



e-News

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International Association for the Protection of Intellectual Property
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[AIPPI new website is online](#)

[AIPPI World Congress — Rio 2015](#)

[AIPPI 2015 Rio](#)

(Felipe Claro, President of AIPPI)

The first AIPPI annual and paperless meeting took place in the multi-colored city of Rio, Brazil, from 10 to 14 October 2015, at the recently enlarged Windsor Barra Hotel & Congressos, located in front of the beautiful Barra beach.

[Fond Memories from Rio](#)

(Luiz Henrique do Amaral, Chair Organizing Committee)

The Rio Congress is sadly over. What a joy to have received 1,600 participants from more than 80 countries. The IP world coming together for serious studies and high level discussions but also for networking and fun. The Rio Organizing Committee is thankful for all who came a long way to enjoy our hospitality. Now we can't wait for Milan!

[Resolutions adopted in Rio de Janeiro](#)

(Sarah Matheson, Reporter General of AIPPI)

The delegates at the 2015 Congress in Rio de Janeiro last month adopted four Resolutions on various questions of IP law:

- Q244—Inventorship of multinational inventions
- Q245—Taking unfair advantage of trademarks: parasitism and free riding
- Q246—Exceptions and limitations to copyright protection for libraries, archives and educational and research institutions
- Q247—Trade secrets: overlap with restraint of trade, aspects of enforcement

The texts of the adopted Resolutions are available on our website and [here](#).

The Resolutions will be disseminated to all relevant authorities and bodies. In addition to national and regional IP offices, including EPO, OHIM and EAPO, they will be sent to WIPO and WTO. The Groups are also encouraged to disseminate the Resolutions to their relevant ministries and other government bodies, together with any further engagement appropriate to promote the Resolutions and AIPPI's work more generally. The Resolutions will also be deployed by AIPPI where relevant to any consultations, submissions or in any other context in which it is relevant for AIPPI to express an opinion.

[Professional Development Programme: Presentations are now available online](#)

(Sarah Matheson, Reporter General of AIPPI)

"The Rio Congress offered an extensive professional development programme covering a wide variety of topical issues in IP, including the popular 'Pharma Day', plus other panel sessions similarly divided into 'streams' of interest."

'Pharma Day' included sessions on pharmaceutical trademarks, personalised medicine, technology transfer and policy based examination of patentability. The patents stream included sessions on FRAND, inventor remuneration, post-grant oppositions, plant variety protection and green technology. The trademark stream included sessions on collective marks and geographical indications, bad faith registrations and non-traditional marks. A session on industrial designs, debating the issue of form over function, provided an introduction to a Study Question for Milan which will hopefully lead to an AIPPI Resolution on this controversial topic. Other highlights included a panel session on ISP liability, and an engaging exploration of the use of mediation in IP cases.

Building on the success of additional lunch panel sessions run for the first time in Toronto in 2014, there were two special lunch sessions in Rio, one addressing the theme of 'Continuous improvement of IP systems' and the other exploring 'How to manage innovation in an anti-IP climate'.

There was a distinguished line up of speakers including experts from industry, IP offices, the judiciary, academia, and private practice. A description of the Rio Congress panel sessions, speakers and their presentations are available here.

[Standing Committee Reports and Presentations are available online](#)

(Sarah Matheson, Reporter General of AIPPI)

The annual reports of AIPPI's Standing Committees received by the Reporter General prior to the Rio Congress were made available to all Congress participants in a new online format, which is now also available here. A number of Standing Committees also delivered presentations on their work during the year which are available here.

[AIPPI World Congress News of Rio 2015](#)

(AIPPI General Secretariat)

Articles published by Managing Intellectual Property

- Monday 12 October 2015
- Tuesday 13 October 2015
- Wednesday 14 October 2015

[Membership Committee report](#)

(AIPPI General Secretariat)

Please see the Membership Committee Annual Report for AIPPI World Congress 2015.

[Communications Committee report](#)

(AIPPI General Secretariat)

Please see the Communications Committee Annual Report for AIPPI World Congress 2015.

[AIPPI World Congress in Rio - pictures](#)

(AIPPI General Secretariat)

We invite you to have a look at the pictures taken during the AIPPI World Congress 2015.

[Your opinion is important to us](#)

(AIPPI General Secretariat)

Give us your feedback on the latest AIPPI World Congress 2015.

[AIPPI Bureau](#)

[AIPPI at the EAPO 20th Anniversary International Conference](#)

(John Bochnovic, Executive Director of AIPPI)

To mark its 20th Anniversary, the Eurasian Patent Organization (EAPO) hosted an international conference in Moscow on November 10, 2015 on "The Role of Regional Patent Organizations in Creation of Global Intellectual Property Protection System". AIPPI was represented by Deputy Secretary General Olga Sirakova, who addressed the 250 participants on "AIPPI and harmonization of the protection of IP". Speakers at the conference included WIPO Director General Francis Gurry as well as the heads of EAPO and other regional patent organizations.

More information here.

[TPP revealed](#)

(Sarah Matheson, Reporter General of AIPPI)

After 7 years and much controversy concerning the secrecy of the negotiations, agreement on the Trans Pacific Partnership Agreement (*TPP*) was reached on 5 October 2015, as reported in ExCo I at the recent Congress in Rio de Janeiro.

The final text of the agreement was officially released on 4 November 2015. Reports suggest that signatures are expected in early 2016, with ratification in each country to take place over the next two years.

[AIPPI Committees](#)

[Review of developments in selected WTO/TRIPS Council topics during the period from July 15, 2015 to November 9, 2015](#)

(Ivan Hjertman, Member of TRIPS Committee)

The AIPPI Standing Committee TRIPS has among its tasks to advise the Bureau on developments in TRIPS-related issues and to provide key related documents. To this effect, the TRIPS Committee has regularly prepared, on annual or semi-annual basis, a Review of developments in selected WTO/TRIPS topics. These Reviews essentially cover some general WTO topics along with topics on the TRIPS Council agenda. An updated version of the latest such Review has now been prepared for the AIPPI eNews. It covers the period from July 15, 2014, to November 9, 2015.

More information here.

[An introduction to the Amicus Brief Committee](#)

(Clare Cunliffe, Secretary of Amicus Brief Committee)

AIPPI Advocacy: The Amicus Brief Committee and its work

[13th session of the Working Group on the Legal Development of the Madrid System for the International Registration of Marks: the dependency rule under debate](#)

(Elena Molina, Secretary to the Standing Committee on Trademarks of AIPPI)

WIPO held the Working Group on the Legal Development of the Madrid System for the International Registration of Marks between 2 and 6 November 2015. The contracting parties of the Madrid Union and, in an observer capacity, several non contracting states and the main international non-governmental organizations, such as AIPPI, INTA, Marques and ECTA, were represented therein to discuss certain proposals for modification of the Common Regulations under the Madrid Agreement and the Protocol as well as certain potential changes in the law and practice to improve the system for registration of international marks.

[The economic cost of IPR infringement in sports goods](#)

(Ann-Charlotte Söderlund Björk, GOZZO Advokater HB, Göteborg, Sweden)

This third report regarding sport apparel presents the analysis of the sports goods sector. The products of this sector include mainly sporting equipment such as golf clubs, tennis rackets and balls, skis etc. However, it does not include sports apparel (such as football jerseys or baseball caps) which can also be worn as normal clothing. Such apparel is included in the clothing and footwear sector.

It is estimated that the legitimate industry loses approximately €500 million of revenue annually due to the presence of counterfeit sports goods in the EU marketplace, corresponding to 6.5% of the sector's sales. This translates into employment losses of approximately 2,800 jobs.

More detail here.

[Forthcoming Events](#)

[February 2016:](#)

[AIPPI/INTA Seminar - Designs: Into the Future, February 29, 2016 - March 1, 2016](#)

[March 2016:](#)

[AIPPI/ASEAN Regional Seminar 2016, March 3, 2016](#)

[March 2016:](#)

[AIPPI Israel - From IP to NP, March 21, 2016 - March 22, 2016](#)

[April 2016:](#)

[AIPPI Turkey - 4th IP Law Seminar](#)

[April 2016:](#)

[AIPPI Finland & AIPPI Sweden - AIPPI Symposium 2016, April 21, 2016 - April 22, 2016](#)

[July 2016:](#)

[AIPPI Trilateral meeting of the Chinese, Japanese and Korean Group, 16-17 July, 2016](#)

September 2016:

2016 AIPPI World Congress, September 16, 2016 - September 20, 2016

October 2017:

2017 AIPPI World Congress, October 13, 2017 - October 17, 2017

Articles and notes

Australia: High Court of Australia holds isolated nucleic acids to be unpatentable
(Clare Cunliffe (Barrister at the Victorian Bar) and David Fixler (Senior Associate, King & Wood Mallesons), Melbourne, Australia)

In *D'Arcy v Myriad Genetics Inc* [2015] HCA 35 the High Court of Australia found that isolated nucleic acids are not patentable subject matter. The Court held that in determining whether subject matter was patentable for "new classes of claim", regard may be had to policy factors.

China: The Supreme Court Selects SEB's Patent Case as One of the 50 Typical Cases in 2014

(Shuhua Zhang, WAN HUI DA Law Firm & Intellectual Property Agency, Beijing, China)

In this patent infringement lawsuit, the Plaintiff SEB S.A., a French company, succeeded in stopping infringement by KERN, a Chinese manufacturer, and obtaining compensation for damages. The focus of this case is how to seek protection when the claims were defined by function or effect and how to choose the claims to lower the risk in the litigation.

Ecuador: The Organic Code of the Social Economy of Knowledge, Creativity and Innovation

(Maria Cecilia Romoleroux / Ian Wall, Corral Rosales Carmigniani Pérez, Quito, Ecuador)

A draft national code would have wide ranging effects for patentability, patentable subject matter and patent research in Ecuador.

Finland: Extended Collective Licensing for NPVR Services Introduced in Finland

(Johanna Lilja, Jori Jokinen and Åsa Henriksson, Roschier, Attorneys Ltd. Helsinki, Finland)

An extended collective license concerning network personal video recording ("NPVR") services was introduced in Finland on 1 June 2015. By putting in place the extended collective license, lawmakers are attempting to remove the legal uncertainty as well as to tackle the copyright issues relating to the NPVR services.

France: Repute trademark and indirect advertisement of alcoholic beverages

(Marie-Elvire de Moro-Giafferri, DUCLOS THORNE MOLLET VIEVILLE (DTMV) & Associés, Paris, France)

In this recent case, the General Court of the European Union sheds new light on the question of the infringement of a reputed trademark under article 8.5 of the Community Trademark Regulation and particularly on the requirement of a link between the trademarks for the public and on the potentially damaging consequences of such a link.

Japan: First Allowance of Registrations for New Types of Trademarks in Japan

(Mizue Kakiuchi, KUBOTA, Tokyo, Japan)

Based on amendments of the Trademark Act effective on April 1, 2015, the JPO has recently decided the registrability of trademarks consisting of sounds, colors, holograms, motions or positions for the first time. The decisions provide useful guidance with respect to all such non-traditional trademarks.

Mexico: Mexico is on its way to adopt a Trademark Opposition System

(Herrerias F., Bernardo, Hogan Lovells BSTL, S.C., Mexico, Mexico)

It is expected that early next year Mexico will implement an opposition system for trademarks. A draft amendment to the IP law has just been sent to Congress (the Mexican AIPPI Group was involved in the process).

[Poland: Changing Landscape of Industrial Property Law in Poland](#)

(Marta Kawczynska and Marcin Fijalkowski, POLSERVICE Patent and Trademark Attorneys Office and Baker & McKenzie Krzyzowski i Wspólnicy)

Poland's new Industrial Property (IP) Law landscape will come into force on December 1, 2015, with significant changes for patents, designs and trademarks.

[Switzerland: Risk of confusion: the reputation of the junior mark is not relevant, says the General Court of the European Union](#)

(Thomas Widmer, LALIVE, Geneva, Switzerland)

In the recent SKY/SKYPE decision, the General Court of the European Union reaffirmed that it is the recognition of the senior mark and not that of the junior mark that must be taken into account when determining whether there is a likelihood of confusion between the two (5 May 2015, T-423/12, § 56). This contribution aims at analysing said decision from the perspective of both European law and Swiss law.

[UK: How do you infringe a Swiss form claim?](#)

(Duncan Ribbons and Maeve Lynch, Redd Solicitors LLP, London, UK)

The question of what steps a generic manufacturer must take to avoid infringement of a second medical use claim in the UK has been much debated but never decided by a court until now. In Warner-Lambert v Actavis, Arnold J has effectively held that a generic manufacturer who markets a product with a skinny label (i.e. with references to the patented indication carved out) will only infringe a Swiss form claim in very unusual circumstances.

[USA: Google's unauthorized copying of millions of books is fair use under U.S. copyright law, U.S. federal appeals court holds](#)

(Uli Widmaier, Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP, Chicago, USA)

The U.S. Court of Appeals for the Second Circuit held that Google Book's "search" and "snippet" functions constituted fair use of books that Google had copied without the copyright owners' authorization.

[National Groups](#)

[Japan: Japanese Laws Relating to Industrial Property 2015](#)

(Seiji Iwai, AIPPIJAPAN, Tokyo, Japan)

For use by IP practitioners in other countries, the Japanese Group of AIPPI makes and publishes an English translation of the current laws on industrial property rights in Japan:

[AIPPI World Congress — Rio 2015](#)
[AIPPI 2015 Rio](#)

(Article by Felipe Claro, President of AIPPI)

The first AIPPI annual and paperless meeting took place in the multi-colored city of Rio, Brazil, from 10 to 14 October 2015, at the recently enlarged Windsor Barra Hotel & Congressos, located in front of the beautiful Barra beach.

1,600 attendees exchanged views and experiences during the different working, educational, networking and social activities. Among the attendees, were judges, industry people, sister organizations, IP Office leaders, as well as representatives from Brazilian and international authorities.

The Organizing Committee masterfully dealt with all of the logistical issues associated with hosting a large number of people in a city known for its traffic congestion. The friendly staff was attentive and cooperative with the many requests, especially those related to the new paperless Congress format which permitted attendees to view the working papers on their own devices and to print them at will.

During and before the Congress, Luiz Henrique do Amaral, Chair of the Organizing Committee and Assistant to the Secretary General, with the help of the ABPI President, Elisabeth Kasznar, ensured there was the necessary coordination with the Bureau to produce a first class Congress.

Several sister associations had the opportunity to attend a dedicated meeting to share their opinions and coordinate their activities. In addition, industry representatives had the opportunity to speak in a lunch panel, attend a special meeting, and interact in a working lunch with leaders of the IP Offices in Brazil and Japan and of the EPO.

Well-selected workshops and panels studied diverse IP topics, such as the Unitary Patent and UPC, FRAND, plant variety protection, green technologies, bad faith registrations, non-traditional marks, industrial designs, collective marks and GIs, inventor remuneration, ISP liability and IP mediation, and of course there was the popular Pharma Day. Hard debate within a friendly environment was most rewarding for the attendees.

The AIPPI Executive Committee adopted various resolutions, about inventorship of multinational inventions, unfair advantage of trademarks, exceptions and limitations to copyright protection, and trade secrets. There can be seen at the new AIPPI website.

As proposed by the AIPPI Bureau, the Executive Committee and the General Assembly agreed in Rio to introduce extensive changes modernizing AIPPI's statutes and regulations, and updating its terminology. And the new Executive Director was in full operation during the Congress helping in whatever task he was assigned.

The Council of Presidents, which also changed its structure, was pleased to announce new Members of Honor: John Bochnovic (Canada), Stephan Freischem (Germany) and Thierry Calame (Switzerland), and Award of Merit Holders: (Gunnar Baumgärtel (Germany), Sergio M. Ellmann (Argentina), David W. Hill (United States of America), Philip Mendes da Costa (Canada), Bruce E. Morgan (Canada), Renata Righetti Pelosi (Italy), Sara Ulfsdotter (Sweden), Kazuhiko Yoshida (Japan).

Two new National Groups were added to the AIPPI family, and the Executive Committee celebrated the formation of the groups in Pakistan and Vietnam.

The social agenda was especially attractive and many of the best locations of Rio bore witness to this international IP gathering.

During the Opening Ceremony attendees received a warm welcome and enjoyed a youth orchestra presentation and a display of dancing from around Brazil. ABPI President, Elisabeth Kasznar, highlighted Brazil as a very big and diverse country, full of opportunities.

The cultural evening was a real carnival. All attendees were transported to the Copacabana Palace Hotel to be immersed in the spirit and costumes of the Brazilian Carnival.

The closing dinner was simply remarkable. The Jockey Club was the setting for an elegant and attractive soirée and all guests were able to bet on a lucky “IP horse”. The attendees celebrated until the early hours the closing of an unforgettable Congress, and immediately started planning for next year’s Congress in September in Milano. Ci vediamo.

[AIPPI Bureau](#)
[TPP revealed](#)

(Article by Sarah Matheson, Reporter General of AIPPI)

What is the TPP?

Once signed, it will be the largest ever economic treaty, its parties jointly representing more than 40% of the world’s GDP and 25% of its trade. The parties are Australia, Brunei, Canada, Chile, Japan, Malaysia, Mexico, New Zealand, Peru, Singapore, the United States of America and Vietnam.

Described by the European Centre for International Political Economy as an economic integration that ‘competes’ with Europe, the TPP spans agriculture, foreign investment, government procurement, telecommunications, e commerce, competition policy, labour and the environment, amongst other areas.

However, it is the very comprehensive intellectual property (IP) provisions that have been particularly contentious. There is no doubt that the TPP will require changes to the IP laws of many of its parties.

According to official statements, the IP offices of each party will:

- cooperate on training and exchange of information;
- protect and enforce copyright;
- prevent users from circumventing technological protection measures;
- outline remedies to deal with trade of counterfeit and pirated goods;
- incorporate civil procedures and remedies for rights holders;
- mandate the criminalisation of commercial counterfeit and pirating activities;
- enable rights holders to rectify their rights across the TPP region; and
- ensure member states protect patents and have a transparent, efficient administration for technological inventions.

Many areas of the IP chapter are relevant to recent AIPPI Resolutions or concern areas of study of AIPPI. The Standing Committee on Free Trade Agreements will no doubt have much to do in analysing the IP aspects of interest in the coming months. For now, the below is simply a guide to the breadth and nature of the IP provisions.

General

The IP chapter preserves the WTO Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). The TPP parties also explicitly affirm their commitment to the Doha Declaration on TRIPS and Public Health, which supports least developed and developing countries in addressing public health problems.

Trade marks and geographical indications

Under the TPP, no party may require, as a condition of trade mark registration, that a sign be visually perceptible. No party may deny registration of a sound mark solely on that basis. Parties must make best efforts to register scent marks.

Parties may provide limited exceptions to the rights conferred by a trade mark, such as fair use of descriptive terms, provided those exceptions take account of legitimate interests of the trade mark owner and third parties.

The TPP includes provisions relating to collective and certification marks, well-known trade marks, procedural aspects of examination, opposition and cancellation and electronic trade marks systems.

Parties must also provide for an appropriate procedure for the settlement of domain name disputes.

The TPP recognises that geographical indications may be protected through a trade mark or sui generis system or other legal means.

Parties are also required to provide means to prevent commercial use of another party's country name in relation to goods in a manner that misleads consumers as to the origin of goods.

Patents

Subject to certain exceptions, parties must make patents available for any invention, whether a product or process, in all fields of technology, provided that the invention is new, involves an inventive step and is capable of industrial application. The parties also confirm that patents are available for inventions claimed as at least one of: new uses of a known product, new methods of using a known product, or new processes of using a known product; although parties may limit those new processes to those that do not claim the use of the product as such.

A party may exclude inventions from patentability in order to protect the ordre public or morality, including to protect human, animal or plant life or health or to avoid serious prejudice to nature or the environment (as long as those exclusions are not made solely because the exploitation is prohibited by law).

Parties may also exclude diagnostic, therapeutic and surgical methods for the treatment of humans or animals, as well as animals (other than microorganisms) and essentially biological processes for the production of plants or animals (other than non-biological and microbiological processes). However, parties must allow for patents for inventions that are derived from plants.

The TPP also provides for a one-year grace period for initial public disclosure in relation to determining if an invention is novel or involves an inventive step.

The parties confirm the importance of improving the quality and efficiency of their patent registration systems, as well as simplifying and streamlining the procedures and processes of their patent offices. Patent applicants must have at least one opportunity to amend, correct or make observations in connection with their applications. Parties are to provide patentees with an adjustment to the term of their patent if there have been 'unreasonable delays' in issuing the patent, for example, a delay of more than five years from the date of filing the application, or three years after a request for examination of the application has been made. In the pharmaceutical context, parties must adjust the patent term for 'unreasonable curtailment' as a result of the marketing approval process.

Pharmaceuticals

The TPP contains measures relating to marketing of generic pharmaceuticals, requiring notification to the patent holder of an application for marketing approval, whether that be through a US 'Orange Book' type

procedure or, at a minimum, coordination between the marketing approval authority and the patent office. During the course of the negotiations, much of the focus was on the period of data exclusivity protection for biologic products. Ultimately, parties can elect between two alternatives a minimum eight-year data protection period, or a minimum five-year protection period plus 'other measures' to deliver a 'comparable' market outcome, with transition periods for some parties. This is to be reviewed in ten years' time.

For new pharmaceutical products the data exclusivity period is at least five years (with some exceptions for Chile and Malaysia).

The TPP also provides for data exclusivity of at least three years for new clinical information required for marketing approval for new indications, formulations, or methods of administration of an approved pharmaceutical product or — alternatively — at least five years for new chemical entities not previously approved in a party's territory. However, if a party provides at least eight years of data protection for new pharmaceutical products, it is not required to apply these additional exclusivity periods.

(On data exclusivity generally, new agricultural chemical products have a period of at least ten years.)

Copyright

Copyright protection for a work, performance or phonogram is 70 years beyond the life of the author (or otherwise from the end of the calendar year of the first authorised publication).

The TPP gives authors the exclusive right to authorise or prohibit reproduction of their work in any manner or form, and the making of their works available to the public, including in such a way that the public may access these works from a place and at a time chosen by them.

Many commentators have criticised the absence of a US style fair use defence. There are however provisions dealing with limitations and exceptions, and parties must endeavour to achieve an appropriate balance in their copyright systems, taking into consideration legitimate purposes such as criticism, comment, news report, teaching, research and facilitating access to published works for the visually impaired.

Parties are required to ensure that civil remedies and criminal offences provide adequate legal protection, and to provide effective legal remedies against the circumvention of technological protection measures and electronic rights management systems.

The TPP also has a range of provisions relating to internet service providers (ISPs). In order to obtain 'safe harbour' legal immunity, ISPs must forward notifications from copyright owners to customers whose IP address allegedly infringes the copyright in question. Where a copyright owner has made a 'legally sufficient claim of copyright infringement', ISPs must provide information they hold about the infringer's identity. ISPs will also be required to remove infringing material if they become aware of it, and will receive legal immunity if they take down material in 'good faith', including from content owners if it is not later found to be infringing.

Industrial designs

The TPP requires parties to ensure adequate and effective protection of industrial designs. Protection is available for designs embodied in a part of an article, or to a part of an article in the context of the article as a whole.

Parties also commit to improving the quality and efficiency of their respective industrial design registration systems.

Trade secrets

The TPP requires all signatories to provide for criminal procedures and penalties for unauthorised and wilful access to a trade secret held in a computer system, the unauthorised and wilful misappropriation of a trade secret or the fraudulent or unauthorised and wilful disclosure of a trade secret. However, parties may limit criminal procedures to particular circumstances, such as where the act is intended to injure the owner of a trade secret.

Enforcement

The parties agree to provide effective enforcement systems including, for example, civil procedures, provisional measures, border measures, and criminal procedures and penalties for wilful commercial-scale trademark counterfeiting and copyright or related rights piracy.

Other

The parties also agree to cooperate in the area of traditional knowledge, recognising the relevance of traditional knowledge associated with genetic resources. Patent examination may include regard to traditional knowledge.

Nothing in the TPP prevents a party from determining whether or under what conditions the exhaustion of intellectual property rights applies under its legal system.

[AIPPI Committees](#)

[An introduction to the Amicus Brief Committee](#)

(Article by Clare Cunliffe, Secretary of Amicus Brief Committee)

What is the Amicus Brief Committee?

In 2013, AIPPI established an Amicus Brief Committee (ABC) to coordinate and oversee the filing of amicus briefs in national and regional courts and tribunals.

AIPPI has already filed amicus briefs and intervener briefs in some very high profile pieces of litigation. Cases in which AIPPI has filed amicus briefs include *Bilski v. Kappos*, and *Alice Corporation Pty., Ltd., v. CLS Bank International & Anor* in the Supreme Court of the United States, as well as in *Apotex Inc., et al & Anor. v Sanofi Aventis, et al* in the Supreme Court of Canada (in relation to the utility requirement) and Case G03/08 before the European Patent Office's Enlarged Board of Appeal (which considered the patentability of computer implemented inventions).

The ABC is responsible for:

- reviewing requests for amicus briefs from national and regional groups, special committees and individuals,
- identifying proceedings where it may be appropriate to file an amicus brief,
- researching AIPPI's position on the particular issues raised by proposed amicus briefs and liaising with other special committees,
- making recommendations to the Bureau as to whether an amicus brief should be filed,
- coordinating and overseeing the filing of briefs,
- ensuring briefs comply with the Amicus Brief Committee Protocol,

- reporting to the Bureau and communicating to AIPPI members on amicus briefs.

More information about the ABC can be found [here](#).

How will the ABC consider a request to file an amicus brief?

All requests received by the ABC will be reviewed in accordance with the Amicus Brief Committee's Protocol. A sub-committee of the ABC will be established to liaise with the national or regional group in relation to the desirability of filing an amicus brief. The ABC will establish whether AIPPI has an established position on the relevant issue, and whether the position is still current. Where AIPPI does not have a current position on an issue, the ABC will consider whether the matter is sufficiently urgent and important to warrant formulating a position. If the ABC considers that it is appropriate to file an amicus brief, the ABC will submit a request to the Bureau for approval. No amicus briefs will be filed without the approval of the Bureau and the relevant national or regional group.

Once approval has been granted, the ABC team will coordinate with the national and regional group (and, if relevant, the Special Committee) to draft an amicus brief. The final draft of the brief will be submitted to the Bureau for approval.

When will AIPPI file an amicus brief?

AIPPI will consider filing an amicus brief in any proceeding which is sufficiently urgent and important, where AIPPI either has a position on the relevant issue or can formulate a position on the issue in the time available.

Generally, AIPPI will file amicus briefs:

- in higher courts (that is, in appellate courts rather than at first instance); and
- in substantive hearings (that is, after leave to appeal has been granted, rather than in petitions for rehearing/petitions for certiorari).

How do I make a request to file an amicus brief?

All requests to file amicus briefs should be sent to amicusbriefcommittee@aippi.org. The more comprehensive a request is, the faster it will be considered. Ideally, requests should set out:

- The forum (the court/tribunal);
- The parties involved;
- The nature of the dispute;
- The position of the relevant court or tribunal on amicus briefs;
- The procedures involved in filing amicus briefs in the relevant forum;
- An indication of the timing;
- The interest of the requestor in the proceeding (if any); and
- Any relevant AIPPI resolutions (if known).

Because the ABC needs to consult the relevant national or regional group and any relevant special committees and undertake research before it can make a recommendation, it is desirable to request to file an amicus brief as early as possible.

If you have any questions, please contact a member of the ABC (listed [here](#)). We look forward to hearing from you.

[13th session of the Working Group on the Legal Development of the Madrid System for the International Registration of Marks: the dependency rule under debate](#)
(Article by Elena Molina, Secretary to the Standing Committee on Trademarks of AIPPI)

WIPO held the Working Group on the Legal Development of the Madrid System for the International Registration of Marks between 2 and 6 November 2015. The contracting parties of the Madrid Union and, in an observer capacity, several non contracting states and the main international non-governmental organizations, such as AIPPI, INTA, Marques and ECTA, were represented therein to discuss certain proposals for modification of the Common Regulations under the Madrid Agreement and the Protocol as well as certain potential changes in the law and practice to improve the system for registration of international marks.

The 13th session of the Working Group had a busy agenda. It dealt with a number of proposals, including: (i) the amendment of the Common Regulations as regards examination of limitations in international registrations by the International Bureau, replacement of national trademarks and the recordal of a change in the legal nature of the holder; (ii) the introduction of the recordal of division and merger of international registrations; (iii) the review of the translation practice of the International Bureau regarding the list of goods and/services; (iv) the freezing of the operation of Article 14(1) and 2(A) of the Madrid Agreement in order to ensure the unity of the Madrid System by no longer accepting accessions to the Madrid Agreement alone and; (v) the freezing of the five-years dependency rule of the international trademarks. In fact, the freezing of dependency, which has been debated in the Working Group for the last five years, was one of the hot topics of the session and the one that generated more debate.

According to Article 6(3) of the Madrid Agreement, the protection resulting from an international registration may no longer be invoked if, within five years from the date of international registration, the basic mark registered in the country of origin no longer enjoys legal protection in that country. The Protocol contains the same provision but additionally set forth the so-called “transformation option” whereby the trademark holder can convert the international registration into a national or regional application, keeping the original date of filing and the original list of goods and/or services if the basic mark is cancelled in whole or in part during the five years dependency term. This option rendered the dependency rule more flexible and more attractive.

The main purpose of dependency was to provide a fair balance between the interests of the trademark holders and the interests of third parties by providing a centralised mechanism for the assertion of earlier rights. However, this mechanism has been subject to criticism for several reasons, mainly: (i) legal uncertainty for holders of international trademarks during the five years dependency term; (ii) the risk of total loss of protection as a result of a central attack, including in countries where the attacking party has no corresponding earlier rights; (iii) unreasonable loss of rights where the basic mark application is limited, refused or withdrawn before the office of origin on absolute grounds within the five years dependency term; (iv) complexity of the system, with transformation being a costly, time-consuming and burdensome option for trademark holders; (v) risk of loss of protection for non-use of a basic mark filed in a script different from the relevant script in the country of origin (eg. Japan, China or Korea).

WIPO has conducted a survey on the views of users of the Madrid System on the dependency principle for the Working Group to obtain a better understanding of the practical advantages and disadvantages of this mechanism. This analysis was requested by the Working Group to consider the potential temporary freezing of dependency proposed by WIPO. According to WIPO, one of the advantages of freezing versus abolition is that the first is revocable and could be used as a test. Another one is that whereas the suspension of the effects of dependency may be approved by the Madrid Union Assembly, the abolition of dependency or the reduction of the dependency term would require approval by a diplomatic conference since it would entail a permanent modification of Articles 6 of the Agreement and Protocol.

The aforementioned survey was conducted from 18 May to 7 June 2015 among users of all contracting parties. More than 1,300 users answered the full questionnaire, which included 38 questions. According to WIPO, the main findings of this survey can be summarized as follows: (i) cancellations of international marks due to the ceasing effect of the basic mark are not for the most part, the result of a central attack;

(ii) a significant number of users question the fairness of dependency and considers that it lowers the value of the Madrid System; (iii) a few users employ central attack as a mere incentive to bring holders of international registrations into negotiations, without the intention or means to actually execute such threat; (iv) a majority of users do not view dependency as an advantage of the Madrid System; (v) a majority of users are in favor of either abolishing or restricting dependency; (vi) a majority of users indicate that, if dependency was abolished or restricted, they would be equally or more inclined to use the Madrid System; (vii) the use of the Madrid System to protect trademarks in a script other than the script used in the country of origin is an issue that affects users worldwide; (viii) a large majority of users does not have an opinion on transformation, a procedure which is seldom employed and that is viewed by some users as expensive and difficult.

While some representatives criticized the findings of the survey conducted by WIPO as well as the method to obtain them, others found that they were accurate and conclusive and that they put into evidence the convenience to abolish or freeze the dependency rule. In any event, the issue was highly controversial not only among the contracting parties but also among the international non-governmental organization, which had an important role in the debate.

AIPPI has already resolved in Resolution Q239 issued in Toronto on 17 September 2014 that it “does not support an abolition or freeze of the dependency on the basic mark” but it “supports a reduction of the dependency period from five years to three years, as such would provide a more even balance between the interests of the trademark owner on the one hand (providing an earlier level of certainty) and third parties on the other hand”. AIPPI considers that “[a]rguably, although the dependency is at times criticised (e.g. for having effect even in countries where the basis for cancellation of the basic mark does not apply), alongside the option of transformation which often applies, the dependency overall provides a fair balance between safeguarding the interests of the trade mark owner (who can efficiently obtain a broad geographic coverage of its mark by designating members) and third party interests, in particular by providing a centralised mechanism for the assertion of earlier rights.”

Eventually, in view of the lack of consensus, the Working Group agreed to request the International Bureau to prepare and present a new document, to be discussed at its next session, with other proposals to make the Madrid System more flexible and effective.

The relevant documents of the 13th session of the WG are available at http://www.wipo.int/meetings/en/details.jsp?meeting_id=35594.

Articles and notes

[Australia: High Court of Australia holds isolated nucleic acids to be unpatentable](#)

(Clare Cunliffe (Barrister at the Victorian Bar) and David Fixler (Senior Associate, King & Wood Mallesons), Melbourne, Australia)

Patentable subject matter in Australia

Under the *Patents Act* 1990 (Cth), subject matter is patentable if it is a “manner of manufacture within the meaning of section 6 of the Statute of Monopolies [(1623)]”.

In the landmark decision of *NRDC v Commissioner of Patents* (1959) 102 CLR 252, the High Court held that a method of eradicating weeds was patentable, because the method was directed to “an artificially created state of affairs” of economic significance. This formulation was subsequently adopted by Australian Courts as a formulation for manner of manufacture.

Background

Myriad owned a patent claiming (amongst other things) isolated nucleic acids coding for the mutant BRCA1 polypeptide which indicates a predisposition to breast cancer.

Yvonne D'Arcy challenged the validity of three claims to the isolated nucleic acid on the basis that they did not define patentable subject matter. Claims to diagnostic methods were not challenged. Nor were the claims challenged on any other basis (such as lack of inventive step).

Myriad argued that the claims satisfied the test for patentable subject matter, because isolating the nucleic acid had resulted in an artificially created state of affairs of economic utility.

Myriad succeeded at first instance and on appeal before five judges of the Full Federal Court. Seven judges of the High Court unanimously overturned these decisions.

Artificiality

The High Court found that significance of the claimed subject matter was the “information” stored in the sequence of nucleotides — which was unchanged by the process of isolation. Accordingly, the Court considered that the isolated nucleic acid was not within the “category of that which can be ‘made’” and was, therefore, unpatentable.

The High Court’s reasoning extended to synthesised DNA (cDNA). In this respect the High Court went further than the Supreme Court of the United States which, in its *decision on the equivalent patent*, found that only naturally occurring DNA was ineligible subject matter.

Policy factors

The Court noted that the NRDC test “was not intended as a formula exhaustive of the concept of manner of manufacture” and identified four other factors that may be relevant when assessing the patentability of subject matter for new classes of claims:

1. Whether patentability is consistent with the purposes of the *Patents Act 1990* (Cth) (in particular, whether patentability might have negative effects on innovation, have a chilling effect on activities beyond the scope of the exclusive rights, or involve the court in assessing important and conflicting public and private interests).
2. Whether patentability would affect the coherence of the law.
3. Australia’s obligations under international law and the patent laws of other countries.
4. Whether to accord patentability would best be left to the legislature.

The decision does not provide guidance on how to recognise “a new class of claim” and it is unclear when these factors will be considered, or how the court will assess them.

It should be noted that many of the claims of the Myriad patent which were directed to the application of the isolated nucleic acid (such as claims to diagnostic methods) were not challenged.

IP Australia

Following the High Court’s decision, IP Australia published a *draft examination practice note* stating that nucleic acid sequences encoding polypeptides and RNA (naturally occurring or synthesised) are no longer patentable.

The draft practice note includes a list of subject matter that, in IP Australia’s view, remains eligible for patentability. However, it is difficult to see how some of the items listed (for example, “isolated cells” or “Isolated non-coding (e.g. “Junk”) DNA”) could be patentable, given the High Court’s reasoning.

Conclusion

Following the High Court's decision, it is uncertain when regard may be had to policy factors in assessing patentability. The Court's approach may well impact on claims to computer-implemented inventions.

[China: The Supreme Court Selects SEB's Patent Case as One of the 50 Typical Cases in 2014](#)

(Article by Shuhua Zhang, WAN HUI DA Law Firm & Intellectual Property Agency, Beijing, China)

Legal and Regulatory Background

The "Supreme Court's Interpretation of Certain Issues on Application of Laws in the Trial of Patent Infringement Disputes" (2010)

Article 4: If a claim states the technical features in terms of functions or effects, the people's courts shall determine the content of the technical features by taking into account the embodiments to achieve such functions or effects as described in the specification and drawings and any of their equivalents.

Case Summary

In 1995, SEB applied for an invention patent No. ZL95109146.8 for "a device which controls the opening and closing of a pressure cooking vessel with a clamp". The patent was granted in 1998.

At the Canton Fair of April 2011, SEB found that a Guangdong-based company named KERN was offering for sale a pressure cooker which was suspected of infringing the above patent. SEB immediately filed a complaint with the IPR Complaints Reception Office of the Canton Fair which, after examination, affirmed the infringement and disposed of the infringing product accordingly.

In July 2011, SEB conducted a notarized purchase of samples from KERN, and filed a civil lawsuit against KERN for infringement of the said patent before the Guangzhou Intermediate Court, citing claims 1, 3 and 12 of its patent.

In November 2012, the Court held that the Defendant's pressure cooker fell under the scope of protection of claims 1, 3 and 12 of the Plaintiff's patent. The Court ordered KERN to stop the infringement, to destroy the tooling used to make the infringing products, and to pay SEB an amount of RMB 300,000 as damages.

KERN appealed to the Guangdong High Court. In December 2014, the Guangdong High Court rendered the final decision that the pressure cooker infringed claims 1 and 12 of the patent, but not 3. The Court found that the three claims had technical features which were described in terms of functions. The Court construed the three claims by studying the specification and drawings of the patent, and defined the scope of protection of the claims by listing separately and side by side all the necessary technical features as shown in the specification and drawings.

WAN HUI DA represented SEB S.A. in this case.

Comments:

The purpose of the Supreme Court in selecting this lawsuit as a typical case is to clarify how to define the scope of protection of a claim when the technical feature is described in terms of functions or effects. Before filing the lawsuit, SEB S.A. fully considered the problem of how to seek protection when the claims are drafted in terms of functions or technical effects, and studied the practice of different courts. It then selected three claims that had the best chance of being accepted by the court.

[Ecuador: The Organic Code of the Social Economy of Knowledge, Creativity and Innovation](#)

(Article by Maria Cecilia Romoleroux / Ian Wall, Corral Rosales Carmigniani Pérez, Quito, Ecuador)

As member of the Andean Community, Ecuador is already governed by the following Community ‘Decisions’ in the field of intellectual property: 345 (plant varieties), 351 (copyright), 391 (traditional knowledge) and 486 (industrial property). These Decisions have direct effect. Yet there is proposed new legislation at the national level in Ecuador entitled “the Organic Code of the Social Economy of Knowledge, Creativity and Innovation” (“Draft Code”), which seeks to regulate intellectual property as well as other fields not directly related to IP. What follows is a look at the most important draft articles relating to patents:

Article 253 limits patentable material, in that new forms of substances and similar forms are not considered inventions. This in turn fundamentally limits pharmaceutical and biotechnological development, and is also contrary to TRIPS, which describes non-patentable material exhaustively in Article 27 and does not provide for such a limitation.

Article 259 establishes subjective requirements regarding “inventive step” in providing that it must concern a “significant technical input”. Under TRIPS the only requirement is for an “inventive step”, which may be deemed by a Member to be synonymous with “not obvious”.

The Draft Code also seeks to regulate research activity, firstly in that researchers must reach an accredited standard and also be registered. In the case of patents relating to inventions developed in educational establishments or universities, Article 261 provides that exploitation rights of no less than 40% will be granted to the inventors (even in the event that the patent is assigned). In a similar fashion to the previous article, Article 262 provides that those contracted to carry out research have a right to participate in the exploitation of the patent at no less than 25%.

Articles 261 and 262 are confusing in the extreme. The reason for professors and students conducting research is not economic, and in any case it is preferable to allow greater freedom for research. Moreover, research costs are very high, with very few projects being a financial success. A patent and the exploitation thereof can help to recoup some of the research costs, but instead nearly half of all money earned as the result of the patented invention will be diverted to those who were not seeking monetary gain, rather than those funding the research. Therefore, there is a sense that these provisions have attempted to fix what was not broken. In addition, although researchers and professors might not be economically motivated, introducing financial incentives will undoubtedly concentrate research into profitable fields.

The Draft Code therefore is problematic since although it purports to promote research and development, it in fact could have the opposite effect.

There is already comprehensive Community legislation in place for IP as mentioned at the outset of this article, and the caseload of the Andean Tribunal of Justice is overwhelmingly related to IP, therefore delivering a significant amount of jurisprudence in this field. When one also considers that the Draft Code appears to be in conflict with TRIPS, one must consider that it is unnecessary and even unhelpful.

[Finland: Extended Collective Licensing for NPVR Services Introduced in Finland](#)

(Article by Johanna Lilja, Jori Jokinen and Åsa Henriksson, Roschier, Attorneys Ltd. Helsinki, Finland)

An extended collective license concerning network personal video recording (“NPVR”) services was introduced in Finland on 1 June 2015. By putting in place the extended collective license, lawmakers are attempting to remove the legal uncertainty as well as to tackle the copyright issues relating to the NPVR services.

Background

NPVR solutions are widely available on the global market. In Finland alone, there are some twenty NPVR services on offer, most of which are provided by telecommunications operators. NPVR services, illustrating the “cloudification of television”, store program recordings in the operators’ servers, allowing the end-user to access programs on demand instead of being tied to the broadcast schedule. In practice, this means that the end-user can choose to watch a certain program at any chosen place and time, without recording the program to his/her own device.

In Finland, prior to the change in question, NPVR services were arguably considered to fall within the scope of the copyright exemption on private use. As a result, NPVR service providers used works without the permission of the copyright holders and, consequently, no compensation was paid to the rights holders.

Legal Reform: NPVR Services Covered By Extended Collective License

In order to clarify the law, a new section was included in the Finnish Copyright Act (404/1961, as amended) relating to NPVR services. Although not expressly stated, it can be inferred from the underlying proposal that NPVR services were not deemed to fall within the scope of the copyright exemption on private use.

Pursuant to the new section, by entering into a collective license with the authorized collective management organizations, the NPVR service provider will have the right to record TV programs and make them available to the public on demand. It is worth noting that the collective license also covers works whose rights holders are not members of the collective management organizations, including foreign works.

The collective license does not, however, apply to TV programs to which the TV broadcasting company has acquired the rights. In these cases, the NPVR service provider must enter into an agreement directly with the TV broadcasting company regarding the recording and publication of the work in the NPVR service. In any event, the use of the TV broadcasting company’s signal must be separately agreed upon. Furthermore, the new provision enables the producer of a TV program, who has acquired the rights to record a program and make it available to the public, to opt-out, meaning that it can prohibit the application of the collective license to that specific program.

Practical Implications

As a result of the reform, NPVR service providers will in most cases negotiate agreements with, first, the collective management organizations as regards the use of copyrighted works in their NPVR services, and, secondly, with the TV broadcasting companies as regards the use of the signal and TV programs not covered by the license. NPVR service providers and TV broadcasting companies should thus review and revise their existing agreements to ensure that they incorporate the new rules.

Another practical implication, affecting most of all the end-users, is the NPVR fee. The collective management organizations will charge a fee for each subscription from the service providers, which in turn will charge the subscribers an equivalent fee. The fee is around EUR 2.50 per month.

It remains to be seen whether this rather unique Finnish solution based on extended collective licensing for NPVR services is successful in eliminating the legal uncertainties relating to NPVR services, while still allowing for the further development of NPVR solutions.

[France: Repute trademark and indirect advertisement of alcoholic beverages](#)

(Article by Marie-Elvire de Moro-Giafferri, DUCLOS THORNE MOLLET VIEVILLE (DTMV) & Associés, Paris, France)

Editions QUO VADIS v. OHIM, T517/13, ECLI:EU:T:2015:816

In this recent case, the General Court of the European Union sheds new light on the question of the infringement of a reputed trademark under article 8.5 of the Community Trademark Regulation and particularly on the requirement of a link between the trademarks for the public and on the potentially damaging consequences of such a link.

French company Editions QUO VADIS filed an opposition based on likelihood of confusion (article 8.1b) and infringement of its reputed trademark QUO VADIS (article 8.5), designating inter alia “time planners”, against a CTM application for QUO VADIS filed by Mr. Hernandez to designate alcoholic beverages and retailing of wine.

Following the rejection of its opposition, Editions QUO VADIS filed an appeal before the GCEU based on Article 8.5, claiming that the public would make a connection between the trademarks, that the negative connotation conveyed by alcohol (alcohol-related anti-social and high-risk behavior) would create a detrimental association with the sign and that the registration thereof would restrict its ability and freedom to communicate through its trademark because of French legislation.

Indeed, articles L.3323-2 et seq. of the French Public Health Code authorize direct or indirect advertisement of alcoholic beverages under certain strict conditions. Indirect advertising is defined as the advertising of a product other than the alcohol product where the use of the trademark brings to mind the alcoholic beverage. The opponent relied on French Court decisions that stated that filing a trademark for alcoholic beverages would paralyze the use of an earlier trademark covering non-similar goods (e.g., creams or perfumed candles) because of the law regulating the advertising of alcoholic beverages and that it was a violation of trademark rights justifying the cancellation of the later trademark. In France, such ground of action is independent from that of the repute of the trademark.

The GCUE first stated the four cumulative requirements to be satisfied for the application of article 8.5, i.e., a registered and reputed earlier trademark, identity or similarity of the trademarks at issue, a reputation in the relevant territory and use without due cause, which together generate either i. detriment to the distinctive character of the trademark, ii. detriment to the trademark’s repute, or iii. taking unfair advantage of the trademark’s distinctive character or repute.

Prior to dismissing the opponent’s appeal, the GCUE stated that, in the absence of a link made by the public between trademarks with a certain degree of similarity, but without confusing them, the use of the later trademark is not likely to cause damage. Thus, the establishment of a link is a mandatory prerequisite.

The GCEU then held that although the trademarks were identical, the public could not assume a link between them because of the average distinctiveness of the signs, of the complete difference of nature, purpose and use of their products and services, of the targeted public, thus preventing any overlap. As a consequence, the use of the trademark application was not likely to generate any damage.

Furthermore, as regards the detriment to the repute of the earlier trademark, the GCUE specifies nonetheless that wine is not inherently harmful and that the use without due cause must be the result of the applicant’s behavior not of a national legislation, which should not have to be taken into account in assessing the legality of the Board of Appeals’ decision.

Thus, the GCUE confirmed the Board of Appeals’ decision. The strict assessment of the link with a reputed trademark limits its scope and avoids giving the reputed trademark owner absolute rights, even in the presence of specific national restrictions.

[Japan: First Allowance of Registrations for New Types of Trademarks in Japan](#)
(Article by Mizue Kakiuchi, KUBOTA, Tokyo, Japan)

1. Registrable Marks

On October 27, 2015, the Japan Ministry of Economy, Trade and Industry (METI) announced that the Japan Patent Office (JPO) issued the first series of decisions on the registrability of new types of trademarks. Based on amendments of the Trademark Act effective on April 1, 2015, Japan now recognizes that sounds, colors, holograms, motions or positions can be trademarks in addition to traditional trademarks such as words and designs. The issuance of allowance takes over 6 months from filing for these new types of trademarks, which is a little longer than the common 3 months to 6 months for traditional trademarks. As of October 23, 2015, 1039 applications for the new types of trademarks had been filed with the JPO.

The JPO has decided in favour of registrability for 43 applications among 481 applications filed on the first day, specifically, for 21 Sound Marks among 151 applications, 16 Motion Marks among 32 applications, 5 Position Marks among 103 applications, and 1 Hologram Mark among 3 applications. No Color per se Mark has been allowed yet among the 192 applications yet. After payments of the official registration fees to the JPO, the allowed new types of trademarks will be registered.

2. Sounds

According to the cases announced by METI, the allowed Sound Marks include voices speaking recognized words in Japanese, such as reading or singing traditional trademarks. Though the Sound Marks are depicted by staff notations in most cases, this is not always necessary. A properly-prepared sample or other kind of attachment could be satisfactory for filing. Sound Marks are registerable with a hard media MP3 recording. Meanwhile, descriptions by sonograms or tablature musical scores are not registrable under the JPO Guideline for examination. Sound Marks consisted of a lion's roaring, or of human shouts and the like are still pending, but not rejected yet. Those might be required to prove secondary meaning to satisfy the requirement of distinctiveness.

Also, new types of trademarks must also overcome traditional issues of similarity to prior registered trademarks without limitation to the type of mark.

3. Motions

Most of the allowed Motion Marks depict movements or transformations of traditional trademarks such as words and designs. Other examples of allowed marks are short animation movies for 5 seconds which demonstrate specific effects of medicines, or a large group of fish traveling from one side to another. Because the JPO Guideline does not specify the length but illustrates a 3-second example, 5-seconds could be a proper benchmark, in particular, for movies without traditional trademarks. Meanwhile, some Motion Marks for 10 seconds or more have been allowed.

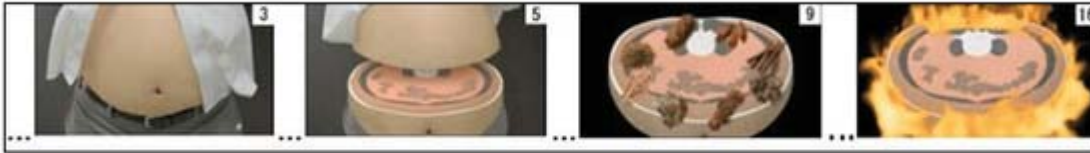
4. Others

Position Marks and Color per se Marks seem to have a high threshold to be registered since only a few applications have been allowed at this time. Those would be required to have further evidence of secondary meaning for distinctiveness as well, since the JPO indicated that the other applications are still under examination.

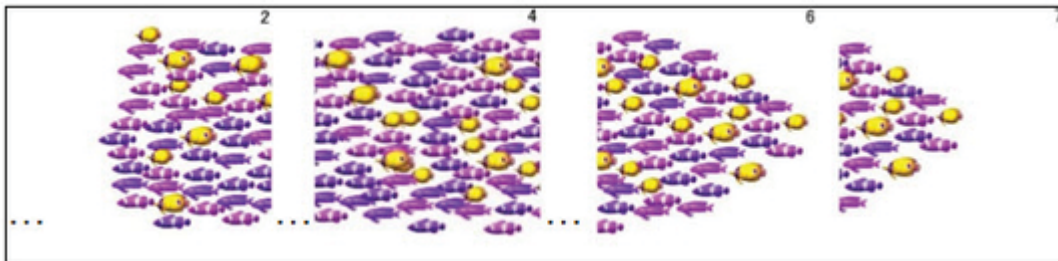
On the whole, the JPO is willing to protect trademarks beyond languages, and will expand its decisions to register new types of trademarks.

Motion Mark Examples:

#2015-29822



#2015-30559



[Mexico: Mexico is on its way to adopt a Trademark Opposition System](#)
(Article by Herrerias F., Bernardo, Hogan Lovells BSTL, S.C., Mexico, Mexico)

On November 10, 2015 a proposed amendment to the Mexican Industrial Property Law (IPL) was published in the Senate's Official Gazette. The amendment would implement an opposition system in Mexico which main purpose is to streamline the registration process of trademarks, slogans and the publication of trade names, incorporating this global trend to the benefit of the industrial property system in Mexico and its users. If the amendment is passed, the following sections and articles would be added to the IPL, among others:

Article 119. - Once the application has been received, the Institute shall proceed, within 10 business days, with its publication in the Gazette and carry out a formal examination of the same, as well as the documentation filed, to determine whether the requirements specified in this Law and its Regulations are obeyed.

This publication will be the starting point of the opposition. A revised article 120 is proposed to grant the opportunity to anyone, who might consider that the application violates the IPL's provisions, to bring an opposition within a non-extendable one month term, counted from the date of publication of the Gazette. After that term, a list of applications that are subject to an opposition will be published in the Gazette, within the following 10 business days. It is important to mention that the proposed opposition system will not be binding upon the Mexican Trademark Office (MTO) in the registration process, based on the following facts:

- An opposition will not suspend the examination and registration process;
- Opposition does not automatically grant the role of interested party, third party or party, to the person or entity who filed it;
- Opposition shall not control the outcome of the in-depth examination carried out by the MTO; and
- The MTO may consider, in its analysis, the opposition and the allegations filed by the applicant of the registration.

Considering that the opposition will not be treated as a procedure within the registration process, the applicant may file a response to the opposition. Failing to do so would not be deemed a tacit acceptance to the opposition.

It is proposed that the reform to the IPL, if passed by Congress, would become effective after 90 calendar days of its publication in the Official Gazette of the Federation.

Considerations

Currently, in Mexico, in-depth examination of an application is carried out by the MTO based on the information or documentation that is at their fingertips, which may or not be enough. As of today, MTO unilaterally decides whether the proposed application might infringe prior registrations or pending applications. If so, it issues office actions which are served only to applicants, and not to the owner of the application or registration that has been considered as a bar. Hence, registrations sometimes are granted without considering third parties' rights that might be infringed or affected.

For that reason, it is considered necessary to implement an opposition system in Mexico, to offer third parties the opportunity to file information, evidence and/or documentation that would allow MTO to better assess the registration of a distinctive element, avoiding the possibility of granting registrations that could infringe or jeopardize third party's rights.

The inclusion of an opposition system is meant to ensure that trademarks are duly examined and granted according to applicable law provisions. The aim is to decrease the filing of cancellation actions, particularly, those based on registrations that were granted by error, mistake or as a result of the difference in judgment from examiners.

The publication of this initiative clearly proves the willingness of Mexican authorities to have an improved IP system.

[Poland: Changing Landscape of Industrial Property Law in Poland](#)

(Article by Marta Kawczynska and Marcin Fijalkowski, POLSERVICE Patent and Trademark Attorneys Office and Baker & McKenzie Krzyzowski i Wspólnicy)

Poland's new Industrial Property (IP) Law landscape will come into force on December 1, 2015, with significant changes for patents, designs and trademarks.

Major changes to IP law, both procedural and substantive, adjust it to European regulations and international agreements, including inter alia the European Parliament and Council Directive 98/44/EC on the legal protection of biotechnological inventions, the Geneva Act of the Hague Agreement concerning the international registration of industrial designs, and the Singapore Treaty on the Law of Trademarks. They also take into account rulings of the Court of Justice of the European Union issued in IP matters.

Key changes in the patent field

- The new IP law will provide for a grace period of six months preceding the filing of the patent application if the disclosure of the invention was caused by evident abuse in relation to the applicant or its legal predecessor. Such prior disclosure will then not be regarded as prior art.
- Products or methods that cannot be proved to be susceptible to exploitation, or which cannot be shown to give a result expected by the applicant, under generally accepted and recognized principles of science, will not be regarded as inventions.
- Regulations relating to filing divisional applications will become much stricter, i.e. the Polish patent office will refuse to accord the filing date of the original application to a divisional application if it considers that the original application fulfilled the unity requirement. This change may significantly reduce the possibility of filing voluntary divisional applications in Poland.
- In biotech inventions relating to a gene sequence, or a partial sequence, it will be required to disclose an industrial applicability of the sequence in the application's description, as well as to indicate the function

of such gene sequence in an independent claim. This change implements into the Polish IP law the CJEU ruling in the case C-428/08 (Monsanto Technology).

- As of December 1, 2015 there will be a new register of supplementary protection rights extending patent protection to products that are active substances of medicinal products or plant protection products. This change will reduce the risk of confusion as to existence of extended protection and its duration.

Key changes in the industrial design field

- A description of the industrial design is no longer required in the application document.
- Copyright protection of an industrial design may be sought and acquired independently of industrial design protection. Previously, the industrial design holder could not invoke copyright protection after the expiration of the industrial design registration.
- Several new provisions were added as a result of Poland's accession to the Hague Agreement concerning the international registration of industrial design. The new provisions govern the refusal, opposition and cancellation procedures as well as the scope of protection granted to international industrial designs.

Key changes in the trademark field

- The Polish Patent Office has been objecting to the registration of trademarks containing names of Polish towns unless the applicant was able to present the consent of local authorities. However, there was no corresponding local legislation and applicants often had difficulties obtaining consents. Therefore, the requirement of such consent was abandoned.
- Letters of consent have been introduced and acknowledged. Previously, the Polish Patent Office has been citing senior rights despite the consent of the senior right holders to the applicant's use and registration of the trademark.
- More trademark law change will become effective later in mid 2016.

[Switzerland: Risk of confusion: the reputation of the junior mark is not relevant, says the General Court of the European Union](#)

(Article by Thomas Widmer, LALIVE, Geneva, Switzerland)

Decision of the General Court of the European Union T-423/12

In the recent SKY/SKYPE decision, the General Court of the European Union reaffirmed that it is the recognition of the senior mark and not that of the junior mark that must be taken into account when determining whether there is a likelihood of confusion between the two (5 May 2015, T-423/12, § 56). This contribution aims at analysing said decision from the perspective of both European law and Swiss law.

In a nutshell, the Court rejected the argument that the SKYPE opposed community trademark ("CTM") had acquired, through extensive use, a high distinctiveness which served to counteract any similarity with the SKY opposing trademark.

The rationale is that when considering whether or not a CTM falls under any of the relative grounds for refusal, events or facts which happened before the filing date of the CTM are irrelevant because the rights of the opponent, insofar as they predate the CTM, are earlier than the applicant's CTM (Guidelines for Examination in the Office for Harmonization in the Internal Market ["OHIM"] on Community Trademarks, status as at 1 February 2015, Part C, Section 2, Chapter 7, § 6.2).

In other words, the right to a CTM begins on the date when the CTM is filed (or on the priority date, as the case may be); and from that date on the CTM has to be examined with regard to opposition proceedings (OHIM, Decision of 28 July 2010, opposition n° B 1 359 803, p.2).

Still put differently, the reputation of the junior CTM can never be relevant in the context of opposition proceedings. Indeed, either the reputation has been acquired after the filing of the junior CTM and cannot be taken into account since it is posterior to the right of the opponent over the opposing trademark. Or the reputation has been acquired before the filing of the junior CTM and cannot be taken into account either, since it does not relate to the junior CTM which did not, by definition, exist before its filing.

The question if the reputation of the junior mark may be taken into account when assessing the risk of confusion was also addressed in Switzerland, with the same result (former Swiss federal appeal commission for intellectual property, Decision of 31 January 2000 [“Land Rover”]).

However, there is one particular Swiss decision in which the opposite was held true. The issue was whether there was a risk of confusion between the “Campus” and the “UBS Campus” marks, both covering financial services.

According to Swiss case law, the fact that a junior mark consists exclusively of the senior mark, to which another word has been added, is an indication that the two marks are similar. This is however not the case if the added word gives the junior mark a different meaning, or if the senior mark has a weak distinctive character and the added word has a strong distinctive character (Swiss Federal Administrative Court, Decision of 7 December 2009, B-4151/2009).

In the “Campus” vs. “UBS Campus” case, the Swiss Supreme Court reasoned as follows: first, “Campus” has a weak distinctive character in relation to financial services aimed at students; second, the “UBS” sign has a strong distinctive character since UBS (the biggest bank in Switzerland) “has offices throughout Switzerland and constantly advertises”. In other words, the “UBS” sign is considered to be highly distinctive since it has a reputation. Third, the adding of “UBS” to “Campus” is sufficient to avoid any risk of confusion between “Campus” and “UBS Campus” (Swiss Supreme Court, Decision of 18 January 2000, 4C.3/1999).

Accordingly, the Swiss Supreme Court took into account the reputation of a part of the junior mark (“UBS”) when assessing the risk of confusion with the senior mark (“Campus”).

This has not given rise to a fruitful debate amongst Swiss legal writers who criticized, essentially, the qualification of “Campus” as a weak mark (J. Müller, sic! 2000, 196) and the alleged inexistence of a risk of confusion between “Campus” and “UBS Campus” (J. Müller, op.cit. and E. Marbach, SIWR III/1, footnote n° 1199). Other writers opined that adding to a senior mark a strong element, and in particular a famous name, can be sufficient to avoid any risk of confusion even if the senior mark has an average distinctive character — and not only a weak distinctive character as ruled by the Swiss Supreme Court (Schlosser/Maradan, CR-PI, Art. 3 LPM N° 56).

[UK: How do you infringe a Swiss form claim?](#)

(Article by Duncan Ribbons and Maeve Lynch, Redd Solicitors LLP, London, UK)

Background facts

Warner-Lambert is the proprietor of a patent which claims the use of pregabalin for the preparation of a pharmaceutical composition for treating pain. Pregabalin is also approved for the treatment of other non-patented indications. Actavis launched its generic pregabalin product (Lecaent) under a ‘skinny’ label.

In the UK, doctors are encouraged to prescribe drugs according to their generic name (INN) rather than their brand name. Furthermore, usually pharmacists do not know what indication a drug has been prescribed for (because the indication is rarely written on the script) and there are typically financial incentives for pharmacists to dispense generic drugs where available. In these circumstances, it is manifest that some of Actavis’ product would be dispensed to patients who have been prescribed pregabalin for the treatment of pain.

In an attempt to segregate the patented and non-patented markets for pregabalin, Warner-Lambert obtained an unprecedented order requiring the National Health Service to issue guidance to doctors that, when treating pain, they should write “Lyrica” (the brand name of Warner-Lambert’s product) on the prescription rather than “pregabalin” (the INN).

Infringement of Swiss form claims

Swiss form claims are process claims that derive their novelty from the new use of the known drug. Infringement therefore depends on the drug manufacturer’s mental state, i.e. at some level he must intend or know that his generic product will be used for the patented indication. In a previous judgment in the litigation, the Court of Appeal determined that the mental element imposed by a Swiss form claim was that the manufacturer must know or be able to reasonably foresee that some of his drug will intentionally be used for treating pain.

Applying this test, Arnold J rejected the proposition that it was sufficient to establish infringement that it was reasonably foreseeable to Actavis that some of its product would be used to treat pain. He reasoned that there must also be an intention that Actavis’ product be used for the treatment of pain.

As to the question of whose intention was relevant, Arnold J considered that the intention of prescribing doctors was “highly relevant, if not exclusively so”. However, he held that for there to be infringement the doctor’s intention must be to use Actavis’ product (and not just any generic product) for the treatment of pain. In practice, it seems that this intention requirement will only be satisfied where a doctor writes “Lecaent” (the brand name of Actavis’ product) on a prescription for a patient suffering from pain, which would seem to be a most unusual situation and there was no suggestion that such a practice had been adopted by doctors in the UK.

Alternatively, Arnold J accepted that the pharmacist’s intention may be relevant, although only in a small proportion of cases (the evidence in the case suggested that the proportion was 5%) where the prescription indicates that Pregabalin has been prescribed for the treatment of pain. However, taking into account the surrounding circumstances, such as the steps taken by Actavis to inform pharmacists that Lecaent was not licensed for treating pain, Arnold J concluded that it was not foreseeable to Actavis that Lecaent would be intentionally administered for the treatment of pain save in a small number of exceptional cases which he regarded as *de minimis*.

Comment

The decision provides welcome clarification on the mental element required for infringement of a Swiss form claim, but it is not without its difficulties. For example, applying this test would suggest that a ‘full label’ (i.e. without the patented indication carved out) generic product would not infringe a Swiss form claim so long as doctors prescribe by INN and pharmacists do not know what indication the drug has been prescribed for.

[USA: Google’s unauthorized copying of millions of books is fair use under U.S. copyright law, U.S. federal appeals court holds](#)

(Article by Uli Widmaier, Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP, Chicago, USA)

Authors Guild et al. v. Google, Inc., No. 13-4829-cv (2d Cir. Oct. 16, 2015).

The U.S. Court of Appeals for the Second Circuit held that Google Book’s “search” and “snippet” functions constituted fair use of books that Google had copied without the copyright owners’ authorization.

The facts are as follows:

“Through its Library Project and its Google Books project, acting without permission of rights holders, Google has made digital copies of tens of millions of books, including Plaintiffs’, that were submitted to it for that purpose by major libraries. Google has scanned the digital copies and established a publicly available search function. An Internet user can use this function to search without charge to determine whether the book contains a specified word or term and also see ‘snippets’ of text containing the searched-for terms. In addition, Google has allowed the participating libraries to download and retain digital copies of the books they submit, under agreements which commit the libraries not to use their digital copies in violation of the copyright laws. These activities of Google are alleged to constitute infringement of Plaintiffs’ copyrights.”

Slip op., pp. 2—3.

The plaintiffs made five arguments why Google’s conduct infringes their copyright. The Court rejected all of them.

1. Plaintiffs argued that Google’s copying of entire books, together with letting readers search them and view “snippets” of them, cannot be fair use because it is not “transformative.” Slip op., p. 3.

The court found that Google’s use of the books was “highly transformative” and revealed only as much as was essential to “permit searchers to identify and locate the books in which words or phrases of interest to them appeared.” Id., pp. 4, 21.

2. Plaintiffs argued that Google’s profit motive and its goal of “use its dominance of book search to fortify its overall dominance of the Internet search market” preclude a finding of fair use. Id., pp. 3, 24.

The court saw “no reason in this case why Google’s overall profit motivation should prevail as a reason for denying fair use over its highly convincing transformative purpose, together with the absence of significant substitutive competition, as reasons for granting fair use.” Id., p. 26.

3. Plaintiffs argued that Google infringes their derivative rights by cutting into potential licensing revenues. Id., pp. 3—4.

The court found that plaintiffs’ copyright “does not include an exclusive derivative right to supply . . . the kind of information about the works that Google’s programs provide to the public.” Id., p. 37.

4. Plaintiffs argued that Google’s digital copies of plaintiffs’ books are vulnerable to hackers who might distribute the books for free on the Internet. Id., p. 4

The court found that plaintiffs’ claim is “not supported by the evidence” because Google Books’ digital scans are protected by “impressive security measures” that were praised by “plaintiffs’ own security expert.” Id., p. 42.

5. Finally, Plaintiffs argued that “Google’s distribution of digital copies to participant libraries is not a transformative use.” Id., p. 4.

The court found that “the possibility that libraries may misuse their digital copies is sheer speculation.” Id., p. 45.

The court emphasized that “giving authors absolute control over all copying from their works would tend in some circumstances to limit, rather than expand, public knowledge.” Id., p. 13. Google Books, however, “augments public knowledge by making available information about Plaintiff’s books.” Id., p. 4.

Augmenting public knowledge is an important concern of the court. Many of the books copied by Google are out of print, and Google Books “provide[s] otherwise unavailable information” about these works. Id., p. 18.

National Groups

Japan: Japanese Laws Relating to Industrial Property 2015

(Article by Seiji Iwai, AIPPIJAPAN, Tokyo, Japan)

For use by IP practitioners in other countries, the Japanese Group of AIPPI makes and publishes an English translation of the current laws on industrial property rights in Japan:

Title: "Japanese Laws Relating to Industrial Property 2015 (Pocket Edition)," Released on February 18, 2015.

- Size: B5, softcover, 336 pages.
- Updated to reflect the revision by Act No.36 on May 14, 2014.
- Definitive compilation of the main four Japanese IP laws in English.
- Names of laws contained: Patent Act, Utility Model Act, Design Act, Trademark Act, Unfair Competition Prevention Act, Act on International Applications under the Patent Cooperation Treaty, Intellectual Property Basic Act.

You can order this book (JPY 5,600) at amazon.co.jp:

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AIPPI is concerned with all types of intellectual property rights (including patents, trademarks, and copyrights).

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