the smoke-free environments (tobacco plain packaging) amendment bill 2013 in august 2014 the bill was left in limbo pending the outcome of the WTO's ruling on the legality of Australia's law on the plain packaging of tobacco products.

In late 2015 the WTO ruled in favour of Australia and in mid-February 2016 it was signalled that the bill is likely to be passed before the end of this year.

## NORWAY

Kristina Edén Johnsen

- 1 Legislation on possibility to mortgage patent rights has entered into force.
- 2 The entry into force of the European Union Trademark Regulations open for Norwegian attorneys to represent directly in trademark applications with The EUIPO. Applicants domiciled in Norway have earlier been obliged to file EU-applications through an attorney within the European Union.

## PERU

FRANCISCO ESPINOSA BELLIDO / FERNANDO BARREDA ZEGARRA

- 1 Changes in the specific legal requirements for accepting trademark coexistence agreements
- 2 Changes to the IP software used by the Peruvian IP authorities (INDECOPI) have been introduced which are affecting our work (mostly in a negative way)

## POLAND

Marek Łazewski, Jakub Siewewiesiuk, Piotr Godlewski

- 1 Legal practitioners (attorneys at law, advocates) were allowed to practise before the Polish patent office in trademarks and designs matters.



- 2 Compulsory representation before the Polish patent office was liberalized or – for some activities – lifted for applicants from the EU.
- 3 Trademark applications will be handled in a registration procedure rather than examination procedure (effective April 15, 2016).

## PORTUGAL

João Jorge / João Pereira da Cruz

The Portuguese PTMO following CJEU Dec. C-471/14 decided to adopt the date of notification of the first MA in the computation for the duration of an SPC, only when the MA is a centralized MA (obtained near EMA and published in the OJEU). So a different method is used when the basis for the SPC can be found in a first centralized MA or any other first MA (decentralized, mutual recognition or national boards).

## ROMANIA

Margareta Oproiu

The PTO used to release internal Instructions on several matters, as for example for examination of national trademark applications, introducing additional requirements. Following the meeting with the IP professional, the PTO cancelled that internal rule<sup>2</sup>. The PTO used an internal Instruction in respect to the examination of the SPC application, contrary to the EU regulations. Following the recent meeting with the PTO officials, such internal rule was cancelled.

## POLAND

Marek Łazewski, Jakub Sielewiesiuk, Piotr Godlewski

- 1 Legal practitioners (attorneys at law, advocates) were allowed to practise before the Polish patent office in trademarks and designs matters.
- 2 Compulsory representation before the Polish patent office was liberalized or – for some activities – lifted for applicants from the EU.
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## RUSSIA

Valery Medvedev

- 1 In its Ruling No. 310-ЭC15-2555 of January 20, 2016, the Russian Supreme Court indicated that if a court establishes that a plaintiff (a trademark owner) in a trademark infringement lawsuit has not registered a trademark for the purpose of using it, but only for the purpose of preventing other businesses from using it, such registration may be considered as a bad faith resulting in dismissal of the lawsuit. The conclusion has been reached in a case where a local company that did not use a trademark for 15 years sued an ice-cream manufacturer.
- 2 In its Ruling No. 2и-468/2015 of November 12, 2015, the Moscow City Court issued one of the first preliminary injunction rulings under the new anti-piracy law for the protection



of computer video-games. The relevant motion was brought by Ubisoft Entertainment S.A. against the local web-site owner (case No. 3-0866/2015).

- 3 On March 2, 2016 President of Russia signed a Federal Law No. 47-FZ On Amendments to the Commercial Procedure Code. The Law, in particular, provides for a mandatory pre-court dispute settlement procedure for all civil law disputes. According to the new procedure, a court will not consider the claim unless the parties have previously taken measures to pre-court settlement of the dispute. Only 30 days after sending a warning letter to the counterparty the aggrieved party may submit a claim to a commercial court. This rule applies to all civil law disputes except of cases on the establishment of legal facts, compensation for red tape, bankruptcy, corporate disputes, protecting the rights of a group of individuals, on early termination of legal protection of trademark and challenging the decisions of the commercial courts.
- 4 Upon the Russian Patent Office's initiative, in 2014-2015, a utility model (UM) protection system was drastically changed so that obtaining a UM patent in Russia became practically unreasonable. In particular, a UM validity term was reduced, a mandatory substantive examination of a UM application was prescribed, and a possibility of changing a UM application was heavily restricted. Moreover, in 2016, the new Office's Rules on Consideration of Utility Model Applications came into force, according to which only those devices can be protected by UM which do not contain any components or consist of parts physically connected to each other.

## SWEDEN

Lars Thyresson

None

## SINGAPORE

Pei Lin Low

### (1) PATENTS

#### Closing the foreign route to patent applications

Currently, it is possible to obtain a patent in Singapore by filing a supplementary examination request, and simply relying on the search and examination report issued by selected foreign IP offices ("foreign route"). In other words, if an applicant selects the foreign route, no separate substantive search or examination need be requested with the IPOS. With a view to enhancing the quality of patents granted in Singapore, the IPOS intends to close the foreign route for Singapore patent applications and require that substantive examination be requested with the IPOS for all Singapore applications. These changes will be implemented no earlier than 1 January 2017 and will entail amendments to the Patents Act and Patents Rules.

It is proposed that applications with a filing date or lodgement date before 1 January 2017 may continue using the foreign route; international applications filed under the Patent Cooperation Treaty with an international filing date before 1 January 2017 will also be eligible to proceed under the foreign route in Singapore even if the national phase of the application in Singapore is after 1 January 2017.



### New supplementary examination fee

With effect from at least 1 January 2017, the IPOS will introduce a fee of S\$400 for supplementary examination requests (i.e. applications still going under the foreign route) filed on or after 1 January 2017. The fee will be increased annually over a few years. The IPOS is reviewing its fees on examination and other patent-related fees, and will update again. In view of this, if the foreign route is desired for any specific application, it will be prudent for Singapore applications to be filed and the foreign route selected, well before 1 January 2017.

### Singapore begins operations as ASEAN's first International Patent Search and Examination Authority

With effect from 1 September 2015, Singapore begins operations as ASEAN's first and Asia's fifth International Patent Search and Examination Authority under the Patent Cooperation Treaty ("PCT"). This allows local and global businesses and inventors who would like to seek patent protection under the PCT international patent filing system to fast track their applications for patent protection in multiple markets via Singapore with the Intellectual Property Office of Singapore (the "IPOS") as their International Searching Authority ("ISA") and International Preliminary Examining Authority ("IPEA").

The IPOS announced this development on 31 August 2015. The IPOS also announced that patent applicants to Vietnam, Mexico, Brunei, Japan and Laos will be the first to gain access to the IPOS' new services as an ISA and IPEA in the coming months.

The PCT is administered by the World Intellectual Property Organization ("WIPO") and enables businesses and inventors to seek patent protection in 148 countries through a single international patent application. There are currently 19 IP offices across the world appointed to act as ISAs and IPEAs. In Asia, there are five appointed IP offices, the other four being China, India, Japan and South Korea.

### IPOS appointed as competent ISA and IPEA by US and Indonesia IP offices

The United States Patent and Trademark Office ("USPTO") and the Directorate General of Intellectual Property of Indonesia have recently appointed the Intellectual Property Office of Singapore ("IPOS") as a competent International Searching Authority ("ISA") and International Preliminary Examining Authority ("IPEA") for patent applications entering their respective markets under the Patent Cooperation Treaty ("PCT"). This development took place at the sidelines of the 55th World Intellectual Property Organization General Assembly in Geneva, Switzerland.

US and Indonesia join a growing list of markets comprising, among others, Vietnam, Mexico, Brunei, Japan and Laos, that have appointed IPOS as an ISA and IPEA. With the appointments, applicants in these countries may select IPOS as ISA and IPEA to conduct the international search and international preliminary examination (if required). Innovators in Singapore and Singapore-based technology companies who seek patent protection under the PCT international patent filing system will now have cost-efficient access to the patent systems in the US and Indonesia and the other markets.

By filing a PCT application through IPOS as the receiving office, and selecting Singapore as an ISA and IPEA, PCT applicants will enjoy rebates of up to 75% on PCT filing fees. IPOS also offers the Supplementary International Search ("SIS") services under the PCT. IPOS is the first SIS authority to carry out searches in Chinese.



The above new service is in addition to the Patent Prosecution Highways offered by Singapore that expedite patent applications to over 30 countries, including key economies such as Europe, China, Japan, Korea and ASEAN, as well as the ASEAN Patent Examination Cooperation (ASPEC), which expedites applications within ASEAN.

By way of background, Singapore commenced operations as ASEAN's first and Asia's fifth International Patent Search and Examination Authority under the PCT on 1 September 2015. This allows local and global businesses and inventors who would like to seek patent protection under the PCT international patent filing system to fast track their applications for patent protection in multiple markets via Singapore with IPOS as their ISA and IPEA.

#### Singapore and Thailand sign Memorandum of Cooperation on patent protection

The Intellectual Property Office of Singapore ("IPOS") announced the signing of a Memorandum of Cooperation ("MOC") between IPOS and the Department of Intellectual Property (DIP), Ministry of Commerce (Thailand). This development means that businesses and innovators from Singapore and Thailand can now utilise Singapore's new search and examination services to file for patent protection under the Patent Cooperation Treaty ("PCT") that is administered by the World Intellectual Property Organization ("WIPO").

With the signing, Thailand joins Brunei, Indonesia, Laos and Vietnam in recognising IPOS as an International Searching Authority and International Preliminary Examination Authority under the PCT. Other global economies appointing Singapore include USA, Japan and Mexico.

#### Patent Case Law - Singapore High Court dismisses application to amend patent

Ship's Equipment Centre Bremen GmbH v Fuji Trading (Singapore) Pte Ltd & Ors and another suit [2015] SGHC 159

The Singapore High Court in *Ship's Equipment Centre Bremen GmbH v Fuji Trading (Singapore) Pte Ltd & Ors* exercised its discretion under section 83(1) of the Patents Act ("Act") to refuse the plaintiff's application to amend its patent as there had been undue delay on the part of the plaintiff in applying for amendment despite having reasonable grounds to believe that the patent might be anticipated by prior art. The undue delay was aggravated by the fact that the plaintiff had sought to obtain unfair advantage from the patent.

The plaintiff was the proprietor of two Singapore patents for a coupling device used to secure shipping containers, commonly known as a twistlock. The plaintiff had commenced proceedings against two sets of defendants for alleged infringement of the Singapore patents. The defendants denied any infringement and counterclaimed, seeking to invalidate the patents for lack of novelty.

The plaintiff subsequently applied under section 83(1) of the Act for leave to amend the claims of one of the patents ("370 Patent"). The 370 Patent had been obtained based on a patent application under the Patent Cooperation Treaty ("PCT") and the plaintiff had also filed and obtained a European patent based on the same PCT patent application ("European Patent").

The plaintiff stated that it was amending the 370 Patent to correspond to the allowed claims of the European Patent, which had been amended in the course of opposition proceedings before the European Patent Office ("EPO"). The plaintiff's proposed



amendments to the 370 Patent were identical to the amendments to the European Patent, which had been allowed by the EPO (“proposed amendments”).

## (2) REGISTERED DESIGNS

MinLaw and IPOS complete review of Singapore’s registered designs regime

The Ministry of Law (“MinLaw”) and the Intellectual Property Office of Singapore (“IPOS”) have completed their joint review of Singapore’s registered designs regime. Both parties have jointly issued a “Final Report on the Review of Singapore’s Registered Designs Regime” (“Final Report”) which sets out the full recommendations of the review.

The review recommendations aim to enhance the existing registered designs regime to better support Singapore’s economic and design initiatives. There will not be a significant overhaul of Singapore’s registered designs regime. The main changes to the Registered Designs Act include:

- Broader scope of design protection: The definition of “design” will be amended to include virtual or projected designs, the design of artisanal or handcrafted items and colours as a design feature. However, experiential designs will not be protected.
- Designer of a design will be the owner by default: The designer will be the owner by default instead of the person who commissioned the designer to create the design, but both parties are free to contract otherwise.
- Extension and broadening of grace period: The grace period within which designers must file a design application after first disclosure of their design will be extended from the current six months to 12 months. A longer grace period allows designers to test their design in the market prior to registration without losing their right to acquire design protection. The current requirement for disclosures to be made at select international exhibitions will be removed.

The review had the object of supporting modern business practices, providing business certainty and ensuring that Singapore’s design protection regime is cost effective. To this end, the review reached 20 conclusions (set out in the final part of the Final Report). Some key conclusions include:

- The policy position to maintain the current minimal overlap between design protection and copyright protection is reaffirmed. The designs of useful articles/products, i.e. articles/products having an intrinsic utilitarian function other than to carry the design, are more appropriately protected under the registered designs regime. However, protection should be via copyright where the article or product has no intrinsic utilitarian function other than to carry the design.
- A utility model protection will not be introduced.
- Substantive examination for design applications prior to registration will not be introduced.
- Dynamic designs can be registered if they are capable of being represented clearly and without subjectivity on a static medium, and capable of being represented through a series of freeze-frames of the dynamic design.
- The current 15-year term of protection for registered designs, comprising an initial 5-year term of protection and the 5-year renewal block structure will be maintained.



According to the Final Report, there will be more outreach and information sessions, in partnership with industry associations. Guidance notes will be provided on specific areas relating to the registered designs regime, especially in the area of infringement, to increase public awareness of acts that would constitute design infringement and to help increase certainty in this area.

By way of background, the designs review commenced in 2014 and included two rounds of public consultations - one from May to June 2014, and another from October to December 2015. There were also numerous focus group discussions and one-to-one consultations, including with industry and design associations, businesses, intellectual property practitioners, and academics.

### (3) TRADE MARKS

#### Trade mark cooperation between Singapore and China

The Intellectual Property Office of Singapore (“IPOS”) and the State Administration for Industry and Commerce (“SAIC”) of the People’s Republic of China have signed a Memorandum of Understanding (“MOU”) on trade mark cooperation that will enhance exchanges between the two countries on trade mark registration, examination practices, protection and enforcement.

The MOU will facilitate the two IP offices in:

- Exchanging information and best practices on trade mark registration and protection;
- Developing capacity-building activities, e.g. training on the examination of trade marks, oppositions and dispute resolution proceedings;
- Exchanges between IP officials and experts;
- Conducting joint activities such as conferences on trade mark developments; and
- Collaborating in educating IP rights holders in both countries on trade mark protection and enforcement.

#### Request for reconsideration of trade mark examination reports

According to Trade Mark Circular No 8/2015 on “Request for Reconsideration of Examination Reports” which was issued on 13 October 2015, an applicant may ask the Registry of Trade Marks (“Registry”) of the Intellectual Property Office of Singapore (“IPOS”) to reconsider objections raised in the examination report. The applicant must make the request via e-mail in accordance with a prescribed format, failing which the Registry will not entertain the request.

When the request is received, the Registry will ask a fresh panel of experienced examiners to review the examination decision.

The Registry will only consider a request for reconsideration after the second examination report has been received by the applicant. A final refusal will be issued against the trade mark application where the Registry’s decision is to maintain the objections raised in the examination report. A final refusal does not preclude applicants from applying for a hearing on Form HC 4 to make further representations.



### IP cooperation between UK and Singapore

The Intellectual Property Office of Singapore (“IPOS”) announced closer IP cooperation between the UK and Singapore and enhanced UK-ASEAN trade relations following a new agreement on IP signed in September 2015. The new Memorandum of Understanding between the UK Intellectual Property Office and IPOS will improve international cooperation between the two IP offices on issues relating to copyright, patents, trade mark and design, and allow the two countries to share best practices in areas such as IP rights protection, IP-related research and the streamlining of IP court processes.

## SPAIN

Luis-Alfonso Durán

- 1 New Patent Law that will be in force April 1st, 2017
- 2 New Directive for harmonization of Trade Marks in the EU
- 3 New Regulation on the EU Trade Mark

## SOUTH AFRICA

Bastiaan Koster / Mark Kemp

- 1 Government has announced that substantive patent examination will be introduced. 18 Examiners have been employed so far. They are currently being trained at foreign patent offices.
- 2 For many years it has been the intention of South Africa to join the Madrid Agreement. Indications are that South Africa will join in 2017/18.

## SOUTH KOREA

Insil LEE

- 1 Revision of the Patent Act and the Utility Model Act (Enforcement as of July 29, 2015) - Loosen the requirements for claiming exception of loss of novelty
- 2 Revision of the Trademark Act (Enforcement as of September 1, 2016) - Entire revision including the definition of Trademark
- 3 Revision of the Patent Act and the Utility Model Act (Enforcement as of March 1, 2017) - Ex officio amendment or re-examination / Shorten the period of a request of examination

## TURKEY

Selin Sinem Erciyas

- 1 There is a draft IP Law in Turkey, shared for public opinions on 24 February 2016. The draft law rules on all IP rights in a single book. In overall it improves the protection of the IP rights in Turkey. Especially the provisions related with patent rights are mostly in line with EPC. Important to note that the draft law introduces a post-grant opposition system, similarly to EPC’s system. The draft law is expected to be enacted in 2016.



## UNITED KINGDOM

Simon Rees

- 1 A draft Statutory Instrument for enabling the UK to implement the Unitary Patent and Unified Patent Court has been passed by the House of Commons on 1 March 2016 and the House of Lords on 2 March 2016 - The Patents (European Patent with Unitary Effect and Unified Patent Court) Order 2016
- 2 No other substantive law changes specific to UK since the last ExCo
- 3 Rule changes planned later in 2016 - consultation now open at: [www.gov.uk/government/consultations/proposed-changes-to-the-patents-rules](http://www.gov.uk/government/consultations/proposed-changes-to-the-patents-rules)
- 4 Supreme Court decision of 9 March 2016 on Registered Designs, the “Trunki” case [PMS International Group Plc (Respondent) v Magmatic Limited (Appellant)] - important implications on how to represent drawings in design applications - judgement can be found at: <https://www.supremecourt.uk/cases/uksc-2014-0147.html>

## USA

Andrew D. Meikle

- 1 An alleged infringement defendant’s belief regarding patent validity is not a defense to a claim of induced infringement under 35 U.S.C. 271(b), the Supreme Court held May 26, 2015, as a matter of first impression. *Commil USA, LLC v. Cisco Systems, Inc.*, U.S., 114 USPQ2d 1577 (U.S. 2015).
- 2 The U.S. Patent and Trademark Office (USPTO) on July 30, 2015, published an update to its examiner guidelines on patent subject matter eligibility. 80 Fed. Reg. 45429, 7/30/2015. Also included are appendices providing examples, an index of examples, and a hyperlinked list of court decisions on patent subject matter eligibility. Responding to public comment on the 2014 Interim Guidance on Subject Matter Eligibility Guidance, the update provides, among other things, (1) examples of claims directed to abstract ideas, (2) further explanation of the “markedly different analysis,” (3) further information on how examiners identify abstract ideas, (4) discussion of the prima facie case and the role of evidence, (5) information on examiner use of the prior guidelines, and (6) an explanation of the role of preemption and the streamlined analysis.
- 3 Regarding divided infringement of a method patent claim, the en banc Federal Circuit on August 13, 2015, held that under Section 271(a) direct infringement of a method claim was established for a defendant that did not perform all of the method steps because the performance of the last step by the defendant’s customers was attributable to the defendant. *Akamai Technologies, Inc. v. Limelight Networks, Inc.*, 116 USPQ2d 1344 (Fed. Cir. 2015). The Court explained that attribution is permitted where the other actors are subject to the defendant’s direction or control, which is not limited solely to principal-agent relationships, contractual arrangements and joint enterprises. On the facts of this case, according to the Court, liability under 35 U.S.C. §271(a) is shown where the alleged infringer conditions participation in an activity or receipt of a benefit upon performance of a step or steps of a patented method and establishes the manner or timing of that performance.
- 4 The en banc Federal Circuit on February 12, 2016, reaffirmed in a 10-2 decision its patent rules of exhaustion, concluding that neither the Supreme Court’s decision in *Quanta*



Computer, Inc. v. LG Electronics, Inc., nor its decision in *Kirtsaeng v. John Wiley & Sons, Inc.*, required any change in the law of patent exhaustion. *Lexmark International, Inc. v. Impression Products, Inc.*, 117 USPQ2d 1817 (Fed. Cir. 2016). Specifically, the Court held that a patentee, when selling a patented article subject to a single-use/no-resale restriction that is lawful and clearly communicated to the purchaser, does not by that sale give the buyer, or downstream buyers, the resale/reuse authority that has been expressly denied. Explaining that the ruling in *Mallinckrodt, Inc. v. Medipart, Inc.*, 976 F.2d 700 (Fed. Cir. 1992) remains unchanged.

- 5 On January 15, 2016, the U.S. Supreme Court agreed to review the appropriate claim construction standard to be used in Inter Partes Review (IPR) proceedings in *Cuozzo Speed Technologies, LLC v. Lee* 115 USPQ2d 1425 (Fed. Cir. 2015). In *Cuozzo*, the Federal Circuit panel approved of the PTAB's use of the "broadest reasonable interpretation" (BRI) standard for claim construction, and agreed that the three claims in suit were invalid for obviousness. The question presented to the Supreme Court is as follows: whether the court of appeals erred in holding that, in IPR proceedings, the Board may construe claims in an issued patent according to their broadest reasonable interpretation rather than their plain and ordinary meaning.
- 6 The United States Lanham Act's ban on registering disparaging marks violates the First Amendment of the Constitution, the en banc Federal Circuit held December 22, 2015. In *re Tam*, en banc Fed. Cir., 117 USPQ2d 1001 (Fed. Cir. 2015). In a case involving the refusal to register the term "The Slants" as the name for a group of Asian musicians, the Court concluded that the disparagement provision of the Lanham Act is used to reject trademarks based on their content and viewpoint, and that denying the benefit of registration on this basis is an unlawful burden on free speech.

February 2016[*End of document*]