The Patent Lawyer

GLOBAL REACH, LOCAL KNOWLEDGE

www.patentlawyermagazine.com

September / October 2020

Launch interactive document

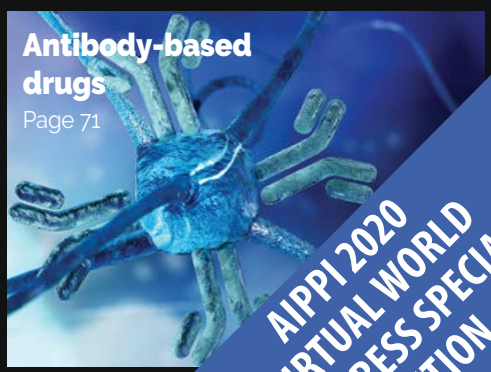
Good for the gander: IPR estoppel

Haynes & Boone examine the lesser-known estoppel and what the rule prohibits.

ASIA Law firm RANKINGS

Patent co-ownership
Page 41

Mexican IP Law
Page 54



Antibody-based drugs
Page 71

AIPPI 2020 VIRTUAL WORLD CONGRESS SPECIAL EDITION

CTC Legal Media

THE PATENT LAWYER
Issue 50

Editor
Faye Waters
faye@ctclegalmedia.com

Publishing Director
Chris Dooley
chris@ctclegalmedia.com

Advertising Enquiries
Katie Kerr (Publishing Executive)
katie@ctclegalmedia.com

Subscription Enquiries
subscriptions@ctclegalmedia.com

Accounts Enquiries
accounts@ctclegalmedia.com

Published by:
CTC Legal Media Ltd,
23 Hedgers Way, Kingsnorth,
Ashford, Kent TN23 3GN
Tel: +44 (0)20 7112 8862
Fax: +44 (0)20 7084 0365

Design and Repro by:
Design and Printing Solutions Ltd
Unit 45C, Joseph Wilson Industrial Estate, Whitstable, Kent CT5 3PS

Printed by:
Pureprint Group, Crowson House, Bolton Close, Bellbrook Park, Uckfield, East Sussex TN22 1PH

ISSN 2051-3690

CTC Legal Media

Editor's welcome

Welcome to our AIPPI World Congress special edition, at which we are proud Media Partners. Though we are unable to meet in person this year, we are excited for the AIPPI virtual event and look forward to networking with you. This issue, also available at the INTA Annual Meeting and Leadership Meeting, features articles on the focal developments in patent law brought to you by industry leaders worldwide.

Our cover story, written by the experts at Haynes and Boone, examines the lesser-known IPR estoppel and its impact on patent owners, exploring what qualifies as a triggering "adverse judgment" and what the rule prohibits a Patent Owner from doing.

> "Exploring what qualifies as a triggering "adverse judgment"

We also touch on utility models from two different perspectives: a case study on Portuguese speaking countries from Inventa International, and from Beijing Sanyou IP Agency Ltd an overview of the Chinese system. Further, we look at SPC's development in Poland over the last 16 years; and problems that arise in, and the reasons for, patent co-ownership.

We visit Mexico for a review on patent prosecution in light of the new IP law from OLIVAERS, and then the UK following the latest rulings on patent enforcement. All this and a great deal more.

If you have any comments, questions, or would like to discuss ideas, find us at our virtual booth – we look forward to hearing from you.

I hope you enjoy the issue.

Faye Waters

Faye Waters
Editor

Mission statement

The Patent Lawyer educates and informs professionals working in the industry by disseminating and expanding knowledge globally. It features articles written by people at the top of their fields of expertise, which contain not just the facts but analysis and opinion. Important judgments are examined in case studies and topical issues are reviewed in longer feature articles. All of this and the top news stories are brought to your desk via the printed magazine or the website *www.patentlawyermagazine.com*

September / October 2020

Contents

Ken Adamo – IP Attorney USA
Ken has extensive trial experience as lead counsel before state and federal courts and the US International Trade Commission.

Dr Saiful Khan – Potter Clarkson
Saiful is a Partner and Board Member at Potter Clarkson who practises in both the Electronics & Computing Group and the Design & Engineering Group.

Osamu Yamamoto – Yuasa & Hara, Japan
Osamu Yamamoto is a patent attorney, and a managing partner of Yuasa and Hara. He specializes in patents in the fields of biotechnology & pharmaceuticals.

Pravin Anand – Anand & Anand, India
Pravin Anand, managing partner of Anand and Anand, is an advocate and a patent and trademark attorney.

Noel Courage – Partner, Bereskin & Parr LLP
Noel Courage is a partner and patent attorney at Bereskin & Parr LLP, working in its Toronto office. His practice focuses on patenting and licensing of life sciences inventions.

Stefan Schohe – Boehmert & Boehmert
Stefan is partner at Boehmert & Boehmert. He mainly works in the fields of IT and physics, with a focus on litigious issues.

Caitlin Heard – Partner, CMS
Caitlin's principal area of expertise is multi-jurisdictional patent litigation. She has acted on a number of high-profile disputes across a range of technical areas.

Vitor Fidalgo – Lecturer at the University of Lisbon Faculty of Law
Vitor is also Legal Director at Inventa International, implementing the best IP strategies and enhancing the profitability of assets.

Piotr Dynowski LL.M. – Bird & Bird
Piotr is Partner, co-head of the IP, and head of TMT practice at the Warsaw office. He is one of the leading IP and patent litigation lawyers in Poland.

Simon de Banke – Founder & CEO, IP Centrum
Simon de Banke is founder and CEO of the high-tech-focused IP Services disruptor IP Centrum.

Daniela Ampollini – Trevisian & Cuonzo, Italy
Daniela is a partner of Trevisan & Cuonzo. She advises clients in IP matters in the Italian jurisdiction, with a focus on patent litigation.

Enrique A. Diaz – Goodrich Riquelme
Enrique is head of the Industrial and Intellectual Property Department. He currently manages the prosecution of over 3500 trademarks and more than 1000 patents per year.

Mark Durrant – Director of Marketing and Communications, Marconi Group
Mark spent thirteen years at Nokia, most recently as Director of Communications for Nokia Technologies, He is now Director of Marketing and Communications at Marconi Group.

Eric Su – HongFangLaw, China
Eric Su is founding partner at HongFangLaw and studied law at the East China University of Politics and Law and chemical engineering at the North University of China.

Sergio Olivares Jr. – Olivares, Mexico
Sergio Olivares leads the multi-award winning patent practice at the law firm Olivares and is widely recognized as one of Mexico's leading patent attorneys.

Malcolm Dowden – Legal Director, Womble Bond Dickinson
Malcolm is the author of the EU/UK chapter in the American Bar Association's *The Law of Artificial Intelligence and Smart Machines.*

Valery Medvedev – Gorodissky & Partners, Russia
Valery is the Managing Partner and in charge of the largest IP practice in Russia. He is a Russian and Eurasian Patent Attorney.

Eugene Goryunov – Partner, Haynes and Boone
Eugene Goryunov is a partner in the Intellectual Property Practice Group in the Chicago office of Haynes and Boone and an experienced trial lawyer.

Maria Zamkova – Fenix Legal KB, Sweden
Maria has a Master of Industrial Design and is a patent and trademark attorney. She is an expert in European Patents.

Dr. Claudia Tapia – Ericsson, Germany
Claudia is Director of IPR Policy & Legal Academic Research at Ericsson. She is Chair of 4iP Council and vice chair of the Patent and Technology Licensing of LESI.

Good for the gander: patent owners face IPR estoppel, too

David L. McCombs, Theo Foster, Eugene Goryunov, Scott Jarratt and Calmann Clements examine the lesser-known estoppel and what the rule prohibits a Patent Owner from doing.

Most patent litigators are familiar with the *inter partes* review estoppel that bars a petitioner from relitigating its validity challenge after the Patent Trial and Appeal Board (PTAB) issues a Final Written Decision.[1] But a lesser-known estoppel provision exists and prohibits a patent owner from "taking action inconsistent with" an adverse judgment, including pursuing before the Patent Office a "claim that is not patentably distinct from a finally refused or canceled claim." The patent owner estoppel rule has gotten little attention, so this article will explore what qualifies as a triggering "adverse judgment" and what the rule prohibits a Patent Owner from doing.

Disclaimer may trigger adverse judgment and patent owner estoppel

Patent Owners at times make the strategic decision to disclaim all or some of the challenged claims to avoid institution or otherwise terminate an IPR trial. Such disclaimer may be construed as a request for adverse judgement. One of the "[a]ctions construed to be a request for adverse judgment" is the "disclaimer of a claim such that the party has no remaining claim in the trial."[2] Previously, different panels at the PTAB had reached different conclusions as to the PTAB's authority to enter adverse judgment prior to institution.[3] This split was resolved, however, when the Federal Circuit confirmed that the PTAB may enter adverse judgment before institution.

In *Smith & Nephew, Inc. v. Arthrex, Inc*, for example, patent owner Arthrex filed a disclaimer before institution. At the petitioner's request, the PTAB treated the disclaimer as an adverse judgment.[4] The PTAB was unmoved by Arthrex's attempt to distinguish its disclaimer from a request for adverse judgment, noting that "it would be unfair if Patent Owner were able to avoid Petitioner's challenge through a statutory disclaimer and then pursue patentably indistinct claims in its continuation applications."[5]

The Federal Circuit affirmed, finding that the PTAB's authority to enter adverse judgment did not depend on the patent owner's desire or consent:

> If the Board's authority to enter an adverse judgment depended on whether the patent owner requested an adverse judgment, a patent owner could always avoid an adverse judgment by simply stating that it is not requesting one, even with respect to the specific instances articulated in 37 C.F.R. § 42.73(b).[6]

Arthrex also sought to distinguish its decision to cancel claims before institution from a patent owner that cancels claims during trial. But the court held that the language of § 42.73(b) "can be interpreted as meaning that there is no claim remaining for trial, which occurs when, as here, all of the challenged claims have been cancelled." Indeed, "there seems to be no meaningful distinction between claims that are cancelled before an IPR proceeding is instituted and claims that are cancelled after an IPR proceeding is instituted." In reaching this decision, the Federal Circuit looked to the purpose of § 42.73(b), which is to create "estoppel against claims that are patentably indistinct from those claims that were lost."[7]

Patent owner estoppel has limited application in IPR trials

The PTAB has declined to apply patent owner estoppel during IPR trials, with various panels offering differing rationales. For example, in *Elekta Inc. v. Varian Medical Systems, Inc.*, the Petitioner challenged in separate petitions, IPR2016-00380 and IPR2016-00315, apparatus claims of U.S. Patent No. 8,867,703. The Petitioner argued that the Patent Owner was estopped from arguing that certain elements of the apparatus claims were patentable because it had already received adverse judgment on the method claims from a previous IPR.[8] The claims in the previous IPR recited similar elements, but the PTAB did not find this argument persuasive. The PTAB noted that the method and apparatus claims did not recite "subject matter of the same scope" and that the Petitioner's position "improperly focuses on only one limitation of the claims, divorced from the claims' other limitations."[9] Accordingly, Patent Owner estoppel does not apply to specific limitations of a claim, but rather to a claim as a whole. In other words, a Patent Owner may still seek to obtain certain limitations of a claim subject to adverse judgment, as long as the overall scope of the newly sought claim is different.

> **Construed as a request for adverse judgement.**

Furthermore, Patent Owner estoppel does not appear to limit a Patent Owner's ability to defend its claims in an IPR because doing does not equate to "obtaining" claims as recited by 37 C.F.R. § 42.73(d)(3)(i). In *Apple, Inc., v. Contentguard Holdings, Inc.*, for example, the Petitioner argued

1 This article reflects only the present personal considerations, opinions, and/or views of the authors, which should not be attributed to any of the authors' current or prior law firm(s) or former or present clients.
2 37 C.F.R. § 42.73(d)(3)(i).
3 37 C.F.R. § 42.73(b)(2).
3 *Unified Patents Inc. v. Digital Audio Encoding Sys., LLC,* IPR2016-01710, Paper 20 at 3 (Feb. 28, 2017) (denying the petition as moot and dismissing Patent Owner's request for adverse judgment as moot after disclaimer of all claims prior to institution).
4 IPR2016-00917, Paper 12, at 2 (Sept. 21, 2016).
5 Id. at 8-9.
6 *Arthrex, Inc., v. Smith & Nephew, Inc.,* 880 F.3d 1345, 1349 (Fed. Cir. 2018).
7 Id.
8 IPR2016-00341, Paper 20 (Oct. 7, 2016).
9 IPR2016-00380, -00315, Paper 41, 16 (June 5, 2017).


David L. McCombs


Theo Foster


Eugene Goryunov


Scott Jarratt


Calmann Clements

Résumés

David L. McCombs and Eugene Goryunov
David and Eugene are attorneys at Haynes and Boone LLP and specialize in all aspects of PTAB and district court trials and dispute resolutiontechniques.

Theo Foster, Calmann Clements and Scott Jarratt
Theo, Calmann and Scott attorneys in the Dallas-North office of Haynes and Boone and specialize in PTAB trials.

that the Patent Owner was estopped from supporting the patentability of the challenged claims with similar subject matter to those that were cancelled in a previous IPR.[10] The PTAB disagreed, however, stating that the "comments accompanying the rule suggest that it is intended to preclude recapturing in another USPTO proceeding – e.g., prosecution, a continuation or reissue application."[11] Accordingly, Patent Owner estoppel does not apply to defending existing claims in an IPR, but rather to obtaining new claims in a continuation or reissue application.

Additionally, the PTAB has found other reasons not to estop a patent owner. For example, in *SDI Technologies, Inc. v. Bose Corporation*, the PTAB declined to apply patent owner estoppel because patent owner's appeal rights had not yet been exhausted. There, the Patent Owner had appealed the PTAB's Final Written Decision in a previous IPR. In a current IPR, the Petitioner argued that the Patent Owner was estopped from supporting the patentability of similar claims. The PTAB, however, agreed with the Patent Owner that its appeal rights had not yet been exhausted and "a claim is not cancelled until all appeal rights have been terminated."[12] The Board has also declined to apply patent owner estoppel where adverse judgment was not explicitly requested by the Patent Owner, even though claims were cancelled in an IPR proceeding.[13]

> **"The PTAB has found other reasons not to estop a patent owner."**

[10] IPR2015-00458, Paper 9, 7-8 (July 15, 2015).
[11] Id. at 8.
[12] IPR2014-00343, Paper 32, 9 (June 11, 2015).
[12] *Cisco Systems, Inc. v. VirnetX Inc.*, Decision on Rehearing, Reexamination Control 95/001,792, p. 9.

Conclusion

Patent Owners should be cognizant of the estoppel provisions of 37 C.F.R. § 42.73(d)(3)(i) when disclaiming claims during an IPR and also when prosecuting claims following an adverse judgment. Estoppel may require Patent Owners to narrow pending claims. If such narrowing is undesirable, Patent Owners should avoid taking steps that may be viewed as a request for adverse judgment, i.e., filing a disclaimer. Conversely, accused infringers or petitioners would be well served to review prior IPR trials of a Patent Owner's patents in an effort to identify any potential estoppel implications if Patent Owner files a motion to amend.

Contact

Haynes and Boone
180 N LaSalle Street, Suite 2215,
Chicago, IL 60601,
United States of America
Tel: +1 312.216.1620
https://www.haynesboone.com/

Strategic factors in the attack and defense of patent enforcement

Dr. Sergey Vasiliev, Partner at Gorodissky & Partners, considers the elements for both claimant and defendant in preparation for legal action.

The patent enforcement is kind of a puzzle or a mathematic task. The exact result that a patentee is seeking for is to win the case, while the ways to reach the goal can be multiple. One of the benefits the experienced patent litigator may bring to the case is the ability to develop various enforcement strategies and foresee possible scenarios of litigation. The same relates to the defensive strategies that may lead to settlement, loss or win.

In this article we would like to consider some practical tips that can be helpful for both claimant and defendant in terms of preparation and taking legal actions.

Dr. Sergey Vasiliev

1. Preparation for actions: what and how to collect as evidence

Preparation for actions is the mainstay of the litigation strategy. You would have certain flexibilities to decide on the course of enforcement depending on what has been prepared for legal actions and how.

The concept of pre-trial discovery is not allowed in Russia and the burden of proof lays solely with the claimant. The claimant shall produce and submit evidence himself and may face the risk that the case will be dismissed due to lack of proper and sufficient evidence. Therefore, before you decide to take the case to the court you should make sure that all possible efforts have been exerted to collect as much evidence as needed.

The only exception becomes available once the case is in court. The litigant may ask the court to force the other party to submit certain evidence. Prior to filing the said motion, the litigant shall take all possible efforts aimed at obtaining the evidence himself. It is, however, at the court's discretion to decide whether to satisfy such a motion. The rationale here is a balance between parties' interests. The claimant shall prove that he did his best to collect and submit the evidence and thus needs the court's support now as all other available options were exhausted. If you are on the defendant's side, you should assure that the court's order to submit certain evidence will not unreasonably disturb the privacy and confidentiality of the defendant's business.

> **Time for submitting evidence is limited.**

For example, in a recent patent litigation case heard by Commercial Court of Moscow Region the claimant submitted no evidence on use of the patented method of processing correspondence. Instead, the claimant motioned with the court to force the defendant to submit the evidence himself. The patentee neither seeks and collects the evidence himself, nor involves a third party for doing that. The defendant objected that the claimant provided his assumptions only without any confirmatory documents and an expert opinion on use of the patent-in-suit. In other words, any other manufacturer in the same field could be in the defendant's shoes. The defendant also explained that the only goal of litigation was getting access to the business processing applied at the defendant's production. As the outcome the court rejected the claimant's motion on obtaining the evidence and dismissed the case court on the grounds that the claimant failed to provide sufficient and persuasive evidence of infringement.

Another important rule to keep in mind is that the time for submitting evidence is limited. The party shall be in position to collect, produce and submit evidence when the case is considered in the first instance court. The court of appeals may not accept any new pieces of evidence except when the party proves that it was practically impossible to submit that piece of evidence within the hearings in the first instance court.

There are a few standard ways to collect the evidence, including test purchasing, detective investigation, notarization. Test purchases normally help furnishing solid pieces of evidence, such as infringing product per se and a number of supporting documents (sales agreement, invoice, specification, manual, etc.). The detective is invited when the defendant's activity is hidden. Notarial services are very helpful to certify evidence, which can further be removed or modified by the adversary to impede the enforcement.

2. What type of legal action is appropriate for my case

As one knows, the basic principle says that the scope and nature of defense shall be adequate to the scope and nature of the infringement.

In theory, civil, administrative and criminal legal proceedings can be initiated against the patent infringement. In practice, however, the civil actions are mainly taken to enforce the patent rights.

If the right holder faces clearly counterfeit products pretending to be the original ones, then administrative or criminal actions with the police is the appropriate remedy. The minimum scope of evidence here should be a sample of a counterfeit product and an expert opinion on use of the patent in the product. The patentee may have good chances to organize the police raid if he submits a motion and the said pieces of evidence with the police office. In the rest of the cases, the civil actions with the court are preferable.

And it's getting more common when an unauthorized use of the patent becomes a subject of consideration of Federal Antimonopoly Services, that monitor and prosecute the unfair competition on the market. Therefore, if adversary's activity is aimed at getting unlawful/unfair advantages on the market and may damage the patentee that case can be brought to the antimonopoly services.

Taking civil actions is not a bar for taking administrative or criminal ones. Therefore, if appropriate, the enforcement strategy may imply both civil actions with the court, and the administrative actions with antimonopoly body.

> **The scope and nature of defense shall be adequate to the scope and nature of the infringement.**

3. How to change the venue

The procedural rules and judicial principles are similar and equal in all commercial courts all over the territory of Russia. However, the party may feel more comfortable to litigate in its home region rather than in the court of the defendant's location. The rule on court competence, however, says that the lawsuit shall be filed in the region of defendant's registered place of business. If there are multiple infringers, the lawsuit can be filed at the registered address of any of the defendants. Therefore, in terms of litigation strategy, legal actions can be taken in respect of two or more defendants in order to have options to choose the venue. The importer, manufacturer, warehouse, seller can be treated as potential defendants. Therefore, the claimant may consider the locations of those parties and take the case to the court of preferable region.

4. Think a few steps ahead and be ready for counteractions

The effective enforcement strategy presupposes that the strength of the patent-in-suit was checked and challenged before taking actions. In the very negative scenario when the patent-in-suit is invalidated by the adversary the court case shall be dismissed. If the patent-in-suit is invalidated in part the court may keep on litigation based on the newly issued patent. In that case the patentee may face the risk that the initial claims would not be satisfied due to the new (narrow) scope of protection granted under the newly issued patent.

Another reason to challenge the patent is postponement of litigation for a certain period or until the end of invalidity proceedings, which normally last less time than litigation.

The thing is that the Russian patent system is bifurcated meaning that patent infringement disputes are commenced and heard in courts, while patent invalidity actions are brought in front of the RU PTO. In this light the good defensive strategy presupposes to claim postponement of the litigation until the end of invalidity proceedings. This, however, is a matter of the court's discretion and pending invalidity proceedings are not an imperative ground for the court to postpone litigation.

Résumé

Sergey Vasiliev, Ph.D. Partner

Sergey has been working at Gorodissky & Partners since 2007. He advises clients on non-contentious and contentious use of IP/IT, unfair competition and false advertising, parallel imports and anti-counterfeiting, licensing, franchising and due-diligence. He has extensive experience in representing clients in courts and various administrative bodies. He regularly speaks at national and international seminars and conferences and is the author of numerous articles on various issues of patent and copyright. Repeatedly nominated by leading international legal ratings. He is a member of LES Russia.

In turn, the smart offensive strategy presupposes submitting motivated objection not to postpone litigation. In that context invalidity proceedings for the patent-in-suit that took place in the past and resolved in patentee's favor can be served as good persuasive ground to convince the judge not to break litigation.

5. Court expertise/expert report

Examination of the product-in-suit and the claim interpretation always concerns a number of technical questions. Even if the judge is a person skilled in the art, he must judge from the perspective of law and shall not take responsibilities for the technical matters. In the circumstances a court expertise becomes one of the key elements of the litigation since its result substantially determines the outcome of the case.

Although the expert(s) is (are) assigned by the court, it is on the parties' side to find a proper candidate and convince the judge to choose that particular exert and not some other one. To enhance the chances to have the candidate assigned as an expert it is recommended that the candidate; (1) has special knowledge in the art; (2) doctor degree; (3) a number of publications; (4) was assigned as the court expert in the past; and (5) has knowledge in the interpretation of the patent claims.

And it is a good ground to have the candidate challenged if that person; (1) might have any interest in the dispute; (2) might be under control of the claimant or defendant; or (3) prepared inappropriate reports in the past.

Therefore, the task for each party is to carefully study the candidates, find some gaps in their practice and provide motivated objections to the judge.

Another important round is studying and criticizing the expert report. After submission of an expert opinion, the parties shall have the right to study and challenge the same. If needed, the experts may be called to the court and should answer the questions of judges and litigants. The high qualified patent litigator shall be able to question the expert in a way, which opens up any disadvantages, uncertainties and inconsistencies in the expert report. Depending on the result of the questioning of the expert the court may either accept the expert report and continue litigation or assign additional/repeated examination.

6. Abuse of rights or how to catch the adversary

Unfair efforts of the parties to litigation shall finally be rejected. Even if the inferior courts for some reason miss an unfair behavior the senior courts normally redress the balance. Therefore, both the claimant and defendant are advised to look at the dispute from the perspective of fair play and equity both. That argument may substantially change the judge's view on the case and the outcome.

> **The bright example of this principle is mainly known as estoppel.**

The case law shows that legal actions can be treated as fair and not abusing if the parties' legal and technical positions are consistent and unified. Any explanations or statements made by a party in one proceedings/litigation can be exploited against that party in another litigation/proceedings. Therefore, the fair party shall not submit opposite and inconsistent statements, meaning that a statement given in course of a patent prosecution/invalidation shall not contradict to the statements expressed in course of litigation. The bright example of this principle is mainly known as estoppel. This however is not the only implication of fair play doctrine.

Recommendation in this regard is to carefully study all materials related to the case, including patent prosecution and invalidation material as well as any pending and past litigations on the same patent. The adversary's arguments can be broken if those arguments and statements are discovered to be opposing to the arguments and statements submitted by the adversary within another litigation/invalidation proceedings.

Conclusion:

Patent enforcement is a complicated and longstanding process. There are a number of legal, procedural and technical issues arising in course of preparing and taking legal actions. In this article we have discussed and commented on some of those issues that have practical implication. And we do believe the materials provided herein will be helpful in drafting proper and effective enforcement strategies.

Contact

Gorodissky & Partners
B. Spasskaya Str., 25, bldg 3,
Moscow 129090, Russia
Tel: +7 (495) 937-6116
pat@gorodissky.com

Emerging technology: harvesting valuable inventions

Dr Robert Klinski, Managing Patent Attorney at Patentship, discusses the inventor's dilemma surrounding the emerging technology stage and how the invention harvesting scheme can be of aid.

Every technology has a life cycle which usually begins with an emerging technology stage, followed by a technology growth stage and a technology saturation stage.

The emerging technology stage is often initiated by a disruptive catalyst, such as the famous apple prompting Sir Isaac Newton to discover the law of gravity. In the emerging technology stage, there is plenty of room for new inventions and less "IP competition", so that valuable IP assets with significant scopes of protection can be secured at reasonable costs. Clearly, an early investment in emerging technologies may have a very high risk-to-reward ratio, in particular when following a clear market vision. However, the capital expenditures (CAPEX) risk may be high in the emerging technology stage.

The growth technology stage is initiated by early technology adopters and is associated with incremental technology development. In this stage, the number of patent applications is increasing, the innovation increment and thus the scopes of patent protection are decreasing. The

Dr Robert Klinski

growth technology stage has a momentum driving the IP costs higher. Clearly, the CAPEX risk is reduced in the growth technology stage, but the risk-to-reward ratio is decreasing along the growth technology stage curve as well.

The technology saturation stage is associated with technology monetization through products deploying the respective technology. In the technology saturation stage, the innovation increment is rather small, and the maintenance of the IP portfolios is the essential cost factor. The risk-to reward ratio is at its lowest, and experience has it that most IP owners abandon less useful IP or consider IP monetization at this stage.

If IP is considered as a value asset, then the CAPEX required for IP development should have a business-related justification, and preferably a high risk-to-reward ratio associated with high rewards and reduced risks. The sweet spot for IP development appears, therefore, to be at the emerging technology stage. Clearly, it is impossible to book in high rewards without a crystal ball. The intriguing question is, however, how to reduce

“The emerging technology stage is often initiated by a disruptive catalyst.”

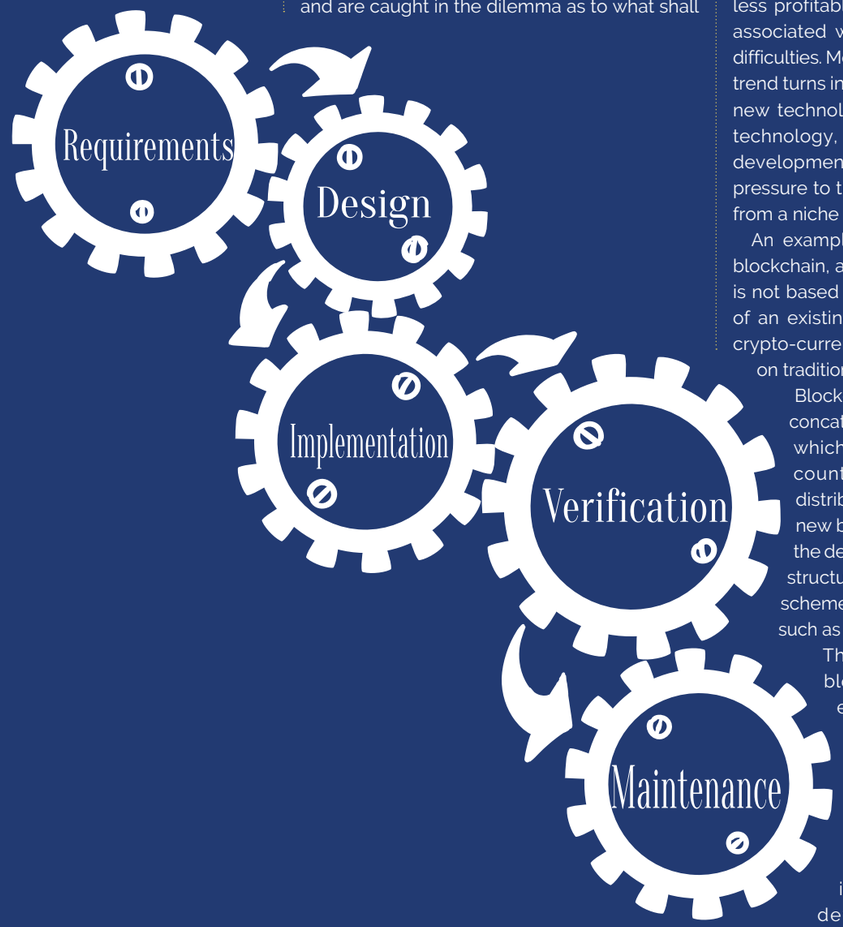
the CAPEX risk? A possible answer which reflects our invention harvesting experience over the last ten years is sketched in the following.

The inventor's dilemma

Traditionally, technology development is allocated in the technology growth stage, and is based on an incremental innovation in order to improve an existing product, such as the combustion engine known since 1892.

Incremental innovation, and thus incremental technology development, aim to improve the existing technology that is typically well known to the engineers, who are well educated and experienced in solving technical problems to develop e.g. an electronic circuit consuming less energy. Therefore, inventions happen as a by-product of incremental technology development, and are incremental as well.

However, one characteristic of the emerging technology stage is the development of the technology platform as such. Unfortunately, engineers are neither trained nor educated in systematically developing intangible IP assets, and are caught in the dilemma as to what shall be invented without an existing technology platform. The inventors dilemma is even amplified by the fact that Patent Offices, and in particular the European Patent Office, often refer to an incremental character of an invention starting from an existing technology platform as “prior art”.



Innovation challenges at the emerging technology stage

One characteristic of emerging technologies is that they can be disruptive and may traverse the well-established innovation processes: there is usually no existing technology that forms a starting platform for further improvement.

Clayton M Christensen has stated that disruptive technologies are often neglected by established technology companies at the beginning of a technical development (“The innovator's dilemma: when new technologies cause great firms to fail”, Boston MA, United States: Harvard Business School Press, 1997). This is due to the fact that technology trends, unless driven by well-established companies, often have their beginnings in less profitable market niches and are usually associated with overcoming major technical difficulties. Moreover, not every new technology trend turns into a profitable technology. Once a new technology trend turns into a profitable technology, the engineers in charge of its development will be under significant time pressure to transfer that emerging technology from a niche market to a profitable market.

An example of an emerging technology is blockchain, a rather disruptive technology that is not based on the incremental development of an existing technology (blockchain-based crypto-currencies were not developed based on traditional banknotes).

Blockchain is based on a cryptographic concatenation of distributed data blocks which enables the development of countless new applications in a distributed network environment. Each new blockchain application may require the development of a new cryptographic structure, (e.g. a cryptographic signature scheme adapted for a certain application, such as cryptocurrency).

The non-incremental nature of blockchain makes it difficult for engineers to recognize an invention in a given blockchain development because there is often no technical increment that can serve as an orientation anchor for engineers to systematically capture inventions in an existing blockchain development. Blockchain is implemented in software, and most engineers believe that software is generally not patentable; therefore, they often fail to realise that a specific blockchain development may involve a patentable invention. In fact, software-related inventions require specific patent drafting skills and profound experience in order to circumvent well-known software patenting problems. Patent applications will otherwise be rejected as not patent eligible, which may in turn confirm the skepticism of traditionally oriented developers regarding patenting software-related innovations. Valuable inventions, and thus intangible assets relating to blockchain, may get lost.

Another example of an emerging technology is 5G communication networks, which are designed to support emerging technologies and applications such as blockchain or the Internet of Things (IoT).

5G communication networks are designed to provide sub-networks which are specifically implemented to support specific applications and services. For example, autonomous driving requires very low communication delays, and thus a very fast communication link to the car. A specific autonomous driving slice is therefore a specific sub-network that enables a fast and reliable communication structure – for example, for car control using a 5G network architecture. In the context of blockchain IoT applications, a 5G slice can be specifically designed to use only secure communication nodes supporting encrypted communications of considerable data amounts associated with the distributed IoT environment.

The specifically designed 5G slices allow a specific network design for countless applications. In order to implement 5G, the traditional, all-purpose network architecture will be replaced step-by-step by the service-oriented network architecture, which is also a non-iterative process. In addition, 5G communication networks are widely implemented in software, mainly because software offers the required flexibility when designing service-specific network architecture.

Therefore, the innovation challenges associated with 5G are similar to the challenges arising in connection with blockchain or any other emerging technology. The development of 5G communication networks is non-incremental, which makes developing or at least recognizing 5G inventions difficult for those engineers skilled in developing traditional technologies. Moreover, the software character of 5G implementations imposes several problems associated with patenting software per se. These problems may result in the loss of essential inventions and therefore intangible

Résumé

Dr. Robert Klinski,
Managing Director

Dr. Klinski is German and European Patent, Trademark and Design attorney, and the founder of Patentship.

He studied electrical engineering and telecommunications at the Technical University Hamburg-Harburg and received his PhD with honors from the Technical University of Munich in the field of statistical signal processing in telecommunications. He was a scientific researcher at the Fraunhofer Institute and engineer at Siemens AG in the fields of wired and wireless communication systems and is mentioned as inventor in several patents relating to telecommunications.

Dr. Klinski has been working in the field of intellectual property since 2002, and has extensive experience in IP prosecution, IP litigation, IP harvesting and IP exploitation in the fields of digital signal processing, 5G, IoT, AI, blockchain and cryptography. In his recent 5G and security projects, he supported his clients with harvesting more than 100 inventions. Dr. Robert Klinski is further actively supporting international investment firms in IP backed startup incubation and IP generation on demand.

Patentship is a medium-sized, value-oriented patent law firm based in Munich, specializing in value-oriented and result-driven patent drafting, prosecution, litigation and licensing in various jurisdictions and in a wide range of technologies, such as electrical engineering, telecommunication and information systems, software, mechanical engineering, automotive and chemistry.

Patentship's clients include national and international research institutes, medium-sized companies and global players listed in Fortune 500 and Forbes 100 rankings.

“Inventions happen as a by-product of incremental technology development.”

> **Which makes developing or at least recognizing 5G inventions difficult.**

assets, particularly at the beginning of a development cycle.

One factor which may additionally prevent harvesting valuable inventions in the emerging technology stage is the fact that new technologies are mostly developed in software, and there are numerous problems associated with patenting software inventions. However, software is just another technology tool that often replaces traditional technology tools that are implemented to solve technical problems. It should, however, be noted at this point that software implementations, or generally technical inventions, that solve technical problems with technical means can be patented according to the EPO.

Market need v. technical problem to be solved

In the emerging technology stage, the inventions result from satisfying a new market need rather than from solving a given technical problem in order to improve an existing technology. With reference to the blockchain example, the catalyst for the development of cryptocurrencies was a market need for secure electronic payments rather than a technical problem associated with improving security characteristics of existing banknotes.

An essential patentability criterion deployed by e.g. the European Patent Office is a technical solution of a technical problem by an invention as claimed in a patent application. In fact, the European Patent Office does neither require nor award a solution of market need.

However, a valuable invention should address a market need preferably in all technology stages. An invention that satisfies a market need is more likely to be implemented in a product or infringed by a third party and therefore has potential monetary value than an invention providing an improvement of an existing technology. In other words, the CAPEX risk associated with a given invention is reduced if the invention solves a technical problem associated with a market need rather than a technical problem associated with a technology per se. The CAPEX risk can further be reduced if taking the patent practices of the Patent Offices into account during the invention harvesting process, and to harvest inventions providing technical solutions of technical problems addressing market needs.

Lean invention approach

During the course of numerous invention harvesting projects over several years, PATENTSHIP has developed a lean invention approach based on the lean startup principles described by Eric Ries in his book *The Lean Startup: How Today's Entrepreneurs Use Continuous Innovation to Create Radically Successful Businesses* (17 October 2017). The lean startup approach is based on identifying a market need in order to build a valuable company. In order to satisfy the market need, a minimum viable product (MVP) can be designed, providing basic functionality. The MVP can be subject to further improvement in subsequent iterations in order to achieve a better market fit.

Eric Ries' lean startup approach and the innovation harvesting approach share the same starting point (ie, market need). Therefore, the principles of the lean startup can be directly exploited to systematically develop technical innovations as well. In particular, the MVP may already define a 'minimum viable invention' (MVI) that provides a first solution to the technical problem based on market need. The MVI can iteratively be improved further if necessary. Moreover, several concurring MVIs can be harvested, each forming another solution to a given technical problem. Therefore, the MVI approach can provide alternative solutions to the same technical problem and thus a plurality of technical inventions during the same invention harvesting process.

Summary

The market-driven invention harvesting scheme has been developed and successfully deployed by PATENTSHIP in a number of invention harvesting projects in emerging-technology fields such as security or 5G in recent years. The considerable number of harvested, important inventions and the high grant rate of patents protecting the harvested inventions prove the efficiency of the systematic invention harvesting concept.

Contact

PATENTSHIP
Patentanwaltsgesellschaft mbH
Elsenheimerstr. 65, 80687 Munich, Germany
Tel: +49-(0)89-75 969 869-0
Fax: +49-(0)89-75 969 869-9
www.patentship.eu

PATENTSHIP
Patent Attorneys | Munich | DE

How can Utility Models provide protection to subjects with smaller levels of "inventiveness"?

Vítor Sérgio Moreira, Patent Engineer at Inventa International, provides a case study on utility models in Angola, Brazil, Mozambique and Portugal.

Several countries allow protection of subject matters by means of Utility Models, which are generally considered as inventions having a smaller level of inventiveness. Usually, the utility models are examined by the Patent Offices according to simpler and accelerated procedures than that related to a patent application.

The utility models play an important role in developing countries, wherein this kind of protection aims to provide a significant level of protection to applicants that develop new products having some level of inventiveness. The provision of utility models also allows an initial easier use of benefits comprised in the patent system. However, some fully developed countries, as Germany, still maintain utility models in their patent system.

This study aims to compare the legal aspects of utility models in some Portuguese speaking countries, namely Angola, Brazil, Mozambique and Portugal. We also present some data related to the filing of utility models in most of the abovementioned jurisdictions. Moreover, some challenges and advances referred to substantive examinations, namely the inventiveness requirement, by the respective Patent Offices are presented.

Vítor Sérgio Moreira

Angola

Utility models are protected in Angola according to Industrial Property Law No. 3/92 of February 28, 1992. The article 15 of said IP Law defines a utility model as "[a]ny new arrangement or form obtained in or introduced into objects such as tools, work implements or utensils that improve or increase the conditions for their use and their usefulness". Furthermore, the subject matter shall meet the novelty criteria, considering that "[p]rotection shall be granted exclusively to the particular new form that makes it possible to increase and improve the utility and utilization of the objects for which it is intended".

Brazil

The IP National Law No. 9.279, of May 14, 1996 of Brazil also provides protection of inventions by utility models. According to its Article 9, "an object of practical use, or part thereof, shall be patentable as a utility model if it is susceptible of industrial application, presents a new shape or arrangement and involves inventive act, resulting in functional improvement in its use or manufacture." In comparison with patent protection, the Brazilian Law states in its Article 8, that "an object of practical use, or part thereof, shall be patentable as utility model if it is susceptible of industrial application, presents a new shape or arrangement and involves inventive act, resulting in functional improvement in its use or manufacture".

The term of a utility model in Brazil is 15 years as from the filing date.

Mozambique

Utility models are also protected in Mozambique, according to provisions of the Industrial Property Code (Decree No. 47/2015 of December 31, 2015), wherein a utility model is "an invention that gives an object or part thereof a configuration, structure, mechanism or layout resulting in a functional improvement in its utility or manufacture".

The national Law of Mozambique allows that a patent application may be converted in a utility model, provided that the applicant request said change before a substantive examination. A regional patent application, filed before African Regional Intellectual Property Organization (ARIPO), may be converted into a utility model in Mozambique, provided that the regional patent application was refused or withdrawn.

Concerning the patentability requirements, the article 97 of the national IP Law of Mozambique defines that "every invention which involves a significant inventive step and has an industrial application is eligible for protection as a utility model, with the exception of pharmaceutical and agro-pharmaceutical". Moreover, "an invention shall be deemed to have a significant inventive step if it functionally improves the utility of an object or its manufacture", according to Article 98 of the same Law.

Mozambique provides a faster and simpler prosecution of utility models applications, as is explicit in Article 101 of the national IP Law.

The duration of the utility model shall be 15 years from its filing date.

Portugal

The Portuguese IP Law also allows the protection of inventions by utility models. Regarding the patentability criteria, the invention shall have to be novel and have industrial applicability. Moreover, the invention is required to have an inventive step, wherein the invention must meet one of the following requisites:

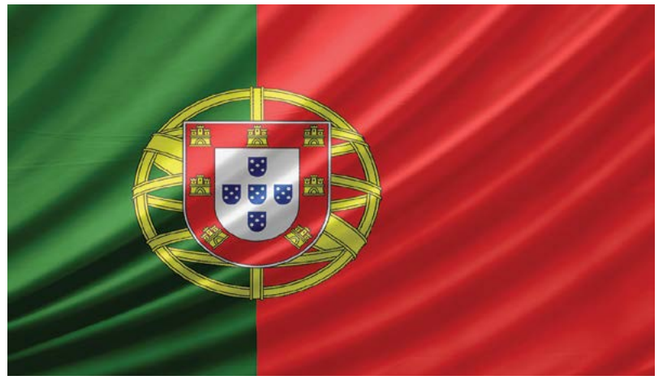
a) The invention must not be an evident result from the prior art;
b) The invention must present a practical or technical advantage for preparation or use of the product or process concerned.

Portugal also included an article in its IP National law stating that the prosecution of a utility model is simpler and accelerated than that related to a patent application. The duration of the utility model shall be until 10 years from its filing date.

Résumé

Vítor Sérgio Moreira

Vítor is a Patent Engineer at Inventa International. His solid background in Chemical Engineering enables him to take care of all patent procedures in several areas of expertise, such as pharmaceutical, oil, petrochemical and biotech industries.



A provisional patent application may be converted in a non-provisional patent application within one year from its filing date and, simultaneously, may result in a utility model application. Moreover, the European Patent Convention and the IP Portuguese Law provide the opportunity to convert a withdrawn or refused European patent application into a patent or a utility model application in Portugal.

Examining of the patentability criteria

A utility model shall be granted, when the subject matter meets the following patentability criteria: 1) industrial application; 2) novelty; and 3) "inventiveness step". The two first requisites are usually objective and do not raise any peculiar debate over them.

On the other hand, the "inventiveness step" has not a common definition among the countries evaluated. The Patent laws of Angola and Mozambique link the "inventiveness step" to functional improvement in the utility or manufacture of the object, wherein this wording does not use any expressions related to the requisite inventive step, that must be met by a patent application. Cabo Verde employs in its Patent Law the very same expression "inventive step" for utility models and patents of inventions. The Portuguese patent law sets a mixed approach, referring to a practical or technical advantage regarding the preparation or use of the product or process concerned, whereas also refers to the possibility of solving a prior art problem by means of a non-evident approach, which also may be related to a higher level of inventiveness, pertinent when referring to a patent application.

Therefore, some Patent Offices and the applicants may be faced with an unclear approach related to the examination of utility models, regarding the "inventiveness step" requisite. This challenge may be highlighted when a patent examiner normally deals with both patent and utility models applications, wherein the self-incorporation of a person skilled in the art may be impaired, leading to ununiformed decisions, which contributes to the decrease of the quality of the substantive Office actions.

> **"Mozambique allows that a patent application may be converted in a utility model."**

The Brazilian Patent Law provides some approaches that are able to mitigate these effects. Initially, its Patent Law defines the "inventiveness step" as an "inventive act, resulting in functional improvement in its use or manufacture". Furthermore, the Brazilian Patent Office has established a technical division comprised of examiners that are responsible for examining solely utility models. Besides, the Brazilian Patent Office published specific guidelines for examining utility models applications (Resolution INPI no. 85, April 9, 2013), wherein the different approaches when addressing a patent application and a utility model application are clearly defined.

The "inventive act" is illustrated with several examples and it is recommended that the examiner considers only the closest prior art document, in order to avoid an improper combination of prior art documents to raise objections against the inventive act. On the contrary, the motivated combination of teachings found in two or more prior art documents by a person skilled in the art may be a normal approach, when raising objections against fulfilling the inventive step of a patent application.

Some data related to filing of utility models

We have gathered some data regarding the number of filings of utility models in Angola and in Mozambique, after consulting the respective Official IP Bulletins published in 2019, which are illustrated in the table below, wherein it is possible to observe a small share, which is not statistically reliable, related to utility models. Anyway, the profile of the patent applicants is quite different between these two countries, wherein about 70% of the patent applicants in Mozambique are residents and only 1% of the patent applicants in Angola are residents.

According to the official statistics provided by the Portuguese Patent Office[1], in 2019 227 patent applications, 84 utility models, 569 provisional patent applications and 20 PCT entries in National phase were filed. The share of utility models is 9.3% and about overall 78% of the mentioned filings are from residents.

According to the official statistics provided by the Brazilian Patent Office[2], in 2018 24,851 patent applications and 2,589 utility model applications were filed. The share of utility models is 9.4% and 96.4% of the utility model were filed by residents.

Conclusion

The utility models may be a relevant kind of protection for the applicants that have just initiated their use of the patent system and/or have developed products that might not meet the inventive step requisite of a patent application.

The Patent Offices shall publish rules and guidelines regarding the substantive examining of utility models, as Brazilian Patent Office did, to properly distinguish the approaches followed when a utility model or a patent application is examined. These guidelines will be helpful to increase the quality of the decisions of the Patent Offices, besides making clear to the applicants the applicable rules.

Previously to creating guidelines, some Patent Offices, namely the Angolan and the Mozambican Patent Office, may initially face the challenge referred to let the benefits provided by the utility models and patent applications be better known for the residents of the respective countries.

Patent and Utility Models applications

	Sum of patent applications publications	Sum of utility models applications published	Utility Models (%)
Angola	88	1	1.1
Mozambique	44	3	6.4

(1) https://inpi.justica.gov.pt/Portals/6/PDF%20INPI/Estatisticas%20de%20propriedade%20industrial/Relat%C3%B3rios/Relat%C3%B3rios%20de%202019/Relat%C3%B3rio_Estat%C3%ADstico%20Anual%202019%20.pdf?ver=2020- 04-27-140134-987

(2) https://www.gov.br/inpi/pt-br/ acesso-a-informacao/ pasta-x/boletim-mensal/arquivos/documentos/ indicadores-de-pi_2019.pdf

Contact

Inventa International
Alameda dos Oceanos, 41,
K21 Parque das Nações,
1990-207 Lisbon, Portugal
Tel: (+351) 213 150 970/1
africa@inventa.com
www.inventa.africa

A glimpse into China's Utility Model System

Lunwei Huang, Partner and Senior Patent Attorney at Beijing Sanyou IP Agency Ltd., explains why utility models are so attractive in China and discusses their advantages and disadvantages in comparison to invention patents.

Among roughly 120 countries or regions having a utility model system or the equivalent, China is unquestionably the most attractive for utility model filers. According to data provided by China National Intellectual Property Administration, or CNIPA, there were roughly 2.27 million utility model applications filed with CNIPA in 2019, in contrast to 1.40 million invention patents (equivalent to utility patent of U.S.) applications.

So why is China this attractive for utility model filers?

1. **A large chance of being granted:**
Basically, a utility model application will be granted once it passes a formality examination, without going through a substantive examination. For this reason, there is a very large chance of a utility model application being granted. In previous years, the grant rate of utility model applications was up to 90%, nowadays, although the grant rate for utility model applications has decreased relatively, it is still as high as 75%.

Résumé

Lunwei Huang

Lunwei Huang is a Partner and Senior Patent Attorney at Beijing Sanyou IP Agency Ltd., a full-service IP law firm founded in 1986 in Beijing, P.R. China. Having worked in the IP industry for 20 year, he has a wide-ranging expertise, including patent prosecution, invalidation, reexamination, administrative and infringement litigation, patent search and analysis in the field of semiconductor, telecommunication, electronics, and computer systems, and more.

Lunwei Huang

"There were roughly 2.27 million utility model applications filed with CNIPA in 2019."

2. **Shorter examination period:**
Utility model applications are subjected only to a formality examination and mature into utility model patents after passing the formality examination. This makes for a significantly shorter examination period. On average, it takes roughly 7 months for a utility model application from filing to allowance. In contrast, it may take 3 years or more for an invention patent application from filing to allowance, as the invention patent application has to undergo both formality examination and substantive examination.

3. **Equivalent protection to invention patent:**
Although patentability requirements for utility model applications are lower than that for invention patent applications, efficacy of the two types of patent are almost the same.
Article 22 of the Chinese Patent Law reads: inventiveness means that, as compared with the prior art, the invention has prominent substantive features and represents a notable progress, and that the utility model has substantive features and presents progress. In terms of the omission of "prominent" and "notable" from the clause for utility model, the inventiveness requirement for utility model is relatively lower than that for invention patent.
On the other hand, utility models enjoy basically the same protection as invention patents. The Chinese Patent Law does not differentiate between invention patent and utility model in terms of infringement damage, and in practice, there is no significant difference between damage awarded in patent infringement litigations

With a damage of 334.8 million CNY (roughly 48 million USD) decided in the first instance.

regarding invention patents and utility model patents. In particular, some utility model patents obtained very high damage.

In 2009, CHINT, a Chinese company, sued Schneider for infringement of its utility model patent involving a circuit breaker, with a damage of 334.8 million CNY (roughly 48 million USD) decided in the first instance, which was a record high amount in the IP history of China. This case ultimately ended in a settlement, with Schneider paying 157.5 million CNY (roughly 22.5 million USD) to CHINT.

In 2015, in the case Hangzhou Naide vs. Dongguan Chuangheng for Utility Model patent infringement, Shanghai IP Court decided a damage of 1 million CNY based on statutory damage, which is the cap of statutory damage.

4. **No restriction on enforcement of utility model patents:**
Since utility models are granted a patent right without going through a substantive examination, and therefore technically the utility model patents are in uncertain situation, some countries pose restrictions on enforcement of utility model patents.
In Germany, the patentee of a utility model patent shall, if the utility model patent is invalidated by another one, bear the official fees and attorney fees connected with the invalidation.
In Japan, anyone can request the patent office to conduct a patentability evaluation on a utility model patent, and if the patentee of a utility model sues or warns another one for infringement and ultimately the utility model patent is revoked, the patentee has to compensate the sued or warned one for any loss caused thereby.
In comparison to Germany and Japan, China poses no special restriction on utility model patents. Although the patentee of a utility model patent may be required to furnish an evaluation report of the utility model patent to initiate a litigation process, he is not accountable for any expense or loss brought about to the defendant if the utility model turns out to be revoked.

The advantageous aspect of "dual application"

There is yet another advantageous aspect of the utility model, the so-called "dual application" approach. One can file an invention patent application and a utility model application simultaneously for the same invention. The utility model application will be granted quickly, as it does not need to undergo a substantive examination, resulting in a potentially unstable patent right. On the other hand, it will take a rather long time for the invention patent application to go through the substantive examination to be granted, but resulting in a fairly stable patent right. In this way, the applicant may acquire and enforce the utility model patent shortly after filing the applications, and when the invention patent application is afterwards granted, the applicant may choose to abandon the utility model patent and keep the invention patent, i.e., the substantively examined, stable patent right. In such a "dual application" approach, one can take advantages of both utility model and invention patent, with both quick grant of patent application and stability of patent right.

For those reasons, the number of utility model applications in China keeps increasing. A surprising fact is that the applications for utility model in China accounts for roughly 95% of the globally overall number, which has invoked some rethinking in the administrative and academic circles. Some voices say there is a serious mismatch between the number of patents and the country's scientific and technological strength, and some voices say the utility model patents include too many "low-quality" patents.

In this context, CNIPA is gradually tightening its examination criterion for utility model applications.

"Obvious novelty examination"

As of October 2013, the Chinese patent office introduced an "obvious novelty examination" to utility model applications. From then on, the examiner had to determine whether a utility model application is obviously lacking novelty on a random basis, i.e., a randomly chosen part of utility model applications went through such a novelty examination, which involved a prior art search. For facilitating this novelty examination, the CNIPA developed an AI-based searching system, which can search prior art documents close to an application and present them to the examiner in a quick and convenient manner. The CNIPA further developed a system for automatically detecting formality defects in a utility model application, which is much more efficient than human examination.

There used to be incentives provided by local governments for patent filings, however, in this trend to "improve patent quality", such incentives for utility model filings have been ceased.

In addition, the CNIPA applied a restriction to the "dual application". As afore-mentioned, one can file an invention patent application and a utility model application simultaneously for the same invention. But according to the latest examination practice of CNIPA, for such a dual application, the examination of the invention patent application will be postponed.

In this trend to "improve patent quality", the grant rate for utility model applications has decreased in recent years. According to statistic data from CNIPA, in 2016, the grant rate for utility model applications was 90%, which means in 100 utility model applications, 90 of them were granted, and 10 of them were ultimately rejected. This figure decreased to 75% in 2019.

Nevertheless, in spite of the above restrictions applied, the advantageous aspects of utility model are not substantially impaired, utility model application is still a considerable option, especially for foreign applicants.

However, a fact is that foreign applicants are not so keen on filing utility model application in China. In recent years, the yearly number of utility model applications filed by foreign applicants in China remained at the order of 7000, accounting for roughly 0.4% of the yearly total number of utility model applications field in China. In contrast, the yearly number of invention patent applications filed by foreign applicants in 2019 accounted for roughly 12% of the total number. To some extent, it can be said that utility models are overlooked by foreign applicants. Filing for a utility model application in China should be considered in a case where a quick grant is preferred, and a long protection period is not desired.

Finally, before deciding to apply for a utility model in China, these are factors that needed to be taken into consideration:

1. Utility model patents have a protection period of 10 years, counting from the filing date. In contrast, the protection period is 20 years for an invention patent. Therefore, if a longer protection period is desired an invention patent is the desirable choice.

2. China's utility models protect only inventions related to the shape or structure of a product. Methods or processes are not protected by utility models. Therefore, for inventions involving a new method, new material, computer program, etc., there is no choice but to apply for an invention patent.

This being said, utility model applications in China should not be overlooked by foreign applicants that exclude the above criteria.

Contact

Beijing Sanyou Intellectual Property Agency Ltd.
16th Fl. Block A, Corporate Square,
No.35 Jinrong Street, Beijing, 100033,
P.R. China
Tel: 86-10-88091921,88091922
sanyou@sanyouip.com

Applications for utility model in China accounts for roughly 95% of the globally overall number.

Movement towards a paperless system: what does this mean for patent rules?

DPS Parmar, Special Counsel at LexOrbis, seeks clarity on "electronic transmission duly authenticated" in light of increasing use and COVID-19.

When the Patent Office adopted the paperless system, its aim was to do away with any practice which promote filing of original or signed in ink or paper documents. The amendment in 2003 of the Patent Rule 6, relating to leaving and serving documents to include "by electronic transmission duly authenticated", was supposed to be deem sufficient to meet the requirement of leaving or serving the document at the Patent Office. Later amendment to this rule in 2006 did away with submitting the original copies in paper form within one month. Certain requirements, like submission of Power of Attorney, submission of certified documents of priority and submission of verified translation of priority document, need a signature in ink and the Office accept the scanned copies thereof through e-transmission. There is still some hesitation in the IPO to accept the e-signed or authenticated documents. The Indian Patent Office in certain cases raise objections and insist to submit the duly signed paper copies as well.

DPS Parmar

Résumé

Mr. DPS Parmar, Special Counsel

Mr. DPS Parmar heads the Intellectual Property Appellate Board (IPAB) practice group at LexOrbis. After joining the IPAB as Technical Member (Patents) in 2011, he has been instrumental in writing some path breaking and insightful decisions on Indian patent law issues. These include establishing legal positions on excluded subject matter under Section 3(d), 3(i) and 3(k), divisional applications, disclosure requirements under Section 8, working statements and compulsory license, to name a few. Before joining IPAB, Mr. Parmar worked with the Indian Patent Office (IPO) for over 27 years and had played a vital role both at the administrative and policy levels. He represented India at various rounds of discussions organized by the World Intellectual Property Organization (WIPO) and attended follow-on programs at the European and Japanese Patent Offices. He was instrumental in the recognition of IPO as the 15th ISA and IPEA under the Patent Cooperation Treaty (PCT). He also served as the head of the Intellectual Property Training Institute (IPTI) in Nagpur, which was responsible for providing training to new examiners at the IPO.

The meaning of "electronic transmission duly authenticated"

The Patent Rule 2003 do not seek to define what is meant by "electronic transmission duly authenticated". An attempt to provide meaning to this term was made through the draft Patent amendment rules 2015 under Rule 2(ca):

"Electronic transmission duly authenticated" means authentication by digital signature as per section 5 of the Information Technology Act, 2000 (21 of 2000)"

However, this definition was not adopted in the final text of the Patent (amendment) Rules 2016, leaving it at the discretion of IPO to interpret and determine the scope of its application under the Patent Act. In absence of any definition different interpretations are given to "electronic transmission duly authenticated", and at times the objections are raised to resubmit the duly signed paper documents as well even after filing such document using e-filling route. According to the Patent Office Manual:

"A patent agent shall file, leave, make or give all documents only by electronic transmission duly authenticated, including scanned copies of documents that are required to be submitted in original.

Provided that the original documents that are required to be submitted in original, shall be submitted within a period of fifteen days, failing which such documents shall be deemed not to have been filed."

Authentication of electronic records under The IT Act 2000

It must be noted that when the Patent Act does not describe the preconditions for a valid authentication, it is a matter that would be decided by the court in which such authentication is questioned based on local law. If we see section 5 and 6 of the IT Act 2000, we find clearly the position of legal recognition of electronic signature that clearly and unambiguously provides for acceptance of electronically signed documents under any law in force in India which requires the said document to be signed by affixing a hand written signature.

"[5.] Legal recognition of [electronic signatures].—Where any law provides that information or any other matter shall be authenticated by affixing the signature or any document shall be signed or bear the signature of any person, then, notwithstanding anything contained in such law, such requirement shall be deemed to have been satisfied, if such information or matter is authenticated by means of [electronic signature] affixed in such manner as may be prescribed by the Central Government.

Explanation.–For the purposes of this section, signed, with its grammatical variations and cognate expressions, shall, with reference to a person, mean affixing of his hand written signature or any mark on any document and the expression signature shall be construed accordingly."

> **"Any alteration to the electronic signature made after affixing such signature is detectable."**

Additionally, the provisions of Section 6 of the IT Act 2000, which applies to the Government and its agencies mandates the acceptance of any form, application or any other document filed with any office, authority, body or agency, if the said form, application or documents is signed with electronic signature and filed electronically.

"[6.] Use of electronic records and [electronic signatures] in Government and its agencies. (1) Where any law provides for:

(a) The filing of any form, application or any other document with any office, authority, body or agency owned or controlled by the appropriate Government in a particular manner.

(b) The issue or grant of any licence, permit, sanction or approval by whatever name called in a particular manner.

(c) The receipt or payment of money in a particular manner, then, notwithstanding anything contained in any other law for the time being in force, such requirement shall be deemed to have been satisfied if such filing, issue, grant, receipt or payment, as the case may be, is effected by means of such electronic form as may be prescribed by the appropriate Government."

Accordingly, in absence of any definition or meaning given to "by electronic transmission duly authenticated" in patent acts and rule, the provision of the IT Act 2000 shall apply for submission of documents through the e-filling route. Interestingly, a patent agent can file, leave, make, or give all documents only by electronic transmission duly authenticated. Accordingly, only the documents where the submission of original document is mandatory, the e-filing of the scanned copy shall be followed by sending the paper copy within 15 days from submission of e-copy. That means certified copy of the priority document and POA shall be filed in original even after filing the scanned e-copy.

Form and scope of digital signature

If we look at the form and scope digital signature in the IT Act 2000, it provides definition of "digital signature", "electronic signature", and provision on Authentication of electronic records.

"(p) "Digital signature" means authentication of any electronic record by a subscriber by means of an electronic method or procedure in accordance with the provisions of section 3.

(ta) "Electronic signature" means authentication of any electronic record by a subscriber by means of the electronic technique specified in the Second Schedule and includes digital signature.

(3) Authentication of electronic records.

(1) Subject to the provisions of this section, any subscriber may authenticate an electronic record by affixing his digital signature.

(2) Any person by the use of a public key of the subscriber can verify the electronic record.

(3) The private key and the public key are unique to the subscriber and constitute a functioning key pair."

(3A) Electronic signature. -

"(1) Notwithstanding anything contained in section 3, but subject to the provisions of sub-section (2), a subscriber may authenticate any electronic record by such electronic signature or electronic authentication technique which:

(a) Is considered reliable.

(b) May be specified in the Second Schedule.

(2) For the purposes of this section any electronic signature or electronic authentication technique shall be considered reliable if:

(a) The signature creation data or the authentication data are, within the context in which they are used, linked to the signatory or, as the case may be, the authenticator and to no other person.

(b) The signature creation data or the authentication data were, at the time of signing, under the control of the signatory or, as the case may be, the authenticator and of no other person.

(c) Any alteration to the electronic signature made after affixing such signature is detectable.

(d) Any alteration to the information made after its authentication by electronic signature is detectable.

(e) It fulfils such other conditions which may be prescribed.

> **In such situations, the only option left would be to digitally sign the electronic document.**

(3) The Central Government may prescribe the procedure for the purpose of ascertaining **whether electronic signature is that of the person by whom it is purported to have been affixed or authenticated.**

(4) The Central Government may, by notification in the Official Gazette, add to or omit any electronic signature or electronic authentication technique and the procedure for affixing such signature from the Second Schedule: Provided that no electronic signature or authentication technique shall be specified in the Second Schedule unless such signature or technique is reliable."

That being the provision of affixing digital signature and electronic signature, the procedure of Rule 6 for submission of document "by electronic transmission duly authenticated" would be deemed to be satisfied, if the provisions of the IT Act 2000 have been followed. The only condition the submitted document must satisfy is that the procedure prescribe by The Central Government/or IPO, for the purpose of ascertaining whether electronic signature is that of the person by whom it is purported to have been affixed or authenticated by, is followed.

Typing of documents mandatory

According to rule 9: "All documents and copies of the documents, except affidavits and drawings, filed with patent office, shall:

(a) **be typewritten or printed in Hindi or English** (unless otherwise directed or … allowed by the Controller) …"

That means handwritten manuscripts of any document, even if bearing the signature of the sender, will not be accepted except where the Controller so directs. That includes the scanned copy of such document. In normal situation, such procedural requirements can be meet but when in a lockdown situation, like one due to COVID-19 pandemic, where all persons are confined to work from home, one cannot expect every person to have a printer or scanner. Moreover, due to security reasons and the electronic system used, particularly by patent law firms, the use of copying on other devices is forbidden. In such situations, the only option left would be to digitally sign the electronic document. It is not possible to get the printed copy for signing in ink and then scan and send such document as required by the patent rules.

Digitally signed documents as evidence

It may also be seen that the provision of digital signature mandate match with provisions of section 3(2),47A and 67A of The Indian Evidence Act 1872 .

Section 3: interpretation – clause

"2. All documents including electronic records produced for the inspection of the Court; such documents are called documentary evidence."

Section 47A: opinion as to digital signature where relevant

"When the Court has to form an opinion as **to the electronic signature of any person, the opinion of the Certifying Authority** which has issued the electronic Signature Certificate is a relevant fact."

Section 67A: proof as to electronic signature

"Except in the case of a secure electronic signature, if the electronic signature of any subscriber is alleged to have been affixed to an electronic record the fact that such electronic signature is the electronic signature of the subscriber must be proved."

Combine reading of both the IT Act 2000 and The Indian Evidence Act allows the use of digital signature for authentication of documents. Therefore, IPO should give a meaningful interpretation for digital signature applied on the documents sent through the e-filing route without raising objections. Additional enquiry to obtain the original signed copy require by IPO can be avoided at least during COVID-19 situations.

> **An expert's advice in this matter would be handy to avoid objections from IPO.**

Way forward

It is not possible to change the rules immediately to accommodate the difficulty faced in meeting certain requirement of the rules where verification or authentication of document is required. However, in a paperless system there is a need to interpret the rules, which facilitate the inventors to meet the requirement of rules. Therefore, it is imperative for IPO to allow all digitally signed document filed in connection patent applications at least until the normal working is resumed. A PDF of the document signed using Digital Signature Certificate (DSC) is normally preferred. An expert's advice in this matter would be handy to avoid objections from IPO.

Contact

LexOrbis
709/ 710, Tolstoy House, 15-17,
Tolstoy Marg, New Delhi, Delhi 110001,
India
Tel: +91 11 2371 6565
www.lexorbis.com

Finding the right Knowledge Management solution for you

Caitlin Kavanagh, Marketing Manager at Minesoft, explains how Pat-KM, Minesoft's Knowledge Management solution, can make your workflow work for you.

For any innovation-driven industry, it's crucial to be aware of the IP landscape in your technology area. For example, consider the fact that 70-80% of scientific and technological information is available only in patents – by not monitoring this effectively, how much actionable intelligence is your company missing out on?

The rate of new inventions has been continuing to increase, for example, the European Patent Office (EPO) reported a 4% increase in patent applications in 2019 compared to 2018, and a new all-time high. As a result, investing in resources to take advantage of this knowledge mine remains hugely important for any innovative companies, regardless of whether it's an SME or multi-national corporation. By ignoring and/or undervaluing IP, businesses can be driven into risky situations; such as opening up your company to infringement proceedings which could result in further loss of profits and harm your long-term corporate survivability, or the possibility of competitors taking advantage of your own technological innovations.

Patent Knowledge Management

IP Knowledge Management processes help to avoid or mitigate these challenges by providing a system to monitor the IP landscape and direct relevant documents between departmental experts in a configurable manner that suits a range of scenarios.

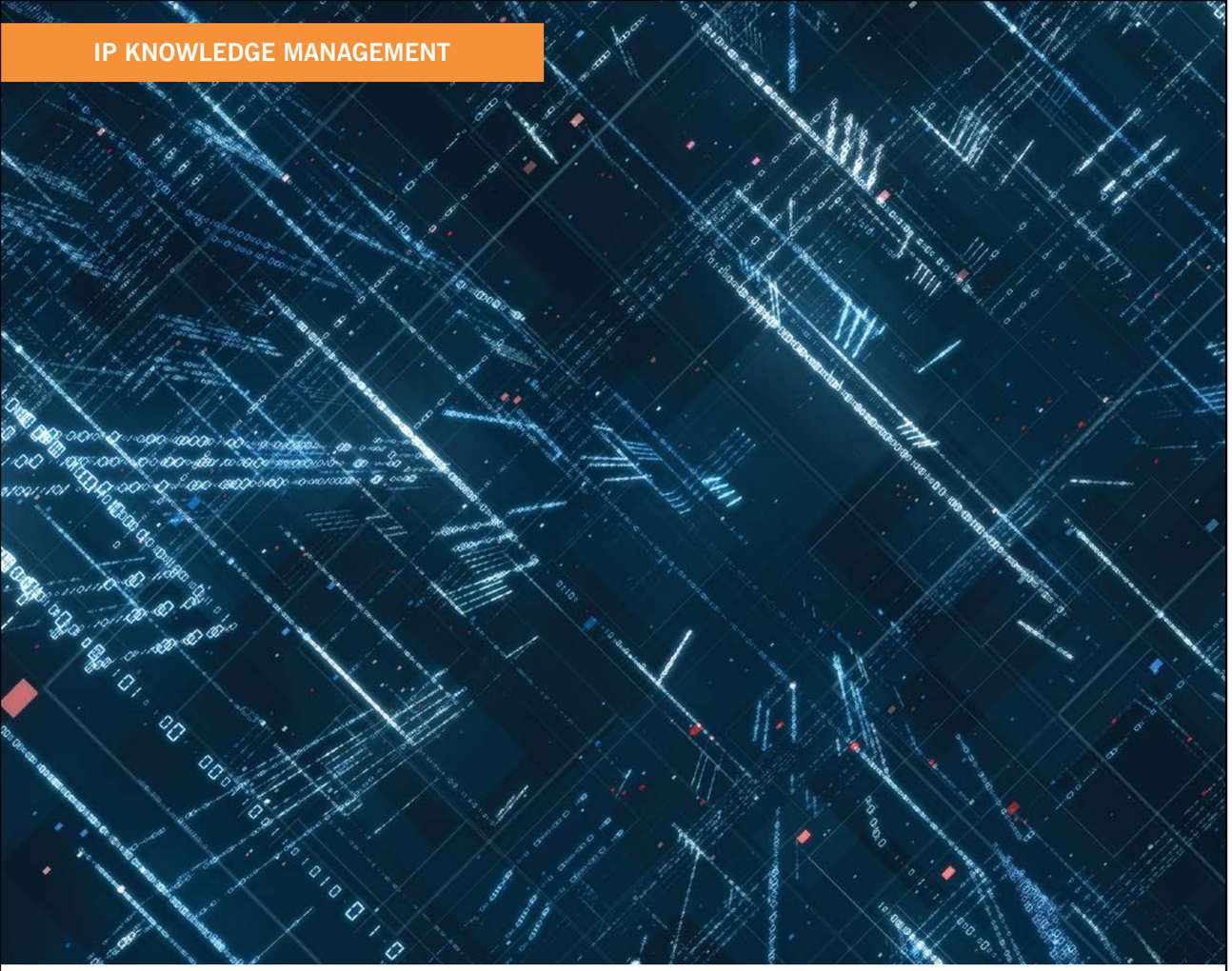
Patents are indicative of modern innovation trends. In addition, they contain important technical information as applicants must describe and explain their inventions in a clear and complete way. Hence, the core requirement of IP Knowledge Management systems is frequently to ensure that a company's R&D team are kept aware of emerging trends and the actions of the competition; ensuring that their current projects are "on-trend" whilst avoiding potential duplication. Many available patent databases already perform this function, with the ability to set-up alerts which monitor new applications and granted patent documents as they occur and send out the pertinent information to approved recipients.

Caitlin Kavanagh

> **"Our "off-the-shelf" system is relied on by some of the world's best-known and leading companies."**

However, the quality of the underlying searchable database of patents is certainly going to have an effect on the decision-making and only a few companies worldwide have concentrated their efforts on this niche, challenging, detailed sector. IP Knowledge Management tools have the functionality to take this workflow further, involving other branches of your organisation and therefore facilitating knowledge sharing across multiple departments. For example, once the results of an alert have been reviewed by the technical teams, specific records can be forwarded to the legal department if a member of the technical team believes that a potential breach has been identified. Alternatively, identified competitor action, as foreshadowed by newly published patents, might be forwarded to the Executive branch to inform future offensive or defensive strategy; to counter emerging threats or capitalise on opportunities to outmanoeuvre competitors.

Internal documents such as search or examination reports, case studies or value-added information like commercial reports on a specific assignee can be linked to a patent family; providing additional insights beyond the patent data alone. Minesoft's Knowledge Management solution – Pat-KM – is adaptable to the customers' needs. Pat-KM incorporates internal company workflows and custom taxonomies to help manage patent knowledge globally throughout the organisation. Our "off-the-shelf" system is relied on by some of the world's best-known and leading companies.



Pat-KM is a comprehensive software solution with the benefit of patent search and analysis tools plus your own searchable and classification fields and rules. Users can benefit from access to comprehensive, shareable and searchable legal status information, citation tracking tools, high-quality machine translations and more...

Transforming the workflow life cycle

Patents offer a well-codified, fully searchable and readily available pool of competitive intelligence waiting to be exploited. Those diving in are faced with challenges of volume and accessibility, but perseverance and employment of specialist databases and advanced Knowledge Management systems, such as Pat-KM, that automate many of the processes will pay off in terms of the wealth of insights gained.

Let's imagine that a company is preparing a project to break into a new technology area. A Freedom to Operate (FTO) search has already been completed and determined that there are currently no existing patents that will be infringed by the new innovation.

> **Pat-KM is not an out-of-the-box solution, it is designed to be highly customisable to meet the individual needs of every customer.**

With the deployment of Pat-KM, the Knowledge Management team can work alongside the Technical team to set up relevant alerts for the new technology area that they are entering, these alerts can continue to monitor the area to ensure that high-risk patents aren't being granted in jurisdictions of interest. Should a new patent emerge before the project is complete, it may well be more cost-effective to abandon the internal project and seek a licence rather than continue and risk infringement in key jurisdictions!

In this situation, users will need the ability to view the legal status of a patent across multiple jurisdictions, revealing whether their key commercial locations are still open to them. A patent that doesn't cover where you operate should be monitored to ensure additional documents aren't filed in those countries but might not be the death knell for your own project.

In this workflow, the alert results could move out to recipients automatically. However, some companies might prefer to tailor their Knowledge Management system to route all information via the Intellectual Property team

by a manual process; should tighter control be a requirement for your business processes. Pat-KM is not an out-of-the-box solution, it is designed to be highly customisable to meet the individual needs of every customer.

Gaining actionable business & competitive intelligence

Exporting this additional data alongside patent data is crucial for reporting purposes. The Archive Snapshot tool grants the ability to run analytics on the patent families and tagging behaviour of your users within the archive. This allows for additional insights to be retrieved from your data and easy assessment on how effectively your current workflow design is meeting your requirements.

Pat-KM acts as a fully separated overlay to a searchable patent resource such as PatBase, securing and archiving competitive intelligence and internal information and placing a powerful set of patent searching and competitive intelligence tools into the hands of company executives; at the same time acting as a place to centralise their in-house special expertise in their technology sector.

Analysing patent information will help an organisation to improve its overall understanding, not only about competitors but about where it sits in relation to the global field of activity. Importantly, it can give a more informed basis for business decisions about the future direction of the company and due to this, patent information and patent analysis is being given more weight in boardrooms.

Newly launched PatBase Analytics V3 provides a comprehensive strategic overview of your own and your competitor' patent portfolios to better understand current and future opportunities and threats. Effective use of this software can produce an accurate description of key players in the marketplace, provide early warning on competitor strategies and general commercial activities, as well as identifying 'white space' in overcrowded technology areas.

Users can take these insights and create visually appealing reports that communicate the results clearly for decision-makers in a boardroom environment. Nicely presented, well-constructed visualisations will allow decision-makers and data specialists to work together with a full and complete understanding between them, with the option to include specific specialist knowledge entered by system users within exported data.

> **Provide early warning on competitor strategies and general commercial activities.**

Conclusion

Protecting, monitoring and investing in your company's intellectual property is beneficial to companies of all sizes. IP protection is crucial to avoid having your unique ideas, products or services infringed upon. Even huge corporations can have their ideas infringed upon, requiring multi-million-pound lawsuits; the massive on-going disputes between technology giants are an active example of the vast amounts of money spent on and the importance of protecting IP.

In addition to this, patents are the most comprehensive source of ideas available and therefore invaluable for an effective R&D strategy, as well as competitive and business intelligence purposes, giving a company advanced warning of emerging threats and opportunities. The retrieval and assessment of patent data provides insights into competitor activity, potential collaborators, and technology trends as well as competitor activity. It's crucial to share this information in a manner that is easily understandable, contains the correct amount of information and can either lead to inspirational discussions or ground-breaking ideas.

Pat-KM used together with a searchable database such as PatBase provides access to global patent data with integrated workflow for monitoring, classification and dissemination of relevant patent records. As a Knowledge Management system, it represents an evolution away from the usual one-size-fits-all solution towards a more bespoke approach that can adapt and change based on client needs and feedback to changing scenarios.

Contact

Minesoft
Shearwater House, The Green,
Richmond-upon-Thames,
London, TW9 1PX
Tel: +44 (0)20 8404 0651
info@minesoft.com

SPC's in Poland - where are we after 16 years??

Magdalena Tagowska, Head of Patents at Patpol, examines the progression of Supplementary Protection Certificate's in Poland with an evaluation of their development over time.

The pharmaceutical industry is very important for the Polish economy. The Polish pharmaceutical market is among the largest markets in Europe with the annual turnover amounting to approximately 8,7 billion EUR (IQVIA, January 2018). The high value of the total turnover does not, however, correspond to the per capita spending on medicines, which is one of the lowest in the European Union and hardly exceeds 200 EUR. For many years now, Poland has been qualified as one of the "Pharmerging" markets, which means that further growth of the pharmaceutical market is to be expected, although it is not going to be as dynamic as in the previous decade.

The importance of the pharmaceutical sector has also been reflected in the IP rights prosecution and their enforcement in Poland. The patent term extension has become one of the most important tools of IP right protection for the pharmaceuticals in Poland.

Patent protection provides twenty years of market exclusivity for an invention covered by a patent, starting from the patent application filing date. This exclusivity period can be extended by applying for the grant of a Supplementary Protection Certificate (SPC). This extension is, of course, limited to medicinal and plant protection products.

The idea underlaying the SPC is to compensate the patent owners for the loss of time in the effective patent protection, resulting from marketing authorization process necessary to put the medicinal or plant protection product on the market. In order to obtain such a marketing authorization, time-consuming experimental investigations and long administrative procedures need to be implemented. These procedures significantly limit the duration of the monopoly resulting from the patent protection.

Dr Magdalena Tagowska

> **The idea underlaying the SPC is to compensate the patent owners for the loss of time.**

Introduction of the SPC has enhanced the IP protection of medicinal and plant protection products, by awarding additional protection, which begins after patent expiry. This extra protection, even though limited to a specific product that has been subject to a marketing authorization, lasts up to five years. Moreover, in case of medicinal products it can be further extended by six additional months (the so-called paediatric extension of the SPC). However, the paediatric extension is only available if specific formal requirements related to paediatric clinical trials are fulfilled.

The idea of patent term extension in a form of the SPC has been present in the Polish patent law system for over 16 years, i.e. from Poland's accession to the European Union. The SPC is a protection right for medicinal and plant protection products, which can be granted in all European Union member states, including Poland, based on the following EU regulations:

- Regulation (EC) No 469/2009 of the European Parliament and of the Council of 6 May 2009 concerning the supplementary protection certificate for medicinal products, which has replaced Council Regulation (EEC) No 1768/92, and
- Regulation (EC) No 1610/96 of the European Parliament and of the Council of 23 July 1996 concerning the creation of a supplementary protection certificate for plant protection products.

Even though the EU regulations are directly applicable in all EU member states, this specific form of protection was also implemented by the Polish legislation body into the Polish regulations (Art. 751 – 7510 of the Act of 30 June 2000 on Industrial Property Law and the corresponding implementing regulations). Therefore, the SPC protection is now well established in the Polish legal system, wherein it is known as a supplementary protection right and not a supplementary protection certificate.

Since the SPC has been established by the EU regulations, any interpretational issues regarding the SPC grant requirements raised by different courts and authorities from the EU member states, has been resolved by the Court of Justice of the European Union (CJEU). This resulted in numerous judgments of the CJEU, whose aim has been to clarify the requirements for SPC grant and guarantee the uniform application of said requirements in all the EU member states. The CJEU judgments have, on one hand, settled many problematic issues related to the SPCs, but on the other they have also raised further question regarding the SPC grant requirements. Moreover, even though the provisions of the SPC regulations seem straight forward, the evolving case law of the CJEU shows that matters concerning the SPC are not always that simple and require additional explanation.

In Poland the competent authority for examination of the SPC applications, as well as the SPC paediatric extension applications, is the Polish Patent Office (PPO). Since 2004, the PPO has examined over 630 SPC applications and granted over 350 SPCs. In most of these cases, the SPC and paediatric extension grant procedures proceed undisturbed, without any stressful upheavals. However, despite the fact that a quite significant number of SPCs have been already examined and granted by the PPO's Examiners, we have to be prepared that, from time to time, some unexpected objection will be raised during SPC examination, although these objections are not in fact supported by any regulations.

> **Since 2004, the PPO has examined over 630 SPC applications and granted over 350 SPCs.**

During the SPC application prosecution one of the most often raised objections is based on Art. 3(a) of the SPC regulations. It means that the PPO Examiners very often question whether the product, in the meaning of an active ingredient or a combination of active ingredients, is protected by a patent in force. Therefore, it is very important to indicate in the request for grant of the SPC, where in the claims of the basic patent, i.e. the patent, which serves as the basis for the SPC grant, protection of the product is provided.

However, sometimes, even a very thorough explanation of the scope of protection provided by the basic patent will not be helpful in overcoming this type objection. In one of the recent cases, the SPC application for a combination of active ingredients was rejected, because the basic patent did not refer, in the patent claims, to one of the active ingredients as possibly being in a form of a pharmaceutically acceptable salt. Such a definition of one of the active ingredients was contrary to what was indicated in the first marketing authorization. The patent claim supporting this SPC application covered a combination of substance X or its pharmaceutically acceptable salt (a novel compound), and substance Y, an active ingredient well-known from the prior art. Also, in the prior art it was known that substance Y was widely used as an acid addition salt. Therefore, the skilled person would have, without any doubts, considered substance Y, as defined in the patent claims, to also cover the pharmaceutically acceptable salts thereof.

The PPO did not share this opinion and issued a rejecting decision. Moreover, this SPC application went through the re-examination stage at the PPO lever without a success. This case was subsequently examined by the Regional Administrative Court, which surprisingly agreed with the decision of the PPO, even though such interpretation of Art. 3(a) of the SPC regulations is clearly contrary to the rulings of the CJEU. The case is not resolved, however, and currently is awaiting the hearing at the Highest Administrative Court, which will hopefully reverse both decisions, the decision of the Regional Administrative Court and the PPO.

In the SPC application proceedings we may even encounter a situation, in which the PPO will raise an objection based on Art. 3(a) of the SPC regulations, by referring to a different SPC application. The PPO finds it, in general, difficult to grant SPCs in cases wherein two different patent holders try to obtain protection for the same product, based on the same marketing authorization, but based on different basic patents. This in itself is very disturbing, since such a possibility is acknowledged in Art. 3(2) of Regulation (EC) No 1610/96 and confirmed as applicable to medicinal products in one of the CJEU verdicts. However, what is even more surprising, in such a situation we may even be presented with an objection based on Art 3(a), because according to the PPO it is unlikely that

Résumé

Dr Magdalena Tagowska, Head of Patents at Patpol

Magdalena Tagowska, PH.D., specializes in the prosecution of patents in the field of chemistry, pharmacy and biotechnology, as well as, obtaining SPC's, *inter partes* proceedings before the Patent Office as well as administrative courts. She is a co-author of scientific publications in the field of electrochemistry and nanostructures, as well as publications related to industrial property. PH.D in chemistry, graduate of Warsaw University, as well as, the American Studies Center at Warsaw University. She is a member of the Polish Chamber of Patent and Trademark Attorneys.

> **After 16 years, the SPC prosecution in Poland has become a little easier.**

two different basic patents protect the same product. Therefore, in the PPO's view the product is not protected by the basic patent.

Fulfilment of Art. 3(a) requirement is also problematic in cases of product-by-process claims. This type of claim is granted in rare situations and should be considered as covering the product per se. However, according the PPO when such a claim constitutes a basis for an SPC, the product definition in the SPC application should be limited to the specific process, which is used to obtain this product. Therefore, the SPC protection is granted not for the product as such, but for the product manufactured by a specific method disclosed in the basic patent. Unfortunately, this position of the PPO was not reviewed by the administrative courts.

Another issue, which arises quite often during examination of the SPC applications before the PPO is the issue of the first marketing authorization, i.e. an objection based on Art. 3(d) of the SPC regulations. Grant of an SPC application can be refused, if a similar medicinal product is already on the market, even if the PPO is unable to present the marketing authorization for the product it juxtaposes as allegedly similar and already placed on the market.

The SPC application can also be rejected if the product comprises an active ingredient, which was a component of a product which was placed on the market earlier. In one of the cases, the PPO has even rejected an SPC application for a product consisting of one active ingredient - A, because there was an earlier marketing authorization covering a composition comprising A in combination with other active ingredients - A+A'+A". Moreover, both marketing authorizations were issued with respect to completely different therapeutic indications. In this case, the PPO failed to notice a difference between the product comprising only A as the sole active ingredient and the product covered by an earlier marketing authorization comprising several active ingredients including A, which in the meaning of Art 1 of the SPC regulations should be considered as a different product. Fortunately, this decision was already reversed during re-examination proceedings.

The examination of the request for paediatric extension of the SPC can also bring about unexpected problems. Even though, paediatric extension is a mere formality when all requirements for grant thereof are fulfilled, the PPO sometimes tends to re-examine validity of the already granted SPC before paediatric extension is granted. In one of the cases, request for paediatric extension was even not allowed, because in view of the PPO's Examiner, the SPC itself did not meet the grant requirements. The PPO did not take into consideration the fact that such objections should have been raised in the SPC invalidation proceedings and not in the proceedings related to the paediatric extension, which did not take place simultaneously. Nevertheless, after initial rejection, the SPC term extension was granted in the re-examination proceedings.

It also should be mentioned that the practice developed by the PPO with respect to the SPCs has also influenced the examination of patent applications related to pharmaceutical inventions. Although it is completely unjustified, the PPO sometimes refers to the judgments of the CJEU related to the SPC or the preamble of the SPC regulations, while examining the patentability requirement. Moreover, we can also observe that SPC applications and their content are often used as an argument by parties attempting to invalidate the basic patents either, as grounds for legal interest, or as argument undermining patentability. This practice is also unjustified, nevertheless it has become quite common in case of pharmaceutical patents.

Therefore, in addition to the problematic issues resulting from the SPC regulations and the CJEU judgments, in Poland we can sometimes encounter some additional problems, for which it is very difficult to any support in the regulations. However, we observe that over the years a number of unexpected and groundless objections has decreased significantly and most of these objections are either overcome during prosecution or re-examination proceedings. Therefore, it seems that after 16 years, the SPC prosecution in Poland has become a little easier.

Contact

Patpol - European and Polish Patent and Trade Mark Attorneys
162J, Nowoursynowska Str.,
02-776 Warsaw, Poland
Tel. +48 22 546 91 00
www.patpol.pl

Insolvable problems arise with common ownership of patents

Nataliya Nazarova, Agreement's Lawyer at Zuykov & Partners LLC, explains the principles of co-ownership patents with advice on the drawbacks that must be considered.

The process of creating an intellectual property object and its further patenting is often a creative and interesting process. The result of a longstanding co-authored work is finally patented, and the time has come to put into practice, for example, a specific technical solution. It is wonderful when a team of authors and further patent holders are a well-coordinated mechanism and practical application will also not cause complications associated with the lack of agreements between patent holders.

However, in practice there is a wide variety of situations and the process of patent ownership is the cause of insolvable problems for patent holders.

It should be noted that in addition to creating an object in co-authorship, the common ownership of the exclusive right may arise in the order of succession if the exclusive right passes by law, or by will, to two or more heirs. Also, joint possession may arise in the event of the acquisition of the exclusive right by one of the spouses, if joint possession is applied to property acquired during marriage. And finally, co-ownership may arise as a result of the reorganization of a company, that is the patent holder, through division or spin-off if, according to the transfer act, the exclusive right to a patent belongs to two or more companies.

Further, according to the alienation agreement, rights can be transferred to several companies or individuals.

Co-ownership of a patent may also arise on the basis of a contract in cases where, for example, the developer and the customer are working together and, according to the contract of copyright order, the resulting right to a patent will be a common right.

Nataliya Nazarova

> **The process of patent ownership is the cause of insolvable problems.**

In other words, there are several reasons for the emergence of common ownership of a patent, however, in both cases, as a result of common use, one or another problem may arise.

For example, when co-creating a patent, one of the patent holders is a person of advanced age, and further "incorporation" of his brainchild into a certain business process is extremely difficult for him. Or when patent holders have

Résumé

Nataliya Nazarova, Agreement's Lawyer

Natalia graduated from the legal faculty of the Moscow Institute of Economics and Enterprise and gained a Specialist degree of Jurisprudence. Natalia has worked with Zuykov and partners LLC since 2015, and specializes on: preparation and filing for registration of licensing, sublicensing, franchise, assignment agreements of the exclusive rights, pledge agreements; amendments to an agreement, cancelation of the above mentioned agreements; correspondence with customers of the company. Natalia's experience in the legal sphere is more than 10 years. Between 2010–2015 Natalia Lawyered for the closed JSC "IPPRO" with specialization on contract registrations and legal representation in Intellectual Property Court, arbitration courts and courts of General jurisdiction for the protection of exclusive rights on objects of intellectual property.

> **There are several reasons for the emergence of common ownership of a patent.**

their own vision for the future use of the patent and in such a situation the question of co-ownership will not be helpful, but resistant and prove impossible for developing an agreed position of use.

Article 1348 of the Civil Code of the Russian Federation regulates the main provisions of the co-authors of the patent:

"1. Citizens who have created an invention, utility model or industrial design by joint creative work shall be recognized as co-authors.
2. Each of the co-authors has the right to use an invention, utility model or industrial design at one's own and sole discretion, unless otherwise provided by agreement between them.
3. The rules of paragraph 3 of Article 1229 of this Code apply to the relations of co-authors related to the distribution of income from the use of an invention, utility model or industrial design and with the disposal of the exclusive right to an invention, utility model or industrial design respectively.
The disposal of the right to obtain a patent for an invention, utility model or industrial design is carried out jointly by the authors.
4. Each of the co-authors has the right to independently take measures to protect their rights to an invention, utility model or industrial design."

The main group of issues in sharing is related to the use of a patent: income from joint use, disposition of the exclusive right to a patent, as well as protection of the exclusive right. Among other things, legislatively these issues are governed by the general rules set forth in paragraphs 2 and 3 Article 1229, as well as the special regulations indicated above.

However, an important agreement, and sometimes one of the main regulators of these relations, is that between the co-owners which determines any issues of joint use. If there is no agreement between patent holders, then a legal regulatory regime between them is recognized, i.e. completely relying on the rule of law. If the concluded agreement regulates only part of the issues, then those issues of use and disposal of law that are not regulated by the agreement will also be governed by applicable legal norms, i.e. the regulation mode will be mixed. If the patent holders prudently reflected in the concluded agreement all possible questions on the further use of the patent, then further cooperation will fully rely on contractual norms, i.e. be negotiable.

It is assumed that the resulting patent rights between several patent holders are common joint property, however by the agreement concluded, patent holders may provide for a different distribution of income from the use of the patent. This distribution of income is decided at the discretion of the parties and is reflected in the signed document.

Let us imagine that 2 patent holders have agreed on the following income distribution:

Patent holder #1 possesses production facilities and carries out actual regulation of the activity on the use of the patent, whilst receiving 80% of income.

Patent holder #2, not having the ability to conduct business, receives 20%.

In the event of the death of Patent Holder #2, even if he has several heirs, nevertheless, they will have the right to claim only 20% of the income, according to previous agreements.

Often difficulties arise when using a patent if each of the patent holders tries to "hog the cover", whilst the overall strategy cannot be achieved.

Let us imagine the same situation where Patentee #1 has production facilities for using the patent and calmly disposes of it independently and at his own discretion. Patentee #2 can do the same, however, he just does not have such an opportunity, trying to attract another company to transfer the right to use under a license agreement. At the same time, Patentee #2 does not give his consent to conclude a contract, creating a deadlock situation for his partner.

Thus, the above examples illustrate that when a patent appears, various kinds of difficulties may arise. No one is insured and does not know how the friendship of the authors of a certain technical solution will initially develop. Time moves on, and a situation may arise when the use of a patent for one of the owners becomes completely impossible. Therefore, we consider it appropriate to recommend to think about the further application of the patent at the stage of creation and to formulate the basic conditions for further cooperation, reflecting them in the civil law agreement, which will prevent a lot of questions and difficulties in the future.

Contact

Zuykov and Partners
Grokholskiy Pereulok, 28,
Moscow, 129090, Russia
info@zuykov.com

The Patent Lawyer Magazine
GLOBAL REACH, LOCAL KNOWLEDGE

Throughout the next few pages, you will view a comprehensive list of the 10 most well-respected law firms from Asia, in alphabetical country and company order.
Our focused list is derived from a multifaceted methodology, which uses months of industry research and feedback from our readers, clients, and esteemed connections around the world. All firms are ranked top 10 in their jurisdiction but are displayed alphabetically to avoid bias.

China

An Tian Zhang & Partners
Beijing Sanyou IP Agency
CCPIT Patent & Trademark Law
Chang Tsi & Partners
China Patent Agent
Hong Fang Law
Lifang & Partners
Unitalen Attorneys at Law
Wanhuida
ZY Partners

Hong Kong

Baker McKenzie
Bird & Bird
Deacons
Eagle IP
Hogan Lovells
Mayer Brown JSM
Norton Rose Fulbright
Rouse
Wenping
Vivien Chen

Taiwan

Baker McKenzie
Deep & Far
Formosa Transnational
Giant Group
Lee and Li Attorneys-at-Law
Saint Island International Patent & Law Offices
Tai E International Patent & Law Office
Tsai Lee & Chen
Tsar & Tsai Firm
Wood & Wu

Malaysia

- Advanz Fidelis IP
- Henry Goh & Co
- Marqonsult
- Raja Darryl & Loh
- Ram Caroline Sha & Syah
- Shearn Delamore & Co
- Skrine
- Tay & Partners
- Wong Jin Nee & Teo
- Wong & Partners

Japan

- Abe Ikubo & Katayama
- Aoyama & Partners
- Asamura Patent Office
- Fukami Patent Office
- ITOH International Patent Office
- Nakamura & Partners
- Ohno & Partners
- Sugimura & Partners
- TMI Associates
- Yuasa and Hara

Indonesia

- Am Badar & Partners
- Biro Oktroi Roosseno
- Cita Citrawinda Noerhadi
- Harvespat
- Januar Jahja & Partners
- K & K Advocates
- Pacific Patent Multiglobal
- Rouse & Co
- SKC Law
- Tilleke & Gibbins

Philippines

- Angara Abello Concepcion Regala & Cruz
- Baranda & Associates
- Bengzon Negre Untalan
- Bucoy Poblador & Associates
- Castillo Laman Tan Pantaleon & San Jose
- Cruz Marcelo & Tenefrancia
- Hechanova & Co. INC
- Romulo Mabanta Buenaventura Sayoc & De Los Angeles
- Salapo Velez Bundang & Bulilan
- SyCip Salazar Hernandez & Gatmaitan

Singapore

Allen & Gledhill
Amica Law
Bird & Bird ATMD
Dentons Rodyk & Davidson
Drew & Napier LLC
Lee & Lee
Marks & Clerk Singapore LLP
Ravindran Associates
Spruson & Ferguson (Asia) Pte Ltd
Wong Partnership

South Korea

AIP Patent & Law Firm
Bae Kim & Lee
Darae Law & IP Firm
FirstLaw PC
Kim & Chang
Lee & Ko
Shin & Kim
Yoon & Yang
You Me Patent & Law Firm
Yulchon LLC

Thailand

Ananda Intellectual Property
Domnern Somgiat & Boonma
International Legal Counsellors Thailand (ILCT)
Law Plus
Rouse
S&I International Bangkok
Satyapon & Partners
SCL Nishimura
Tilleke & Gibbins
Zico Law

Vietnam

Annam IP & Law
Elite Law
Gintasset
Invenco
Pham & Associates
Rouse
T&T Invenmark
Tri Viet & Associates
Vision & Associates
Winco

The use of trademarks and logos in industrial designs in Brazil

Rhuan Quintanilha, Partner at Montaury Pimenta Machado & Vieira de Mello, assesses the pitfalls of the first edition of the Industrial Design Guidelines published by the INIP (2019) in Brazil.

In recent years, the National Institute of the Industrial Property (INPI) has presented a strong movement of modernization and adaptation to international best practices. Within the INPI, there are several projects that aim to bring the protection of industrial property rights to levels never seen in the country. Among these projects, are the plan to combat the patent Backlog, implemented in July 2019, which aims to reduce the massive number of pending patent applications in Brazil (reaching almost 150,000 applications in 2019) and the accession to the Madrid Protocol, which came into effect in October 2019. However, for industrial designs, this movement began a few years earlier.

More specifically, this movement began in 2016, when the INPI carried out a major internal restructuring that transferred responsibility for granting Industrial Design records from its internal Patent Department to the Trademark Department, which was considered a step back by many IP experts at the time. After a year under the new department, in August 2017, a public consultation was held to prepare the first edition of the Industrial Designs Guidelines, similar to what had already been successfully done previously for trademarks.

For many years, industrial design examiners in Brazil examined the applications without any guidelines, which led to several contradictory decisions among themselves, always depending on the interpretation of the Industrial Property Law and the few resolutions in force at the time binding the examiner, which made the publication of the Industrial Design Manual a matter of extreme urgency for the development of the industrial property protection environment in Brazil.

Between the beginning of the public consultation and the publication of the first edition of the Industrial Design Guidelines, there was a certain instability and absence of coordination in the decisions published by the INPI. However, with the publication of the first edition of the Industrial Design Guidelines in early 2019, it was possible to start a standardization of the examination of industrial designs in Brazil (this had been absent for some time). However, even though it represented a great advance in relation to what had been done previously regarding the examination of industrial designs, the first edition of the Industrial Design Guidelines still presented several controversial and unclear points.

Rhuan Quintanilha

> **There are rare cases where applicants attempt to protect a trademark sign per se as an industrial design.**

One of these points is that the INPI maintained an extremely restrictive understanding regarding the presence of trademarks and logos in industrial designs. According to the Industrial Design Guidelines, which follows the same line of the previous resolutions, "the drawings or photographs should not bear marks or logos represented in the configuration of the industrial design, even if the reproduction of the trademark sign has been partial".

Résumé

Rhuan Quintanilha,
Mechanical Engineer
Rhuan Quintanilha is a Mechanical Engineer, with a post-graduate degree in Telecommunications. He has 6 years of experience in Intellectual Property matters, mainly in relation to Patents and Industrial Designs. Rhuan regularly gives lectures and workshops regarding Patents and Industrial Designs.

This feature aims to curb the double protection of trademark signs, which would already be protected by trademark registration. This restriction makes total sense to prevent the trademark signs from being protected by industrial design when they are the only element present in the industrial design application. However, what is observed in practice is that there are rare cases where applicants attempt to protect a trademark sign per se as an industrial design. What actually happens is that there are several cases in which the partial or total reproduction of the mark in the industrial design aims to compose the general ornamental aspect of the design.

For example, several companies in the fashion industry use their trademarks in the composition of prints (Figure 1) that are subject to protection by industrial design, since the INPI allows the protection of industrial designs for 3D objects, as well as for 2D patterns of lines and colors applied to objects, which is the case of prints for clothing and accessories. Prohibiting the use of the trademarks or logos of these companies in ornamental patterns, while allowing the use of any other element in these patterns, is a huge setback, since what should be evaluated is the final ornamental aspect of the object, not just an isolated element.

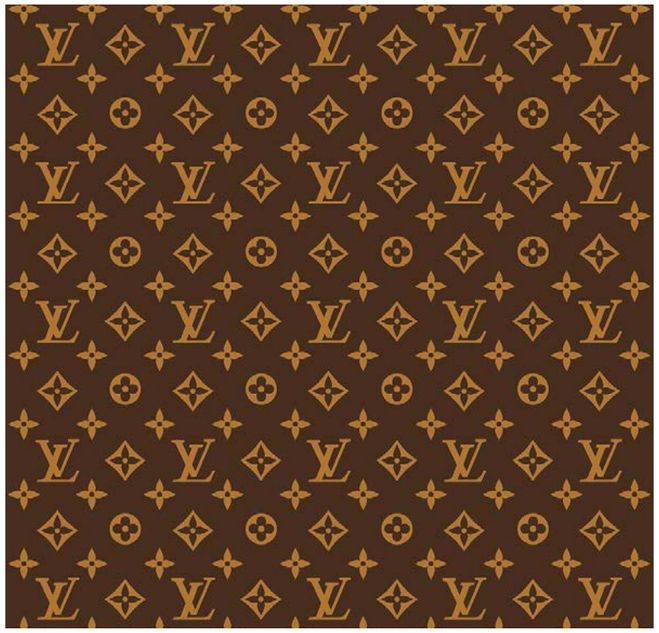


Figure 1 - Print reproducing the Louis Vuitton trademark

Another industry greatly impacted by this understanding of the INPI is the automotive industry. Several companies use their trademarks, or part of them, as visual elements that make up the overall look of their vehicles. For example, the French company Citroën, whose trademark comprises two inverted V's, incorporates these elements into the front portion of its vehicles (Figure 2).

Figure 2 – Vehicle with the Citroën's trademark

> **A huge setback.**

This is a classic case where it is clear that there is no intention by the applicant to obtain double protection for its trademark, but to use that distinctive sign to compose the distinctive ornamental aspect of its automobile. Similarly, Peugeot, a company belonging to the same Citroën group, presents in the industrial designs of some of its cars, a recess in the front grille (Figure 3) of the vehicle that has the same contours as the famous lion that characterizes the French brand. This element possessed the silhouette of the lion to receive at a later time a silver element, which indeed would reproduce the lion itself.

In the second half of 2019, based on this understanding present in the Industrial Design Guidelines, the INPI began to issue several office actions objecting to the industrial design applications of Citroën and Peugeot, arguing that they could not be granted since they would be allegedly reproducing, even when partially, the respective trademarks of said companies. However, when replying those office actions, it was possible to overcome these objections raised by the INPI by stating that the elements which allegedly reproduced the company's trademark are ornamental elements that aim only to compose the overall ornamental aspect of the vehicles, and not to obtain double protection of the trademark itself. In addition, the applicants pointed out their good faith, since reproductions of the trademark in non-ornamental elements, such as in the trunk or on the wheels of the vehicles, were removed at the time of filing the industrial designs.

Figure 3 - Front grid having the lion shaped-recess

Another major problem with this restrictive interpretation of the INPI was that only cases where the reproduction of the trademark was clear were being objected to by the INPI. Several cases where this reproduction was subtle did not receive the same treatment by INPI. For example, in Brazil, several Jeep vehicles had their industrial design registration granted without any objections of this nature, even considering that the front of the vehicles reproduces, albeit in a subtle way, the company's trademark, as seen in Figure 4.

While in the cases of Citroen and Peugeot the elements that referred to the trademark were highlighted in the central portion of the front of the vehicle, facilitating their identification, for the Jeep's cases, this perception was much more subtle. When analyzing the front view of these Jeep vehicles, it is possible to note that the entire front of the car, with the round headlights and seven vertical air intakes between them, reproduces the trademark of the company, which went completely unnoticed by the INPI's examiners. This fact was also presented in the arguments of the cases of Citroën and Peugeot, which contributed to the success in reversing the first unfavorable decision of the INPI.

In view of this, from the end of 2019, the INPI began to grant industrial design applications where it was understood that the presence of any trademark or logo was not aimed at obtaining double protection, but only composing the overall visual aspect of the object to be protected. According to the INPI's Trademark Department, this new understanding will be present in the second edition of the Industrial Design Guidelines, which is currently under review.

> **Only composing the overall visual aspect of the object to be protected.**

Even if it is still a small step, it is possible to note that a change of this magnitude, together with the projects mentioned above, shows that the INPI is increasingly committed to improving the technological development environment of Brazil, aligning it with the best practices adopted by other offices around the world.

Figure 4 - Jeep's granted industrial designs and its trademark

Patent prosecution in Mexico in view of the new IP Law

Mr. Sergio L. Olivares and Mr. Mauricio Samano of OLIVARES examine how IMPI will assess double patenting and second generation voluntary divisional applications.

Mexico's reality

Undoubtedly, these past few months have been challenging for most businesses around the world and law firms are no exception to this. The COVID-19 pandemic emergency has made social distancing a necessity and has led us to rethink the way we work and we are now avid users of electronic platforms and long hours at the office have now turned to long hours on home office.

In Mexico, due to the closure of the Mexican Institute of Industrial Property (hereinafter referred to as IMPI) from March 27 until July 12, the only venue for filing new patent applications was IMPI's online platform and even though terms did not run during the closure, online filing became an excellent solution to ascertain patent filings during this closure period and also avoided a massive physical filing once IMPI reopened. The current administration of IMPI has made it clear that their priority is to promote online filing over physical filing and recently, they have made possible the transformation of physical files to electronic ones which has become an attractive option to some applicants.

Now, in addition to the natural changes we have been living during this pandemic, we are also witnessing a new era for patent prosecution and enforcement in Mexico, since as of July 1st, 2020, a new Federal Law for the Protection of Intellectual Property was published in the *Official Federal* gazette and will enter in force 90 working days after its publication, namely on November 05, 2020. This completely new Mexican IP law, incorporates many practices currently held by IMPI and filled many grey areas that were present in the previous law.

As it relates to inventions, this new law incorporated some very positive changes which are in line with the requirements of the new USMCA Treaty, such as the possibility of applying for patent term extension in case of unreasonable delays (more than five years between the filing date in Mexico and the date of grant) directly attributable to IMPI during the prosecution of a patent application. This is made through the issuance of a complimentary certificate which cannot be longer than 5 years.

Mr. Sergio L. Olivares

Mr. Mauricio Samano

Further great news is that the life-term of Utility Models is now extended from 10 years to 15 years.

There is no doubt that this new IP law brings great benefits; however, there are two aspects of this new law that have raised many eyebrows (and not in a good way) among Mexican patent practitioners. We refer specifically to "double patenting" and "voluntary divisionals". Throughout this paper, we will ensure our best effort to explain these two subjects under the new IP Law and the grey areas that we feel need to be addressed.

Double patenting

For the past several years, IMPI has issued double patenting objections without a specific provision in our law prohibiting double patenting. IMPI applied the criteria followed by most patent systems which is that two patents cannot be granted for the same invention. The basis for the criteria applied by IMPI is that an applicant has no legitimate interest in the proceedings that lead to the granting of a second patent for the same subject matter if he already possesses one granted patent for said matter.

However, our new IP Law contemplates a specific provision prohibiting double patenting in its articles 50 and 101 stating that "During substantive examination and in the granting of rights, IMPI shall look out for the public domain and prevent double patenting of the same invention" (article 50) and "No patent will be granted to matter that is already protected by another patent, or which essential technical characteristics are a non-substantial variation of the matter protected by another patent, even when the applicant is the same in both" (article 101).

It is clear from the above articles that double patenting will not be allowed in Mexico; however, it is not clear how IMPI will assess double patenting.

Currently, a double patenting objection is issued both when the scope pursued in a second case (normally a divisional application) is identical to the scope already pursued in a first case and also when there is scope overlap between said second case and the first case. Specifically, Examiners analyze the scope of the matter granted in the first case, as well as the scope of the matter that the applicant is pursuing in the subsequent case, and verify whether there is an overlap in the scope of protection. In other words, if the parent case protects a series of chemical compounds and the subsequent case claims a series of chemical compounds wherein some of these compounds fall within the scope of the compounds claimed in the first case, the Examiner will issue a double patenting objection.

From our point of view, this practice is incorrect because the existence of scope overlap between a pending application and a granted patent in no way indicates that the same invention is trying to be protected twice and so far, we have been successful in overcoming double patenting objections due to scope overlap by presenting this argument.

By the same token, it is important to consider that a selection invention would be an exception to this criterion. Namely, if the applicant demonstrates that a specific chemical compound that is sought to be protected in a subsequent case and which falls within the scope of the chemical compounds granted in the first case, has a surprising and unexpected technical effect which could have not been deduced from any state of the art document, it is very likely that the Examiner will not issue a double patenting objection.

We will have to wait and see how IMPI will assess double patenting objections once the new IP law enters in force and hope that specific guidelines on how to evaluate double patenting

Résumés

Sergio L. Olivares, Jr., Partner

Sergio Olivares, Jr. joined OLIVARES in 1987 and today leads the firm with strength and a commitment to transparency, client satisfaction, and personal service. He has been a partner since 1994 and Chairman of the Management Committee since 2009. Mr. Olivares' breadth of experience is extensive; he is skilled in the prosecution and litigation of intellectual property rights, including trademarks, copyrights, patents, and unfair competition. He is proficient across all areas of intellectual property law but works most closely with the firm's Patent Group. Mr. Olivares is highly recommended by leading industry publications and directories as a leader in IP. He has been influential in ensuring that OLIVARES remains highly innovative, helping to support the firm's effort to add new practice areas and industry groups that will enable the firm to offer its clients a more comprehensive approach.

Mauricio Samano, Engineer.

Mauricio Samano works in the patent department of our firm. His work at OLIVARES mainly focuses in prosecuting Chemical, Biotechnological and Pharmaceutical patent applications, as well as in providing technical opinions regarding patent infringement. He has experience in conducting state of the art searches and drafting patent, utility model and industrial design applications. Additionally, he has participated in interviews with examiners of the Mexican Institute of Industrial Property (IMPI) and the United States Patent and Trademark Office.

will be included in the upcoming Regulations of our new IP law.

Voluntary divisionals:

The filing of voluntary divisionals has been a common practice in Mexico throughout several years in spite of the fact that there was no specific provision in our domestic law recognizing the possibility of filing voluntary divisional applications.

The legal support for this practice lay in article 4-G(2) of the Paris Convention, which mentions the following:

(2) "The applicant may also, on his own initiative (e), divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the Union shall have the right to determine the conditions under which such division shall be authorized (f)."

Currently, in the practice, voluntary divisionals are widely accepted by IMPI at any moment during the prosecution of a patent application and before the payment of the grant fees of the patent application.

Also, at this point in time there is no limit in the amount of voluntary divisionals that can be filed and it was possible to file second generation voluntary divisionals (divisionals from divisionals), third generation divisionals, and so on without any restriction.

Currently, we are glad that the new Mexican IP Law specifically recognizes the possibility of filing voluntary divisional applications. Article 100 of our new IP law specifically recognizes the possibility of filing voluntary divisional applications and article 102 mentions that the time limit for filing a voluntary divisional is before the payment of the grant fees. However, article 100 contains a paragraph that mentions the following:

> **A new era for patent prosecution and enforcement in Mexico.**

"The divisional application cannot consist in the division of other divisional applications, unless IMPI esteems that said further division proceeds, or in case IMPI requests said further division"

The above paragraph clearly leaves a big question mark on the acceptance of second generation voluntary divisional applications (cascade divisionals) and so far, we are unsure how IMPI will determine if a second generation voluntary divisional application will be accepted. This will of course not be the case for second generation divisionals that are generated as a result of a lack of unity objection raised by IMPI in relation to a particular divisional application.

Another paragraph that we found worrying is the following paragraph of article 100:

"When due to the division, an invention or group of inventions has been excluded, these cannot be claimed again in the initial application or in the application that originated the division, as the case applies"

In view of the above, it is clear that the practice for filing divisional applications has changed and that from now on it will be important to tailor an adequate strategy for filing divisional applications beforehand.

Conclusions:

As of today, many questions are left unanswered and we still have many doubts on how IMPI will assess double patenting and second generation voluntary divisional applications. For this reason, we are attentive to see how the Regulations of the new Federal Law for the Protection of Intellectual Property will be drafted and if they will provide an adequate guidance for Examiners on how to address these and other grey areas in our domestic law.

An adequate reflection for these times we are living is that in view of our new Law, we recommend to not hurry key decisions such as the filing of divisional applications and consult with your Mexican partner an upfront strategy in order to assure that you obtain a solid protection for the whole scope of commercial interest.

Contact

OLIVARES
Pedro Luis Ogazón 17, Col. San Ángel,
Ciudad de México 01000
olivaresnews@olivares.mx
Tel: +52 (55) 5322 3000

What you should know to be successful in IP litigation in Russia

Riikka Palmos, Senior Partner and Head of Trademark at Papula-Nevinpat, clarifies the Russian IP court system and discusses an alternative to enforce IP rights.

Enforcing rights and IP litigation in general has increased in Russia. There are some specifics for the IP litigation which are good to know before entering into a dispute in Russia.

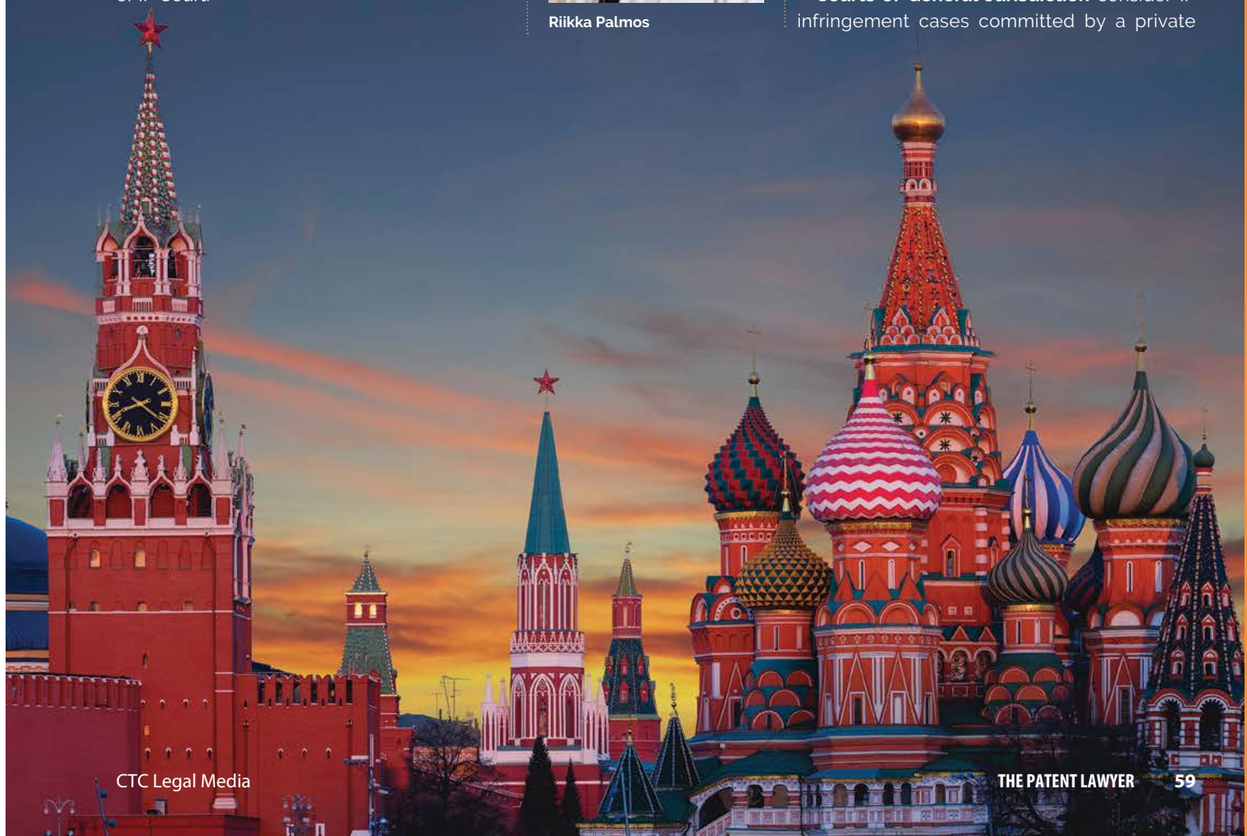
Russia has a specialized IP Court, located in Moscow. However, depending on the subject matter, the handling of the IP disputes is divided into several different Courts, namely (Arbitrazh) Commercial Courts, Courts of General Jurisdiction or IP Court.

Riikka Palmos

Court system in IP disputes

(Arbitrazh) Commercial Courts consider mainly infringements cases between legal entities. Before filing the claim, the pre-court process should be followed (especially when the case includes monetary claims, e.g. compensation). The Commercial Courts follow the rules of law quite strictly. The decision of a regional Commercial Court can be appealed at the regional Appeal Court and further at the IP Court.

Courts of General Jurisdiction consider IP infringement cases committed by a private



person. These Courts also consider domain name disputes. The judges in these Courts are usually not that familiar with IP rights, as these Courts mainly consider different types of family related cases, criminal cases, etc. Due to lack of experience, decisions may be unpredictable. There exists also legal uncertainty about the jurisdiction in the practice, as Commercial Courts have also considered IP cases against private persons, especially when commercial claims are involved.

IP Court is a specialized Court for intellectual property disputes, but it does not handle all kinds of disputes related to IP matters. As a first instance, the IP Court considers the following cases:

- Appeals against the decisions of the Patent Office/Federal Antimonopoly Service FAS and other governmental bodies.
- Cancellation actions of trademark rights due to non-use.

As a cassation instance (appeal instance), the IP Court considers the following cases:

- Appeals against its own decisions, but it is important to notice that the decisions cannot be appealed based on subject matter but only based on processual errors.

Résumé

Riikka Palmos, Senior Partner and Head of Trademark

Riikka Palmos is a trademark lawyer at Papula-Nevinpat since 1995. She is also a senior partner in the company and the director of our Trademark Department and head of Papula-Nevinpat's Legal Team in Russia

Riikka has 25 years of experience in trademarks in Russia and other countries of the former Soviet Union, including changes in the trademark legislation and practices, licensing and assignment of trademarks, protection of well-known trademarks, registration of domain names, registration processes as well as infringement and litigation issues in the Russian Patent Office and Courts.

Riikka also has experience in Finnish and EU trademark processes.

Riikka's expert articles have been published in a number of major IP publications. Riikka is also a popular speaker in Finnish and international conferences and seminars.

> **All documents and evidences must be filed also in Russian language.**

- Appeals against the decisions of the Commercial Courts.

Russian specifics for court process

The court process is strictly regulated in Russia. In addition, there is very strict formal requirements for the documentation and evidences. Especially, it is worth noticing that all documents and evidences must be filed also in Russian language and translations must be notarized.

Further, there is an obligatory pre-court process in the cancellation actions of trademark registrations due to non-use and said pre-court process is also recommendable in other cases in which a monetary aspect is included in the claim. This process requires sending a warning letter before filing the claim and includes short deadlines.

In infringement actions, an outside expert opinion constitutes a significant evidence; both parties can propose their own experts, but it is the Court who decides which expert is used. The Court can also choose its own expert, but this happens very seldomly.

When a foreign company is a party to the court process, the official notice of service process will usually take at least 6 months, which will lengthen accordingly. The consideration of the case will not start earlier than within 6 months from filing of the claim.

It may be a surprise to hear that the Courts send communication directly to the rights owner. Although the court can easily get the representative details from the Patent Office, the Courts still often send notifications directly to the owners. Therefore, it is very important to keep the owner's contact details updated at the Patent Office in order not to miss any important notifications.

Alternative way to enforce IP rights

Courts are not the only instance where IP rights can be enforced. Applying to the Federal Antimonopoly Service (FAS) is an alternative option to defend IP Rights in Russia. FAS is an administrative organ which handles cases related to advertising, unfair competition, monopoly issues and competition sphere in respect of Intellectual Property matters. In other words, FAS may consider infringement cases of IP rights when there is a competition aspect involved between the parties.

In order to get the case accepted for consideration by FAS, there must exist an actual competition situation between the parties, which requires true and real business activities from the infringer in Russia. Such activities are, for example, actual sales or an offer for sale of the goods in a similar field of activity and in respect of similar goods.

During the process, the plaintiff must prove that the infringer's intention is to gain unfair advantage of the IP owner's rights in the Russian market. The plaintiff should also prove losses and/or damages due to the activities of the infringer.

FAS process

FAS is a plaintiff friendly organ. Different from the court process, FAS is able to conduct its own investigations or order ones under its own initiative to obtain additional evidences for the case. For example, in trademark infringements cases FAS may ask the Patent Office to conduct a comparison between the similarities of the trademarks. Further, FAS may even conduct a public opinion poll or obtain information from other Authorities. FAS may also order the infringer to reveal financial information, such as the amount of sales, or other relevant information needed for the decision making.

FAS process is fast; a decision in 6 months or even faster is possible. Proceedings itself are similar as in the court, but less formal. FAS can order the infringer to stop the illegal use of IP rights and order fines, but FAS cannot invalidate IP rights. It can only forbid a third party from infringing the rights. Further, FAS does not have the competence to order any compensation for legal costs or damages. Compensation demands have to be filed in a different process with the Court.

> **FAS may consider infringement cases of IP rights when there is a competition aspect involved between the parties.**

FAS or Court?

In case the requirements for the FAS process are fulfilled, the IP owner may choose to proceed with the infringement case either at FAS or the Court.

Why FAS:

- FAS has a short and plaintiff-friendly process, as well as straightforward decision making. The Court also handles a case relatively quickly but more formally.
- FAS may collect further evidences.
- FAS seems to be more efficient to stop the infringement.
- FAS can fine the infringer.
- FAS decision can be appealed to the IP Court.

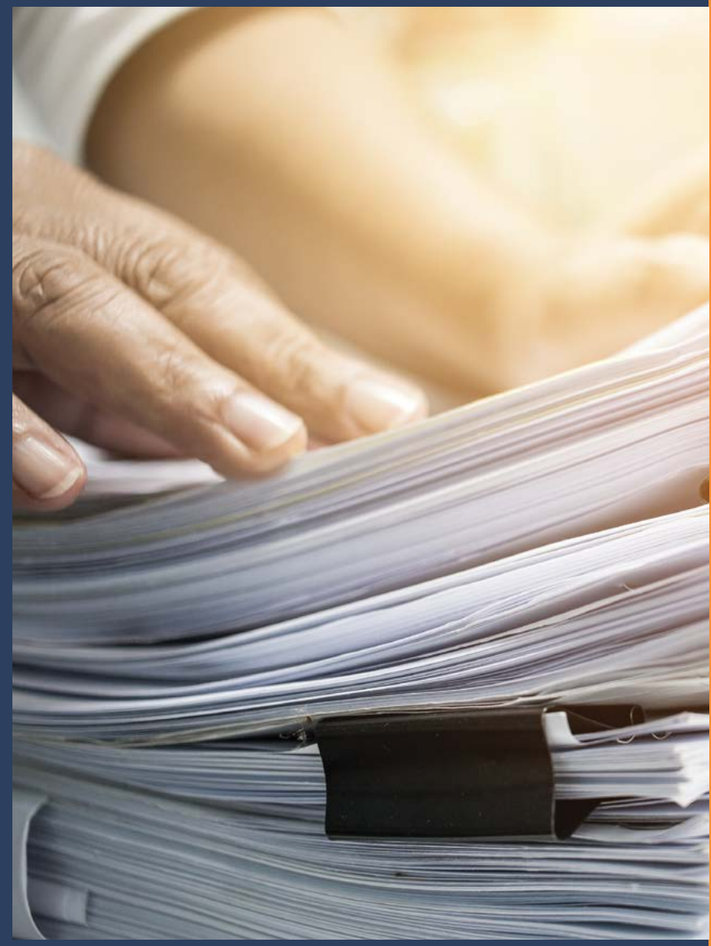
Why Court:

- Courts have better knowledge towards IP rights than FAS Authorities.
- Court can order the payment of the legal costs and compensation of damages.
- Court has a competence to invalidate IP rights.
- FAS Authorities may sometimes be reluctant to accept IP infringement cases for consideration due to insufficient knowledge.
- Despite of the FAS decision, the case can be brought to the Court.

Many IP owners have considered the possibility to choose the instance for the infringement action very useful. Both instances have their pros depending on the plaintiff's goals on the action.

Contact

Papula-Nevinpat
POB 981, FI-00101 Helsinki, Finland
Tel: +358 9 348 0060
info@papula-nevinpat.com
www.papula-nevinpat.com



Pharmaceuticals, pesticides, and agrochemicals patent term extension: where IP owners stand in Russia

Ekaterina Petrova, Russian and Eurasian patent attorney at PATENTICA, considers the implements of the Russian Federation Civil Code on patent term extension.

Patenting of the inventions relating to the field of pharmacy and medicine plays an important role among all subjects of intellectual property being protectable in Russia. It goes without saying, dynamic development of the pharmaceutical industry in Russia requires effective regulation with respect to legal protection of the pharmaceutical innovations. An important option to regulate legal protection of the pharmaceutical inventions is patent term extension, which is analyzed below in more details.

Ekaterina Petrova

Patent term extension: general procedure

Russian patents are valid for 20 years from the filing date of the application. However, if talking about pharmaceuticals, pesticides, and agrochemicals, which require marketing authorization, the patent term can be extended for a period of no more than five years. This opportunity is intended to compensate, at least partly, for the lengthy procedure of patent holders associated with obtaining corresponding marketing approvals issued by the state authorities, which significantly reduces the term of the patent monopoly for such inventions. Important to notice is that in Russia patent term extension is possible only for patents relating to pharmaceutical products and uses thereof and is not allowed neither for patents relating to methods for producing pharmaceutical products, nor for methods of treatment.

Extension of the term of Russian patents is regulated by Article 1363(2) of the Civil Code of the Russian Federation. Pursuant to the above provision, the term of a patent for an invention relating to pharmaceutical, pesticide and agrochemical substances can be extended upon the applicant's request. The term shall be extended for a period counted from the filing date of the patent application to the date of the first marketing authorization minus five years, with the proviso that the term of the patent may not be extended for a period exceeding five years. The request shall be filed within six months from the grant of the marketing authorization or within six months from the grant of the patent, if said authorization is granted earlier than the basic patent.

At the same time, it shall be noted that the Russian Patent legislation does not limit the number of the patent term extensions issued based on one marketing approval. The only requirement stated in Article 1363(2) of the Civil Code is that the marketing approval shall be the first marketing approval, i.e. the drug shall be registered in the corresponding State authority for the first time.

> **It is very fair with respect to the third parties.**

Canonpharma case

This notice can be remarkably illustrated with the IP Court case # СИП-17/2015. Canonpharma has appealed to the IP Court in order to cancel the decision of the Russian Patent and Trademark Office to extend the term of the patent RU2114838 "TRIAZOLE DERIVATIVES, PHARMACEUTICAL COMPOSITION AND INTERMEDIATE COMPOUNDS".

Canonpharma explained that the patent term extension for the patent RU2114838 was issued based on the registration certificate for the drug Voriconazole in 2004. A bit earlier the same registration certificate served as a basis for patent term extension for another patent RU2095358. Canonpharma requested cancelling the patent term extension for the later patent, since one registration certificate for the same drug Voriconazole cannot serve as a basis for extending the validity period of two patents at once.

Having considered the materials in the proceedings the IP Court has concluded that:

- The extension of the term of the patent RU2114838 was carried out in accordance with the current regulations of the patent legislation
- The circumstances pointed out by the applicant are not an obstacle to the extension of the term of the patent RU2114838
- The circumstances related to the patent term extension for the patent RU2095358 have no legal significance for the extension of the RU2114838 patent term.

Thus, the IP Court refused to satisfy the appeal.

> **The Court refused to satisfy the requests for restoration of the missed term.**

Movement towards SPC's

Since January 1, 2015, in accordance with the amendments made to Article 1363 of the Civil Code of the Russian Federation, the patent term extension procedure in Russia moved towards SPC protection in the EU and provides issuing of a supplementary patent comprising of a set of claims directly covering the product, for which the marketing authorization in Russia has been obtained. Thus, the scope of protection of a supplementary patent would differ (sometimes significantly differ) from the scope of protection provided by the basic patent.

The most illustrative example is a patent reciting a Markush structure, covering a very large class of compounds. The Marketing approval is usually issued for a particular compound from the group claimed in the basic patent, and therefore the supplementary patent would have a limited scope for claims reciting a particular compound as approved by the marketing approval.

Pursuant to Article 1363(2) of the Civil Code of the Russian Federation, a set of claims for a supplementary patent comprises of a set of features of the patented (in the basic patent) invention, for which the marketing approval has been obtained. The above rule supposes that the set of claims of the supplementary patent would comprise of the features recited in the set of claims of the basic patent.

Therefore when compiling an independent claim reciting general Markush structure, in order to avoid possible difficulties with the patent term extension in the future, one can be recommended to recite specific embodiments (i.e. specific compounds of interest to the applicant covered by the general Markush structure and intended to be further used as pharmaceuticals) in separate dependent claims.

Résumé

Ekaterina Petrova, Russian and Eurasian patent attorney, M.Sc in Biotechnology, PATENTICA

Ekaterina's practice includes drafting and prosecuting patent applications, compiling various types of patent opinions (including freedom-to-operate opinions) and patent expertise for regular courts. Available at: ekaerina.petrova@patentica.com

> Russian legislation allows filing an appeal against illegal patent term extension (among other illegal decisions) with the Court.

Furthermore, according to the Russian Patent Legislation, examples of preparation of such compounds along with the features characterizing their properties and biological activity shall be disclosed in the specification.

It shall be noted that it is very fair with respect to the third parties, since it provides supplementary patent protection only with respect to an exact product, produced and marketed by the patent holder.

Invalidation of the supplementary patent

Russian legislation allows filing an appeal against illegal patent term extension (among other illegal decisions) with the Court. However, the key problem is in the duration of the term for filing the appeal. In particular, pursuant to Article 198(4) of the APC, a third party has only three months from the date of publishing information on the SPC in the Patent Register to challenge the PTE decision, which is clearly illustrated by the current court practice.

KRKA Novo Mesto case

Thus, according to the decision A40-85716/10, KRKA Novo Mesto has applied to Court to cancel the extension of the term of the patent RU2053229 for the invention "BENZIMIDAZOLE DERIVATIVES AND PHARMACEUTICAL COMPOSITION SHOWING ANTAGONISTIC ACTIVITY WITH RELATION TO ANGIOTENSIN BASED ON THEREOF" as it is illegal. PTE request for the patent RU2053229 has been filed with the Russian Patent Office on 25 February 2005. The Russian Patent and Trademark Office has considered the filed documents and has decided to extend the term of the patent RU2053229. The information on the patent term extension has been officially published on 20 February 2007. The Court has repeatedly examined all documents and, in view of the fact that all conditions are fulfilled and all requested documents are presented, has refused to satisfy the appeal.

Along with the above circumstances one of the grounds for refusing to satisfy the appeal was the fact that the applicant has missed the three-month period for filing the appeal prescribed by the Article 198(4) of the APC of the Russian Federation.

The above decision has been appealed to the Court of Appeal. The Court refused to satisfy the requests for restoration of the missed term prescribed by the Article 198(4) of the APC of the Russian Federation based on the legal position of the Constitutional Court stating that restoration of the missed due date for filing an appeal is possible in view of some justifiable reasons and not in view of the fact that the time limit is too short.

At the same time, the Court has rejected the applicant's argument explaining that the applicant became aware of the patent term extension only on May 5, 2010, noting that the official information on the patent term extension has been published on the website and in the periodical bulletin on 20 February 2007. According to the Court, the publication of this information refers to publicly available information that the applicant should have been aware of.

Thus, it can be concluded that challenging unlawful patent term extensions in Russia is very complicated within the prescribed term (i.e. within three months from the date of publication of the information on the patent term extension and issuing of a supplementary patent) and is impossible after this period of time.

However, pursuant to Article 1363 of the Civil Code of the Russian Federation, third parties still have a right to nullify a supplementary patent based on the same grounds as provided for the basic patent. These grounds are regulated by Article 1398 of the Civil code of the Russian Federation, and include in particular:

- Non-compliance of the invention with the patentability criteria (novelty, inventive step, industrial applicability).
- Non-compliance of the documents of the application with the sufficiency of disclosure requirement.
- Presence of features in the claims which were not disclosed in the original specification on the filing date in the application documents.

Conclusion

The importance of IP protection for scientific and technological progress is beyond any doubt. Extending the term of a patent monopoly is one of the possibilities that allow not only patent holders to recoup their own losses of developing a patented invention, but also to receive additional income for investing in the creation of new inventions. A competent approach to using this opportunity is necessary for the benefit of the patent holders themselves.

Contact

PATENTICA
Office 5, 15 Malaya Morskaya St.
Saint Petersburg, Russia 190000
Tel: +7 812 600 2427
info@patentica.com
www.patentica.com

> Thus, it can be concluded that challenging unlawful patent term extensions in Russia is very complicated within the prescribed term.

Chemical patents: peculiarities in Indian patent laws

Vidisha Garg, Partner at Anand and Anand, examines the clauses of the Indian Patent Act and the impact is has on the patentability of chemical and pharmaceutical inventions.

India has been rising in The World Bank's 'Ease of Doing Business' rankings, from 100 in 2017 to 63 in 2019, and has become one of the top ten most preferred countries for foreign investment. Patent filing in India has also increased from 47854 patent applications in 2017-18 to about 50667 patent applications filed in 2018-19. Patent applications filed in the field of chemical sciences constitutes the highest numbers, in 2017-18 about 6343 chemical patent applications were filed. India is considered the 'world's pharmacy', being the biggest manufacturer and supplier of generic medicines, making it an important jurisdiction for chemical and pharmaceutical patents. This article provides a glimpse into the peculiarities of Indian patent laws in the chemical and pharmaceutical sector.

Vidisha Garg

Types of claims allowed:

Section 2 (1)(j) of the Indian Patent Act, defines an "invention" as a new product or process involving an inventive step and capable of industrial application. Thus, from the plain reading of section 2(1)(j), only products and/or processes which are novel, inventive and industrially applicable are considered to be inventions.

Claims directed to the use of the product/process are not considered as inventions according to the definition of 'invention' provided in the act, therefore, use claims are not allowed. Also, the claims directed to the application of the claimed product/process are not considered as inventions and thus not allowed.

Further, Swiss claims or second medical use claims are not allowed in India in view of the provisions of Section 3(d).

> **Patent applications filed in the field of chemical sciences constitutes the highest numbers.**

The types of claims allowed under the product and process categories are, but not limited to, the following:

I. Product claims:
i. Pharmaceutical product:
a. New Chemical Entities;
b. Formulations/Compositions;
c. Combinations;
d. New forms of known substance such as salts, ethers and esters; polymorphs; solvates, including hydrates; clathrates; stereoisomers; enantiomers; metabolites and pro-drugs; conjugates; pure forms; particle size; isomers and mixtures thereof; complexes; derivatives of known substances; and
ii. Kits;
iii. Product-by-process
II. Process/method of manufacturing claims;

Markush Claims:

As per the practice of the Indian Patent office and the "Guidelines for Examination of Patent Applications in the Field of Pharmaceuticals", while examining the Markush claims, the complete specification is critically examined to see whether:

(i) it discloses best representatives, as known to the applicant, of the possible embodiments;
(ii) such embodiments share a common use or property;
(iii) such possible embodiments share common structure;
(iv) physical and/or chemical properties of best representatives of such embodiments known to the applicant are disclosed;
(v) test conducted for the representatives of such embodiments known to the applicant is provided;
(vi) in case of product claims at least one process for preparing the compounds has been disclosed enabling the whole scope of the invention.

If any one of the above conditions ((i) to (vi)) is not met, Markush claims are objected to as lacking 'unity of invention' and/or insufficiently disclosed.

According to the patent office practice, the compounds are said to have a common structure where the compounds share a common chemical structure which occupies a large portion of their structures. In cases where the compounds have only a small portion of their structures in common, the commonly shared structure constitutes a structurally distinctive portion in view of existing prior art. The structural element may be a single component or a combination of individual components linked together.

Inventions not patentable

Section 3 of the Indian Patents Act lays down a threshold for patent eligibility. Section 2(1)(j) provides a theoretical definition of an invention while Section 3 illustratively outlines what are not inventions. The section relevant to chemical and pharmaceutical inventions are discussed below.

> **Lacking 'unity of invention'.**

1. **Section 3(c):**
"The mere discovery of a scientific principle or the formulation of an abstract theory or discovery of any living thing or non-living substance occurring in nature."

This is very clear on exclusions. Compounds which are isolated from nature are not patentable subject-matter.

Résumé

Vidisha Garg, Partner

Vidisha became a patent agent in 2004 after which she joined Anand and Anand and has contributed immensely to the growth of firm's patent prosecution and contentious practice since. She represents clients in several pre-grant and post-grant patent opposition matters. Vidisha also handles patent revocation matters before IPAB. She was involved in the Tykerb revocation matter, India's first NCE revocation case. Her practice areas also see her engagement in providing opinions and strategies on patent laws in India, drafting of patent specifications, patent searches, validity, patentability, and infringement opinions. Clients rely on her advice on issues relating to protection of national biodiversity.

2. **Section 3(d):**
   "The mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance or the mere discovery of any new property or new use for a known substance or of the mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant.

Explanation: For the purposes of this clause, salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations, and other derivatives of known substance shall be considered to be the same substance, unless they differ significantly in properties with regard to efficacy."

Section 3(d) is the most notorious section in the Patents Act for chemical and pharmaceutical inventions and was brought in to avoid ever-greening of patents. This stipulates that the incremental inventions should involve enhanced efficacy over the already known substance.

In accordance with Section 3(d), new form of a known substance, or a derivative of an already known substance, having known efficacy shall be deemed to be treated as a same substance, if the invention in question fails to demonstrate significantly improved efficacy with respect to that known compound.

In other words, if there is a known substance, that known substance should have known efficacy. It is not enough to show that there is some known compound in the prior art which allegedly bears some structural resemblance to the claimed compound. The prior art should also provide the known efficacy of the said known compound. The rule of law in this regard is clear. The obligation is not on the applicant for a patent to show how the claimed compound has better efficacy over a compound for which there is no established or proven efficacy or carry out tests to do this.

The Hon'ble Supreme Court in *Novartis Vs Union of India and Ors,* MANU/SC/0281/2013, Paragraph 103, held, "We have, therefore, no doubt that the amendment/addition made in section 3(d) is meant especially to deal with chemical substances, and more particularly pharmaceutical products. The amended portion of section 3(d) clearly sets up a second tier of qualifying standards for chemical substances/pharmaceutical products in order to leave the door open for true and genuine inventions but, at the same time, to check any attempt at repetitive patenting or extension of the patent term on spurious grounds".

> **To avoid ever-greening of patents.**

While interpreting the term "efficacy", the Hon'ble Supreme Court in the Novartis case held that in the context of the pharmaceutical patenting the "efficacy" should be understood as "therapeutic efficacy". In Paragraph 180 of Novartis order, Supreme Court held as follows:

"What is "efficacy"? Efficacy means "the ability to produce a desired or intended result". Hence, the test of efficacy in the context of Section 3(d) would be different, depending upon the result the product under consideration is desired or intended to produce. In other words, the test of efficacy would depend upon the function, utility or the purpose of the product under consideration. Therefore, in the case of a medicine that claims to cure a disease, the test of efficacy can only be "therapeutic efficacy". .....It may be noted that the text added to Section 3(d) by the 2005 amendment lays down the condition of "enhancement of the known efficacy". Further, the explanation requires the derivative of "differ significantly in properties with regard to efficacy". What is evident, therefore, is that not all advantageous or beneficial properties are relevant, but only such properties that directly relate to efficacy, which in case of medicine, as seen above, is its therapeutic efficacy."

The forms provided in the explanation of section 3(d) are considered as same substance unless they differ significantly in property with regard to "therapeutic efficacy. Hence, the mere change of form with properties inherent to that form would not qualify as "enhancement of efficacy" of a known substance. In other words, the explanation is meant to indicate what is not to be considered as therapeutic efficacy.

Further, in *Roche vs Cipla* (RFA (OS) Nos.92/2012 & 103/2012), Delhi High Court had held in Para 29 as follows:

"... Now, Section 3(d) assumes that structurally similar derivatives of a known substance will also be functionally similar and hence ought not to be patentable. What is of crucial importance is that this is not a provision that merely bars certain subject matter from patentability. On the contrary, it provides that if the new form of the known substance is found despite a structural similarity to demonstrate a better functionality i.e. enhancement of the known efficacy', it would qualify for assessment under Section 2(1)(j) as if it were a new product involving an inventive step and it would thereafter be up to the applicant for the patent to demonstrate the patentability of this substance in accordance with Sections 2(1)(j) and (ja). This provision is not a patent term extension or an evergreening provision but in fact recognizes incremental innovations in pharmaceutical patents."

According to the interpretation of the Delhi High Court, first it must be decided whether or not the subject matter of the invention falls under the exclusions of section 3(d), if the answer is no, it would qualify for assessment under Section 2(1)(j) as if it were a new product involving an inventive step and it would thereafter be up to the applicant for the patent to demonstrate the patentability of this substance in accordance with Sections 2(1)(j) and (ja). Thus, graphically represented, the same would be:-

In view of the above, it is very important for the applicants to demonstrate enhanced efficacy in the specification by way of experimental data. In case such data is not available, post filing data is also acceptable.

3. **Section 3(e):**
   "A substance obtained by a mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance."

Section 3(e) is critical in the case of the composition or formulation inventions. Merely placing old integers side by side so that each performs its own proper function independently of any of the others is not a patentable combination. Subject matter is patentable where the old integers, when placed together with some working interrelation, produces a new or improved result.

Compositions obtained by mere admixing and resulting in aggregation of the properties of the individual components are not patentable under section 3(e) of Act. However, in a composition, if the functional interaction between the features achieves a combined technical effect which is greater than the sum of the technical effects of the individual features, it indicates that such a composition is more than a mere aggregation of the features. Further, polymer compositions are not considered as admixtures as they involve chemical interactions among the components of the composition.

4. **Section 3(i):**
   "Any process for the medicinal, surgical, curative, prophylactic diagnostic, therapeutic or other treatment of human beings or any process for a similar treatment of animals to render them free of disease or to increase their economic value or that of their products."

This is critical in cases of inventions or subject matter relating to the method of treatment. In the field of pharmaceuticals, it is noticed that method of treatments are often claimed in the guise of composition/dosage claims.

Many a time, method of treatment claims or dosage claims are converted into composition claims during prosecution. However, the allowability of such amendments is doubtful as such claims are examined as per Section 57 read with section 59 of the Act, which lay strict guidelines on the nature of amendment.

> **Many a time, method of treatment claims or dosage claims are converted into composition claims during prosecution.**

Unity of invention

Section 10(5) of the Act, requires that claims or groups of claims should relate to a single invention, or to a group of inventions linked so as to form a single inventive concept. If claims relate to a plurality of distinct inventions, it may be objected on grounds of 'lack of unity of invention'. To fulfil the requirement of 'unity of invention', each claim of a complete specification should share a single common technical relationship which is inventive, called the "special technical feature".

Chemical and pharmaceutical inventions may claim huge numbers of chemical compounds by Markush structures, chemical compounds as intermediate and final products, compositions comprising different chemical components, processes for their manufacture, their uses or applications, even devices or apparatus used for carrying out specific processes in a single application. In such cases, applicants have to show sufficiently that the different sets of claims are related by "special technical feature".

Conclusion

When filing patent applications relating to chemical inventions it is necessary to take into consideration the afore-discussed provisions, particularly the excluded subject matter. In cases where the specification has claims relating to the excluded matter, said claims may be deleted to reduce the official fee as they will have to be deleted during the prosecution of the application. Also, try to provide sufficient data in the specification to demonstrate the enhanced technical effect of the invention. Post-filing data is permissible, preferably in the form of an expert declaration.

Contact
Anand and Anand
First Channel Building Plot No. 17A, Sector 16A, Film City, Noida, Uttar Pradesh 201301, India
Tel: +91.120.4059300
vidisha@anandandanand.com
www.anandandanand.com

Trends in patent inventions for antibody-based drugs in Japan

Dr Wataru Nishii, Patent Engineer at Sonoda & Kobayashi Intellectual Property Law, explores the patenting of antibody-based drugs with special reference to the recent court decisions for a monoclonal antibody recited in a 'reach-through claim'.

Antibody-based drugs are the best-selling drugs in the pharmaceutical market, with a market value predicted to increase to up to USD 300 billion in 2025.[1] Brand-name pharmaceutical companies look to pursue patents with the broadest scope possible for an antibody, while generic pharmaceutical manufacturers frequently seek to invalidate such broad-scoped patents. Therefore, the extent to which it is possible for a patent to cover an antibody is a controversial problem and one which varies by territory as well as changing from moment to moment. Here, I discuss this problem with reference to recent Japanese court decisions. The courts have acknowledged the validity of patents for functionally defined antibodies, claims which could be interpreted as 'reach-through claims'. Thus, the decisions could make patent rights of antibody-based drugs much broader and stronger than before, and considerably impact patent strategies of pharmaceutical companies in Japan.

Court decisions

Amgen Inc. has Japanese patents for inventions directed to 'antigen binding proteins to proprotein convertase subtilisin kexin type 9 (PCSK9)' (Japanese Patent Nos. 5705288 and 5906333, both originating from PCT/US2008/074097 corresponding to WO2009026558). Granted claim 1 of JP5705288 (which is essentially the same as that of JP5906333 except for the recited amino acid sequences) is:

> Claim 1.
> An isolated antibody,
> wherein the isolated antibody is capable of neutralizing the binding between PCSK9 and LDLR proteins, and wherein, with respect to the binding to PCSK9, the isolated antibody competes with an antibody comprising a light chain comprising CDRs 1, 2, and 3 consisting of the amino acid sequences of SEQ ID NOs: 368, 175, and 180, respectively, and a heavy chain consisting of CDRs 1, 2, and 3 consisting of the amino acid sequences of SEQ ID NOs: 158, 162, and 395, respectively.

Dr Wataru Nishii

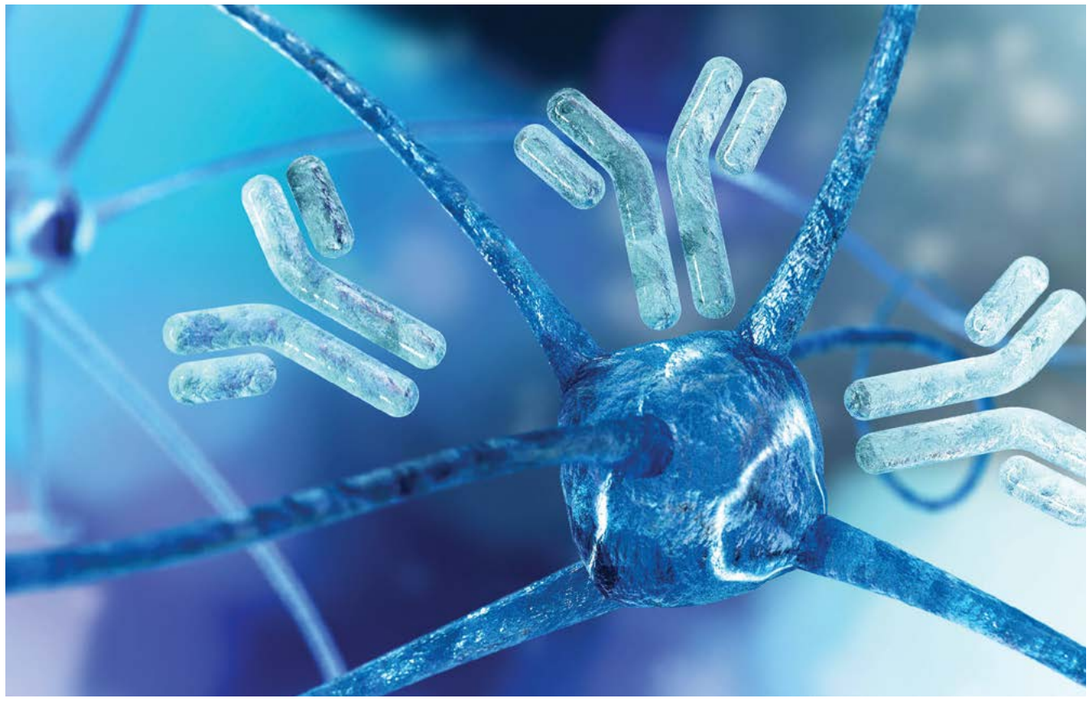
Thus, the claimed isolated antibody is defined functionally by the two defining features: i) being capable of neutralizing the binding between two proteins, and ii) competing with a reference antibody with respect to the binding.

[1] Liu, R.-M., et al. "Development of therapeutic antibodies for the treatment of diseases" (2020) *J. Biomed. Sci.* 27:1.

Résumé

Wataru Nishii, PhD, Patent Engineer
PhD, Department of Biochemistry and Biophysics, Graduate School of Science, The University of Tokyo
BS, Department of Agricultural Chemistry, Faculty of Agriculture, The University of Tokyo

After studying biophysics and biochemistry at the University of Tokyo, Dr. Nishii worked as an assistant professor at the Tokyo University of Pharmacy and Life Sciences, and as a research scientist at RIKEN. He has extensive experience in life science research with a focus on protein science and drug discovery science. He joined Sonoda & Kobayashi Intellectual Property in April 2018.



For these inventions, the Japanese IP High Court rejected an invalidation trial brought by Sanofi (Case Nos. 2017 (gyo-ke) 10225 and 10226), and the Tokyo District Court ruled in favor of plaintiff Amgen and against defendant Sanofi in a patent infringement litigation (Case No. 2017 (wa) 16468). The statements of these court decisions are essentially the same, acknowledging the validity of the above patent invention in view of the inventive step, support, and enablement requirements.

Regarding the inventive step requirement, the Japanese IP High Court stated:

> '...It cannot be acknowledged that those skilled in the art reading A1 could have conceived of the reference antibody even if they could obtain some kinds of monoclonal antibodies capable of neutralizing the binding between PCSK9 and LDLR proteins (the configuration of the corrected invention 1 related to Difference A) based on A1 and the common technical knowledge. Accordingly, it also cannot be acknowledged that those skilled in the art could have conceived of the antibody "competing with" the reference antibody...' (Case No. 2017 (gyo-ke) 10225)

Regarding the support requirement and enablement requirement, the Japanese IP High Court stated:

> **"The extent to which it is possible for a patent to cover an antibody is a controversial problem."**

> "...It is acknowledged that those skilled in the art could recognize that the neutralizing antibody that competes with the reference antibody, included in the claimed scope of the corrected invention 1 (claim 1), can be obtained based on the disclosures of the specification of the present case without reference to the amino acid sequences of the claimed antibody." (Case No. 2017 (gyo-ke) 10225)

Underlying problems

The court seems to acknowledge the inventive step of the claimed antibody, predominantly because the reference antibody (used for the defining feature ii)) was not easily conceivable. However, this could be problematic, since the claimed antibody might also be conceivable without using the reference antibody. That is, the claimed scope might encompass known or easily obtainable antibodies which inherently possess the competing ability, in which case the claimed scope could be unreasonably broader than it should be.

The support and enablement requirements present yet more problems. Even though obtaining the claimed antibody could be possible without reference to its amino acid sequences, this would require undue effort of those skilled in the art, including obtaining the reference antibody and validating the neutralizing and competing abilities of the claimed antibody. Furthermore, the claim in question could be interpreted as a 'reach-through claim', since the defining features i) and ii) substantially define the processes of obtaining antibodies through measuring the neutralizing ability and the competing ability, respectively, to obtain the claimed antibody. However, a 'reach-through claim' is generally considered as being an inappropriate claim style in Europe, the U.S., and Japan, since this could excessively protect patent rights, even for a future invention that cannot be obtained without undue effort, and thus inhibit healthy development of industry.[2] Moreover, the claim does not specify the degrees of the neutralizing and competing ability, even though the degrees could be critically important for the desired effects of the claimed antibody.

In spite of the above problems, the courts acknowledged that the patent inventions meet the inventive step, support, and enablement requirements, and such rulings will inevitably lead to controversy. In other words, it could be said that the court decisions are too advantageous for brand-name pharmaceutical companies and too disadvantageous for generic pharmaceutical manufacturers.

Valid claim scopes in Japan, the U.S., and Europe, for antibody inventions

A patent invention of an antibody can be defined structurally and/or functionally.

Regarding a structurally-defined antibody, it is generally required to at least specify the six complementary defining regions (CDRs) in Japan, while less-limited antibodies are occasionally accepted in the U.S. and Europe.[3] Thus, Japan is, generally speaking, a more difficult place to obtain and maintain a patent for a structurally-defined antibody when compared to the U.S. and Europe.

In contrast, Japan seems to be more lenient with regards to obtaining and/or maintaining a patent of a functionally-defined antibody when compared to the U.S. and Europe. In fact, the European counterpart patent EP2215124 of the above Japanese patents is directed to an antibody with the above defining features i) and ii); however, the modes of the neutralizing and the competing of the antibody are specified in further detail than in the Japanese patent. Moreover, EP2215124 is currently involved in opposition proceedings (brought by five opponents), and further limitations have been introduced into the claimed scope.

Meanwhile, in the U.S., a functional claim is interpreted as being limited to the corresponding structure, material, or acts described in the specification under U.S.C. 112(f), and thus the claimed scope of a functional claim is generally narrower than in Japan and Europe. Correspondingly, the claims of the U.S. counterpart patents US8829165 and US8859741 (of the above Japanese and European patents) are directed to antibodies defined by the epitopes of the antibody, which are much more specific than the claims in the Japanese and European counterparts. Notably, US8829165 and US8859741 have also been involved in extensive infringement litigation: the Federal Circuit Court vacated and remanded a ruling confirming the validity of the claims made in District Court. It stated that for such epitope claims to meet the written description and enablement requirements, the specification must disclose a representative number of the species failing within the scope of the genus, or structural features common to the members of the genus, so that those skilled in the art can visualize or recognize the members of the genus. *Amgen Inc. v. Sanofi*, 872 F.3d 1367, 1373, 1375-76 (Fed Cir. 2017), citing *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1350 (Fed Cir. 2010). This illustrates a stricter approach towards functional claims in the U.S., particularly when considering the Japanese IP High Court's ruling on the support and enablement requirements noted above.

> **"A patent invention of an antibody can be defined structurally and/or functionally."**

Pro-patent policy in Japan

Since the introduction of the Intellectual Property Basic Act in 2002, Japan has been undertaking a pro-patent policy, i.e., strengthening patent rights. The above court decisions illustrate such a pro-patent policy in Japan. Comparable pro-patent decisions were also made in other cases: for example, a recent controversial IP court decision acknowledged the validity of an invention for a medicament comprising the same ingredient as in prior art, that could be used for the same disease as in prior art, but wherein the claimed mechanisms of action are novel (Case No. 2018 (gyo-ke) 10036).

Meanwhile, in the U.S. and Europe, the pro-patent policy seems to be somewhat weakened, in view of a leading court decision in the U.S.[4] and a review by the EPO[5]. Going against such a trend, the Trump administration is restrengthening patent rights, stating "my administration will also take steps to strengthen our patent system here at home" on April 26, 2018, World Intellectual Property Day.

Recommended patent strategies for antibody inventions in Japan

In the case of Japan as described above, it would be worth considering including broad-scoped functional claims in an application for antibody inventions. For example, when there is a patentable

2 "Theme: Comparative study on 'reach-through claims'" in Report on Comparative study on biotechnology patent practices (Trilateral Project B3b Mutual understanding in search and examination), (2001) issued by EPO, JPO, and USPTO.

3 Tomatsuri, M., et al. "Research and Study for the problems for the patentability of bioscience-related/medicament inventions based on the international comparisons" (in Japanese) (2011) *Patents* **64** (12), 14-29.

4 *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006).

5 "Scenarios for the future" in Annual Review 2006, issued by EPO.

antibody defined by the six CDRs, a claim directed to an antibody which competes with the original antibody with respect to binding to the antigen could be recited to pursue a broader claim scope. Furthermore, during infringement litigation, the patent-holder of such a broad-scoped claim could make substantial arguments, citing the above court decisions. A pro-patent policy in Japan will encourage this.

On the other hand, a potential or alleged infringer could argue, for example, that the patented antibody cannot be obtained without undue effort and thus does not meet the support and enablement requirements. However, this might be not easy, considering the pro-patent policy in Japan, as discussed above. Thus, it would be important to create an impression on a judge that the claimed scope of such an antibody is so broad that healthy development of industry will be inhibited.

Conclusion

In a nutshell, recent Japanese court decisions acknowledged a significantly broader claimed scope of a patent for an antibody invention, thus reinforcing a trend towards a pro-patent policy in Japan. Considering this trend, as well as monitoring legal updates, is crucially important in order to optimize the patent strategies of pharmaceutical companies in Japan.

Acknowledgements

I thank Ms. Alison Santino, Mr. Paul Tokeshi, and Dr. Toshiyasu Ishioka for providing valuable comments and carefully reviewing this manuscript.

Contact

Sonoda & Kobayashi
Intellectual Property Law
Shinjuku Mitsui Building Suite 3401
2-1-1 Nishi-Shinjuku, Shinjuku-ku
Tokyo, Japan 163-0434
Tel: +81-3-53391093
www.patent.jp
info@patents.jp

園田・小林特許業務法人
SONODA & KOBAYASHI
INTELLECTUAL PROPERTY GROUP

Dealing with third-party patents in Europe

Sean Leach and Andrew White, Partners at Mathys & Squire, lay out a general roadmap to help non-European practitioners navigate the landscape.

A patent or patent application in the hands of a third-party, which covers a product which you wish to exploit presents a difficult challenge, and even more so if it is in a foreign jurisdiction. Preliminary qualitative research indicates that, in the US at least, the options to monitor and mitigate risks from European patents are not widely known. All but the most internationally focused US and Chinese attorneys use the European procedures infrequently, and their clients even less so.

Whether defending patent infringement action, reducing the risk posed by such actions, applying for complete or partial revocation of a patent, or opposing grant of a problem patent in the first place European jurisdictions offer many effective options, which by comparison with similar measures in the US are low-cost, low-risk and procedurally simple. Much can be done anonymously, and there are very good tactical reasons to take advantage of the possibility to remain anonymous.

In addition to these helpful features of the European procedural and legal landscape, there are other issues, such as bifurcation in Germany and the losing party's liability for the other side's legal costs, which can represent very significant risks in their own right.

The purpose of this article is to lay out a general roadmap to help non-European practitioners as they begin to navigate this landscape.

Sean Leach

Andrew White

> **If the Opposition window is missed it cannot be reopened.**

The background - patents granted by the EPO

The EPO provides a centralized examination procedure, through which a single application granted by the EPO is turned into a bundle of independent national patents.

Each patent must be dealt with separately after grant in the courts of each relevant national jurisdiction. Complete revocation of a granted European patent may thus require court proceedings in multiple jurisdictions, each conducted in a different language, under different evidential and procedural standards.

To a third-party to whom a European patent presents a risk, it is thus far better to take action at the EPO when possible. This can be done by filing so called "observations", or by filing an opposition within a nine-month time window after grant to have the patent revoked centrally at the EPO. Both can be done anonymously, which conveys a very significant tactical benefit because arguments can be advanced without constraining the conduct of future proceedings and because a patent proprietor forced to amend by an anonymous opponent cannot know the infringement target which they are aiming to hit.

In EPO proceedings there is no discovery or disclosure obligation on the parties, and only a very limited liability for the other side's costs. There is no estoppel, the quality of the decisions is high and the rules of evidence and the standards applied by the EPO mean that outcomes are, by comparison to national proceedings, straightforward, fast, and predictable.

1. Before grant: the options to attack an EPO or national application prior to grant in Europe

So-called "third-party observations" can be filed anonymously at the EPO at any point until the patent grants (and can even be filed against PCT applications before they enter the European Regional Phase).

The best time to file third party observations is thus early in examination before minds have been made up, and so the Examiner will be obliged to take them into account (the EPO Guidelines state that if the observations call into question the patentability of the invention in whole or in part, they must be taken into account). Experience suggests that unless the issue of patentability is prima facie clear, the observations may be less effective than one might hope. On the other hand, if the observations are fully substantiated and filed prior to any communication of intended grant, the EPO will normally issue a new office action within three months of their receipt.

The objections likely to fare best are clear added matter objections and clear novelty objections. Importantly, in Europe there is generally no presumption of validity. This is significant because a document being cited during prosecution does not mean that a national court will presume that a patent is valid over that document.

A potential downside to third party observations is that the applicant may amend the patent application so as to strengthen it. Thus, there may be attacks which could be made but which would be much better saved for an Opposition (see below). However, an applicant responding to anonymous observations does not have any infringement target in mind. It may therefore be possible, by carefully calibrated attacks, to shepherd an applicant toward a desirable amendment to clear a product without them ever having been aware of it.

2. Post-grant: the EPO opposition procedure, and its German national equivalent

As noted above, once a European patent application grants, it is converted into national rights, and litigation must be done at a national level at national courts. This can rapidly become expensive. One tactic adopted by some is to litigate in a single territory first and use the outcome of that litigating to force mediation/an agreement elsewhere. However, even adopting such a tactic, costs will be higher. For example, the cost of patent litigation in the English courts (even via the relatively cheaper Intellectual Property Enterprise Court) is typically measured in multiples of hundreds of thousands of pounds with further costs if there is an appeal.

By comparison, the cost of most EPO oppositions is generally less than £100K in all but the most complex cases, and simple cases can be won for far less. At the time of writing this article, an opposition (including detailed professional searches for prior art) could be concluded for about £30K-70K and takes around two to four years to complete. Normally, first instance proceedings culminate in an in-person hearing at the EPO. An opposition decision can be appealed, which can add another two to four years and further cost – although appeals can be accelerated.

The EPO issues on average around 2000 opposition decisions a year, and roughly 30% result in the patent being upheld as granted, about 30% result in the patent being revoked, with the remaining 40% resulting in the patent being maintained in amended form. Therefore, opposition proceedings represent a good prospect of having the scope of a granted patent changed in some form or other.

To take advantage of the Opposition procedure, it is of course necessary to be aware of the patent within the nine-month Opposition period. Only during this window of opportunity can the patent be challenged centrally at the EPO. It is, therefore, prudent to search for competitors' patent applications at the EPO and to monitor their progress. If the Opposition window is missed it cannot be reopened.

3. Post-grant: the options to control risk from national patents after grant and EP patents outside the EPO opposition period

a. UKIPO infringement and validity opinions

If the opposition period has been missed, or if it simply isn't relevant (e.g. the patent was filed directly in a selected number of European territories), there are still options available to challenge and cast doubt on the validity of granted patents in Europe without costly court proceedings.

In the UK, it is possible to obtain an opinion from the UKIPO either relating to the validity of the patent and/or as regards infringement. Opinions are fast and low

Résumés

Sean Leach, Partner

Sean is an expert in the drafting of IP agreements, IP licenses and in the drafting and prosecution of European and British patent applications. His principal areas of technical expertise are electronics, medical devices, and software. He qualified as a Chartered patent attorney in 2010 and a European patent attorney in 2011. Recognized by The Legal 500 for his knowledge of patent portfolio management and advice, Sean is commended by one source for being "technically brilliant" and that "even R&D folks, who are PhDs in their specialist areas, have commended his grasp of new technologies" (2020 edition).

Andrew White, Partner

Andrew has been commended by clients for his proactive approach and understanding of business strategy, and has been recognized as a Rising Star by Managing Intellectual Property IP STARS. Clients note that he can be "relied upon for both his legal knowledge and technical expertise". Andrew likes to develop long term relationships with clients and their technical teams to really understand where a business is going and how IP can be used as a tool to complement those drivers and help the business grow.

cost and can be used to influence the conduct of later proceedings, and may also have implications for awards of costs. Opinions can be requested anonymously.

UKIPO validity opinions are limited to issues of novelty and inventive step. The official fee is around £200 and the request can be filed against any patent or SPC, even if it is no longer in force. A list of opinions issued last year can be found here. The patentee is given an opportunity to comment, and the UKIPO will normally issue a validity opinion within three months. The opinion is non-binding, but the UKIPO can revoke a patent in cases where the patent is clearly invalid. This is rare. The procedure for obtaining an opinion on validity is relatively new, and to date (July 2020) 90 opinions have been issued, with 43 finding the patent to be invalid. Only 36 final decisions have been issued, with about half resulting in the patent being amended. In six cases the patent has been revoked.

Infringement opinions follow similar procedure and are also non-binding, but may serve as a useful negotiation tool to avoid or resolve a potential dispute.

b. Revocation actions in the national courts & before the UKIPO

In the UK, a revocation action can be taken before the UKIPO or the courts (The Intellectual Property Enterprise Court (IPEC) or the High Court (Patents Court). The action can be raised on essentially the same grounds as for an EPO opposition. If action is taken before the UKIPO, a typical timeframe may be between six months to a year. Notably, decisions from the UKIPO can be appealed to the Patents Court. While a revocation action cannot be filed anonymously, any individual or legal entity can apply for revocation and (unlike e.g. in the US), there is no requirement for any threatened or actual proceedings.

> **The objections likely to fare best are clear added matter objections and clear novelty objections.**

If action is taken before the IPEC or Patents Court, it would probably take around 12 months to go to trial. Notably an application for revocation can be stayed pending the outcome of any pending EPO opposition proceedings.

The costs of the proceedings will be determined by the complexity of the case but may typically be in the range of £10,000 to £30,000 before the UK IPO, £50,000 to £200,000 before IPEC and £250,000 to £1,000,000 or even higher before the Patents Court. In English litigation, the losing party generally has to pay the other side's costs. While costs are limited before the UKIPO and IPEC (in the IPEC the costs are capped at £50,000), in the Patents Court, there is no limit on the award of costs

Whilst the procedure before the courts of each jurisdiction is independent, and courts in different European countries do sometimes reach different conclusions on the same patents, a successful outcome from the court of a major jurisdiction is likely to at least influence proceedings in other territories.

c. Bifurcation and protective briefs in Germany

In Germany validity and infringement are dealt with separately (in so-called bifurcated proceedings). It is thus possible for a patentee to obtain a preliminary injunction very quickly and without any invalidity defense even being considered.

To defend against this risk, a protective brief can be filed pre-emptively at a German court setting out arguments against infringement or validity of the patent concerned. It is only disclosed to the patentee if they apply for a preliminary injunction. The benefit of a protective brief is that it ensures an invalidity defense must be addressed by the patentee and considered by the court before a preliminary injunction can be issued.

Conclusion

We have had a series of conversations with non-European attorneys to understand their view of European patent risk. The conclusion we drew from those conversations is that the monitoring and watching that most European attorneys do for their clients is not adopted as widely outside Europe as it could be. When faced with a European patent or patent application which presents a risk, forewarned is most certainly forearmed. The EPO opposition procedure is predictable, fast, and low cost. More people should use it. Although such action before the EPO has much to recommend it, there are also a range of options available in national jurisdictions to control risk without launching revocation proceedings as a first resort.

> **It is thus possible for a patentee to obtain a preliminary injunction very quickly.**

Authors Sean Leach and Andrew White will be presenting a webinar on this topic on Thursday 15 October – visit the Mathys & Squire website at https://bit.ly/3iXAIzY to register your free place.

Contact

Mathys & Squire
The Shard, 32 London Bridge Street,
LONDON SE1 9SG, England
Tel: +44 20 7830 0000
www.mathys-squire.com

UK Supreme Court's increasing involvement in patent law set to continue?

Chris de Mauny, Senior Associate at Bird & Bird, examines the impact on patent enforcement following the latest rulings.

Over the past three years, the UK Supreme Court has issued six decisions concerning patent law issues, displaying a surprising readiness to do so considering both that the Court only issues about 60-80 decisions per year and that prior to 2017, the Court had issued only four patent decisions in the eight years since it had replaced the House of Lords. With the appointment in 2018 of Lord Kitchin to the Court, a patent specialist his entire career, it may be that this trend will continue in the future.

Chris de Mauny

The most high profile of these decisions was probably the first, *Actavis v Eli Lilly* [2017] UKSC 48, which introduced a full doctrine of equivalents into UK law. The most recent, *Unwired Planet v Huawei* [2020] UKSC 37 also directly addressed enforcement in the particular context of standard-essential patents (SEPs). In between, three decisions have dealt with aspects of patent validity, and thereby indirectly with enforcement (*Warner-Lambert v Mylan* [2018] UKSC 56 – which also involved infringement of second medical use patents, *Actavis v ICOS* [2019]

Résumé

Chris de Mauny, Senior Associate

Chris is a senior associate in Bird & Bird's London office specialized in patent litigation. He has a keen interest in both the technical and legal issues raised in patent litigation, and in developing and carrying out a litigation strategy focused on achieving the client's objectives in the dispute. Most of the litigation he has worked on has involved an international element, including overseas clients in the majority of cases and frequent coordination with litigation in the courts of other countries or in the patent office. In the UK Chris has experience working at all levels up to and including the Supreme Court and he has also worked extensively on EPO proceedings.

Case	Field	Main legal issue(s)	Effect
Actavis **(pemetrexed)**	Pharmaceuticals	Infringement	Patent infringed. Full-blown doctrine of equivalents introduced, without file-wrapper estoppel.
Warner-Lambert **(pregabalin)**	Pharmaceuticals	• Requirement for 'plausibility' for sufficiency of disclosure / inventive step • Infringement of second medical use claims • Post-trial patent amendment	Relevant claims revoked. • A claimed effect must be made plausible by patent's disclosure. • Mixed decision, probably supporting an assessment based on objective factors • Attempting to amend post-trial will generally be an abuse of process
ICOS **(tadalafil)**	Pharmaceuticals	Inventive step	Patent revoked. Routine work to identify a best case (a dosage regimen) known to exist did not involve invention.
Regeneron **(transgenic mouse)**	Biotech	Breadth of claim insufficiency	Patent revoked. The patent must disclose enough information to enable its implementation across the whole scope of its claim.
Unwired Planet **(SEPs)**	Mobile telephony	Imposition of global FRAND terms	The UK Courts could impose a FRAND royalty rate on a global basis consequent on a finding of infringement of a UK patent and/or grant an injunction if a FRAND licence offer was not taken up.

UKSC 15 and *Regeneron v Kymab* [2020] UKSC 27), while the case of *Unilever v Shanks* dealt with employee compensation for an outstanding invention and is not considered further here.

Given this body of case law from the highest judicial authority in the UK, one might look for a common thread of principle guiding the outcome or consider whether the UK has become more or less attractive as a patent enforcement jurisdiction. What is notable is that the judges making these decisions have, generally, reached their conclusion by applying a 'back to basics' approach to the issues before them, using fundamental principles to guide their hand in resolving the cases. The outcomes of the decisions are summarized in the table above.

> **A 'back to basics' approach.**

Starting with *Actavis v Lilly*, the Court based its decision upon interpretation of the European Patent Convention – specifically the Protocol to Article 69 – and its requirements for dealing with equivalents. The Court concluded that the requirement in the Protocol that "due account" be taken of equivalent features not only meant that they must be taken account of in some way, but that this should be addressed separately to interpretation of the claim. An unresolved consequence of this approach is that it may be the case that a patent could cover, by equivalence, something in the state of the art before the patent was filed – this may be more theoretical than real.

The Court imposed significant restrictions on reference to the file wrapper for the purpose of considering patent infringement. Combined with the above, the decision appeared highly favorable to patentees because, provided a patent would not fall foul of invalidity because of the extended scope of protection, it could be asserted in a more broad-brush way without encumbrance from any 'baggage' on the file wrapper. However, in the three years since this decision was given, remarkably few decisions have turned on the doctrine of equivalents: only in a handful of cases has infringement depended on equivalence for a patent upheld as valid. All but one of these cases have involved mechanical inventions (one for a medical device) and the exception concerned a mobile telephony SEP.

Addressing next the *Warner-Lambert, ICOS* and *Regeneron* decisions, a degree of consistency of approach is found in the Court's reasons. In each case, the Court discussed the 'patent bargain' that has been understood for many years partly to justify the monopoly provided by patents to those who file them, and which is expressed in the legislation through the requirements of novelty, inventive step and sufficiency of disclosure (among others). These patents were revoked because their monopolies were not justified by the contribution they made – it was insufficiently disclosed, or uninventive. Whilst none of these decisions has changed the legal landscape as radically as *Actavis v Lilly*, together they have brought a sharper focus on the need for a patentee to justify the breadth of its claimed monopoly, by reference to what is actually disclosed in the patent.

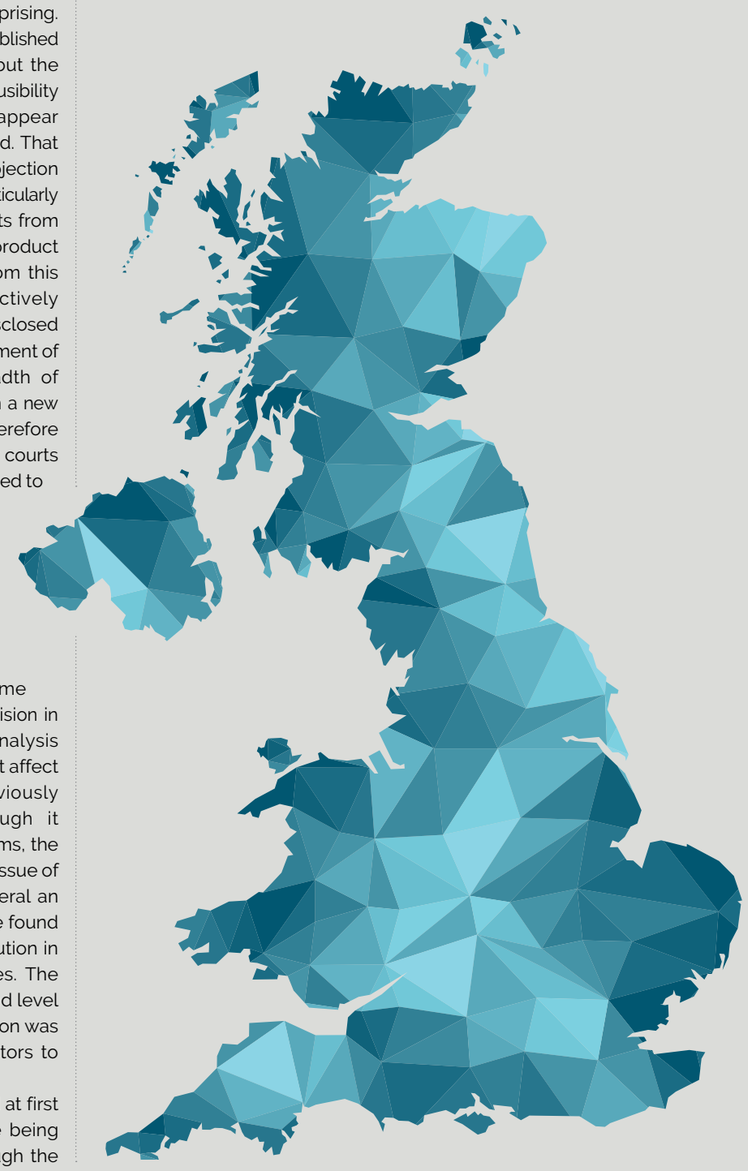
In *Warner-Lambert*, claims were revoked at all levels and to that extent was not surprising. Plausibility as a feature of the law was established already in EPO and English case law but the interpretation of the requirements for plausibility given by the majority of the Court appear stricter than those previously recognized. That said, plausibility is rarely raised as an objection outside the life sciences field and most particularly in medical use cases. Indeed, comments from Lord Sumption at [19] imply that a new product or process will almost never suffer from this problem, suggesting that it is effectively confined to new use patents – if the disclosed invention can be performed, the requirement of sufficiency is satisfied (ignoring breadth of claim issues) unless the novelty relies on a new purpose of something old, which must therefore be plausible. In agreeing with the lower courts that the patentees should not be permitted to amend the patent post-trial in order to save it the Court reduced the options for future patentees address problems with validity encountered during assertion.

In *ICOS*, the patent was upheld at first instance but overturned on first appeal as well as in the Court. Some commentators considered that the decision in this case was harsh. However, the analysis provided by the Court for the factors that affect inventive step had all been previously recognized in various cases. Although it addressed inventive step in general terms, the case was concerned with the particular issue of dosage regimen patents where in general an optimum dosing regimen will exist to be found and earlier case law had expressed caution in finding an inventive step in such cases. The Court acknowledged that the burden and level of research required to make the invention was relevant, but only as one of many factors to consider.

In *Regeneron*, the patent was revoked at first instance but upheld on appeal before being revoked by the Supreme Court. Although the outcome of that appeal was not wholly surprising, the Court's statement of the principles for breadth of claim insufficiency appear to have applied a higher standard for disclosure than realised in previous case law. Breadth of claim insufficiency can arise in any field, but it is more commonly raised in challenge to life sciences and chemical patents.

What may be derived from the *Warner-Lambert, ICOS* and *Regeneron* cases is an attempt by the Supreme Court to ensure that patents are not given in circumstances where the monopoly is not deserved according to the principles of inventive step and sufficient disclosure, which, as

> **The decision appeared highly favorable to patentees.**



UK PATENT DECISIONS

"Some patents may be found invalid that would have been thought valid previously."

the Court discussed, flow from the fundamental principle embodied in the "patent bargain". The result in all three may be seen as tightening the law in these respects, raising the bar slightly for patents which may be susceptible to the kinds of challenges brought in those cases. However, the patents under consideration were somewhat "edge" cases: the second medical use patent in *Warner-Lambert* was held invalid at every level; *ICOS*' patent was for a dosing regimen while Regeneron's transgenic mouse patent took years for the patentee itself to put into effect after the patents were filed. While these decisions have tightened the law in certain respects, the substantive effects may be confined in the future to similar edge cases. That being said, it is of course clear that the judgments, given their judicial status, will regularly be cited in the future, and it remains to be seen whether their effects are also felt more widely for important or valuable patents.

Drawing together the effects of *Actavis* and the following cases, the Court's decisions give scope for patent infringement to be established by equivalents where the inventive concept is used even if the claim language does not cover the infringement. However, if the scope of the patent exceeds the inventive contribution made, it is more likely to be revoked than before. And a technically obvious patent will not escape revocation because it results from substantial research and investment.

Overall, some patents may be found invalid that would have been thought valid previously and some patents may be infringed that previously would not. Thus, the environment for enforcement, overall, may not necessarily have become harsher or more benign overall, but differently shaped. Some patents (and their holders) will benefit while others will lose out. However, it must be acknowledged that the trend of decisions on validity are more likely to impact patents for medicinal patents owing to the pressure to file patents for the incredibly valuable inventions in these fields before competitors. Thus, while some patents of this kind may be infringed by equivalents – as in the *Actavis* case – the overall benefit of the Supreme Court case law may fall to patents in the technology sector which are generally less susceptible to the kinds of validity challenges considered in the recent case law.

That suggestion comes before considering *Unwired Planet*. The case is the fruition of years of litigation by the claimant SEP portfolio holder seeking to use the English courts to force SEP implementers to take a license, on FRAND terms, to its portfolio. This litigation has explored a number of legal issues along the way but the Supreme Court's decision of August 2020 establishes the availability of this litigation tool in the UK courts, including crucially that the FRAND terms may be adjudicated on a global basis and that an injunction may be granted against an SEP implementer who refuses to enter into a license on FRAND terms the court determines.

Below the Supreme Court level, other recent decisions have shown the English courts' flexibility in developing the law, not always to patent holders' benefit. Again, much of this case law derives from and is most likely to impact life sciences patents. Thus, the approval by the Court of Appeal of the so-called *Arrow* declaration – enabling a party clearing the path for product entry to address a patentee's portfolio including pending patent applications, in appropriate circumstances – may hamper patent holders' use of patent thickets. Likewise, the Court of Appeal has recently upheld a decision refusing to grant an interim injunction to restrain generic medicine market entry where the patentee's case for irreparable harm was considered not made out, raising questions over the "clear the path" approach for generic medicine entry in the UK. This has caused concern for some patent holders in the life sciences area.

In sum, the high incidence of Supreme Court patent decisions over the last three years appears to have re-balanced the power of patent enforcement. The effects may be regarded as generally positive for patent holders in the technology sectors where equivalence may assist them and, where SEPS are concerned, the *Unwired Planet* judgment may be beneficial. In the life sciences sector the overall effect may be less positive for patent holders, particularly when taken together with other important legal developments emanating from the Court of Appeal, as referred to above.

"This has caused concern for some patent holders in the life sciences area."

Contact

Bird & Bird LLP
12 New Fetter Lane, London EC4A 1JP, United Kingdom
Tel: +44 (0)20 7415 6000
www.twobirds.com
Christopher.deMauny@twobirds.com

Startups – what you need to know

Tamara El-Shibib, Patent & Technology Transfer Consultant at Cedar White Bradley, outlines the key steps that startups can take to better manage their IP early and avoid costlier setbacks in the future.

IP considerations for innovative start-ups

When entrepreneurs think of launching a new product or service, protecting their IP is not usually at the top of their list. They know it's important but with limited funds and typically high legal fees, taking care of IP matters is usually low on the list. When preparing for a funding round, it's no secret to a tech startup that investors are interested in a well-managed IP portfolio. Managing IP is critical in optimizing the valuation of a tech startup and positioning for a successful funding series. Technology solutions, know-how, test data, consumer validation, brand, user- base, relationships, and business methods are examples of core intellectual assets which need to be managed for success. Some of these are protected with legal rights like patents and trademarks, whilst others are controlled using contracts, secrecy, and other tools. In addition to controlling core assets, startups need to demonstrate that there are no apparent risks with regards to IP ownership or infringement of third-party IP. In this article, we outline the key steps that startups can take to better manage their IP early and avoid costlier setbacks in the future.

Tamara El-Shibib

Make sure IP is assigned to the startup

One of the first things to do once your startup is incorporated is to make sure it owns or has access rights to core IP. Ensure all founders, employees, consultants, and contractors assign their IP rights to any IP developed for the startup (either through the startup's funding or resources), or during their employment with the startup, to the business. This is commonly given via assignment provisions in an employment contract, contractor agreement, consultancy agreement, etc., or via a standalone IP assignment agreement. If IP rights cannot be assigned, make sure your startup receives a license to use the IP rights. This is commonly given via a licensing agreement between the IP owner and your startup. It's best practice to assign all IP (from founders, employees, contractors, consultants, etc.) relevant to your startup to the business instead of an individual having ownership of the IP. Make sure you keep written and dated records of any designs, works, creations, inventions, lists, etc., so that you can clearly identify the contents, who contributed and when. This is to prevent IP ownership issues in the future because people may leave for other ventures.

> **Novelty is a key requirement for patenting.**

Use NDAs

During the early stages of the startup's journey, it's not uncommon for the startup to have to disclose details of their product to attract investment and partnerships. To avoid disclosing any confidential information, consider using Non-Disclosure Agreements, or 'NDAs', with third parties. This helps to ensure that you don't lose a chance to protect your IP before disclosing it. This is especially important for potentially patentable subject matter and trade secrets. Novelty is a key requirement for patenting. Once confidential information becomes public, you can no longer protect it. In addition to preserving IP rights, this also ensures that your core assets are not misappropriated. Consider consulting with an IP attorney in order to make sure that you are properly protecting your IP rights and using an appropriate NDA. Once NDAs are in place, work with your team to draft procedures to comply with any NDAs you have signed.

Consider IP protection

Depending on what your technology is, you may be able to benefit from multiple types of IP protection. Patents protect new and inventive technical solutions. Original software is protected by copyright. Valuable confidential business methods, test data and other assets may be protected as trade secrets. The company trade-name and distinctive logos are protected by trademarks. Many startups fail to recognize the value of securing trademark protection for their brand early on. It's not uncommon for startups to spend hundreds of thousands of dollars on branding and marketing only to later discover that their tradename and logo are not registrable. Not only does it cost the business a lot of money to rebrand but they also risk losing consumers who have come to associate their product or service with that brand.

With high broadband and smart phone penetration rates in the MENA region, there is a growing and sizeable market for the provision of services and goods through mobile applications. Certain distinctive features of your mobile application may be protectable under copyright and trademark law. Although software 'as such' is non-patentable, there are patenting strategies which can be deployed for protecting the underlying novel functional features of a 'computer-implemented invention'. While copyright may prevent others from copying source code or a substantial part of it, it does not protect ideas or the functional aspects of the software program as a patent would. A patent also gives the owner a twenty-year monopoly over that technology concept which allows you to build a more competitive position in the market, charge premium prices, grow a reputable brand, and increase business value. Although building and maintaining a patent portfolio is costly, there are patenting strategies that can help startups protect core IP early and delay patent costs.

Résumé

Tamara El-Shibib, Patent & Technology Transfer Consultant

Tamara joined CWB in 2016 to support the development of its patent practice. Tamara advises clients on patent protection and commercialization. She also assists clients in establishing in-house commercialization programs and technology transfer practices. Tamara has extensive experience working with regional academic and research organizations to implement IP management and technology transfer practices to support innovation. Tamara has advised a range of clients, including government, SMEs, startup companies and individual inventors on patent filing strategies in the region and patent portfolio management. Tamara also assists clients in the development of innovation support programs.

> **Conducting a 'prior art' search can be one of the most valuable pre-filing steps.**

> **Filing a US provisional patent application early is a low cost way to secure the earliest filing date for your invention.**

Work with a patent attorney to design a patent strategy

If you decide to patent your technology, what you claim in your patent and where you file your patent are important decisions that need to be aligned with your business strategy. In addition, there are certain steps you can take to minimize your patenting costs upfront while ensuring you protect IP that is core to your business. Conducting a 'prior art' search can be one of the most valuable pre-filing steps. By running a preliminary patent search on one of the free patent databases, e.g. Google patents or specific jurisdictional patent registers, you can determine whether your technology solution is already patented and who owns closely related technology. This information also allows you to identify complementary proprietary IP and any potential freedom to operate issues that may arise down the road.

It's a good idea to consult a patent attorney to get an official patentability analysis and opinion, however, by performing a preliminary search yourself you can determine whether it's worth the time and investment upfront. If you do decide to work with an attorney, this information will also be helpful to them in understanding exactly what your technology is and how it differentiates from existing technology, giving you a more focused set of search results and a more specific opinion on patentability.

Two crucial areas to consider in your patent strategy are your claim scope and your filing strategy. It's important you work with a patent attorney early on. Let them know your budget, what you consider to be your core technology assets and what your business strategy is. It's common for a technology to develop beyond its initial prototype during technical and market validation. A patent attorney can work with you to design a patent strategy which considers your budget, the product you want to commercialize, the markets you want to enter and the time frame for product development and market entry. Keep them informed of any technical developments as they'll need to make sure any improvements to the original technology are also protected.

US provisional patent applications are a relatively low-cost way of securing an early filing date for a patent application. Most patenting systems in the world depend on a first-to-file rather than a first-to-invent system. This means if two independent inventors develop the same invention, whoever files a patent application on the idea first is awarded the patent. Therefore, filing a US provisional patent application early is a low cost way to secure the earliest filing date for your invention. Since no claims, drawings, or translations are needed, this significantly reduces the attorney fees for preparing the application. It also gives the applicant 12 months to make the decision on whether to pursue a 'full' non-provisional application in any country or abandon the application. Unlike non-provisional applications, provisional applications are never published by the USPTO and therefore do not form prior art for a later filing if you decide to abandon the application.

PCT international applications are another way to delay high patenting costs. By filing a single international application under the PCT, applicants can simultaneously seek protection for an invention in many countries (153 PCT member states) simplifying the filing process and reducing the high cost of meeting the translation and legalization requirements in every country. At 30 months from the filing date, the international application enters the National Phase at which time the applicant must confirm the countries for protection by forwarding the application to the designated patent offices and meeting the national filing requirements. For a lean startup, delaying these patenting costs for 30 months can be incredibly beneficial while you validate your markets and establish your value chain. If on the other hand ..you are dealing with 'a' rapidly evolving technology market

Once you've filed your application, you are free to discuss or disclose your technology to third parties. Make sure to include 'patent pending' notices on your marketing materials and products. In addition to enhancing your brand value, this may help to deter potential infringers.

IP Licensing

During your marketing phase, you may be approached by third parties interested in your technology. Consider granting a non-exclusive IP license to third parties that are not in direct competition with you. An IP license grants another party permission to use IP under specific conditions for a certain period in return for an economic benefit. This may provide an additional revenue stream for your business and invite cross licensing opportunities for access to complementary technology. Whether your startup follows a B2B or B2C business model, make sure you have an appropriate licensing agreement in place to cover the scope and term of the license you are granting for use of your startup's technology, product or services. It's a good idea to consult with an IP or commercial attorney at this point to ensure that your licensing agreement sufficiently protects your IP while granting appropriate rights to your clients to use the IP.

Consider conducting a due diligence exercise of the IP you use or intend to use. If you do not own the IP you intend to use, make sure your startup receives a license to use IP rights from the IP owner. If you are using third party IP, you want to make sure that you have the correct permissions and licenses in place (this applies to any type of IP – patents, copyrights, trademarks, etc.). It's also very important to make sure that the licensing agreement covers issues associated with collection of end-user data, data privacy and data breaches. This is a good time to consult with an IP attorney to ensure that you are complying with any relevant jurisdictional and international laws.

Preparing the right language, terms and contracts in advance will help ensure that the ownership rights to your IP are protected and that all obligations and duties are properly documented. Consider the types of IP licenses you need to deliver your value proposition, what terms and conditions need to be in the license to reflect the scope of intended use, and how to manage royalties and license obligations. Once licenses are executed, work with your team to draft procedures to comply with licensing agreements that you have signed.

Access resources at your disposal

The UAE has become recognized as a startup hub in the region due to its favorable business conditions, attractive tax and investment schemes and increasing venture capital. There are over 20 incubator and accelerator programs in Dubai alone. It's common for these programs to offer free IP clinics and workshops to startups. In addition, some firms provide special rates and pro-bono services to startups through these programs. Consider attending a workshop on IP or an online webinar. Realizing the importance of strategic IP management early on can help you maximise the value of your business and avoid costlier setbacks down the road.

Contact

Cedar White Bradley
Burj Al Salam, 47th Floor
2 Sheikh Zayed Road, Dubai,
United Arab Emirates
Dubai@cwblegal.com
Tel: +971 4 3816888

> **Consider conducting a due diligence exercise of the IP you use or intend to use.**

Directory of Services

CHINA

ANSEN Patent Law Office

Established in 1999, is a Chinese intelltual property law firm located in Beijing, China, with good reputation in professional service, competitive price and high quality management. ANSEN is specializing in providing both domestic and international clients professional service in the fields of the patent, trademark, copyright as well as IP litigation in China. Our attorneys and engineers have had extensive experience in technical fields of new material, mechanical, electrical & electronics, communication, computer science, food, biotechnology and agriculture engineering etc.

Tel: +86 10 82837725/6
Website: www.citicip.com
Email: citicip@citicip.com
Contact: Xiaojuan Zhang and Lin XU

GUATEMALA

Lexincorp

A leading Central American law firm with 7 offices located in the major cities throughout the region. LEXINCORP has specialized in providing legal advisory to our domestic and international clientele for more than 40 years. Our regional practice has evolved to integrate processes, services, knowledge, business, values and solutions to provide the highest quality results operated as a single, fully integrated Central American firm with over 80 lawyers.

Address: 9a Avenida 14-78 zona 10, Guatemala, Guatemala, C. A.
Tel/Fax: (502) 2246 3000 / (502) 2333 5980
Website: www.lexincorp.com
Email: gonzalomenendez@lexincorp.com
groca@lexincorp.com
Contact: Mr Gonzalo Menéndez G., Ms Gina Roca

HONDURAS

BUFETE MEJIA & ASOCIADOS

A full-service Intellectual Property law firm covering: Honduras and Central America offering a convenient and cost-effective regional service. The firm services include filing, prosecution, maintenance, enforcement and defense of all types of intellectual property. Furthermore, the firm has strong litigation and arbitration capabilities and is known for handling complex litigation matters as well as infringement and anti-counterfeiting actions before all Courts, Administrative Offices and Customs authorities.

Tel: +504 25507744 / +1 (914) 4125719
Fax: +1 (718) 7322118
Website: www.bufetemejia.com
Email: info@bufetemejia.com
Contact: Ricardo Anibal Mejia Mejia
& Blanca Rebeca Mejia Lozano

India

Excellon IP

EXCELON IP is a full-service Intellectual Property Solutions Provider, guiding clients ranging from early-stage start-ups to MNCs across several industries in protecting their intellectual property in India and across the globe. Established with our intellectual capital in the field of IP rights, we are a one-stop escape for all IP related matters.
We have blend of experience including technical as well as IP laws and that makes us different.
We believe in customer centric approach and always committed to provide customized solution suitable for client requirement and need.

Tel: +91 951233 2604
Website: https://excelonip.com/
Email: ipr@excelonip.com
Contact: Sanjaykumar Patel
(Founder- Principal IP Attorney)

INDIA

Mehta & Mehta Associates

Mehta & Mehta Associates (Gurgaon, INDIA) is a full-service boutique IP Law Firm, providing Filing, Prosecution and Litigation services in respect of Patents (in different fields of science and engineering), Trade Marks, Designs and Copyright. The Firm assists both national and international clientele, from different geographical locations and backgrounds for all IP related contentious and non-contentious matters.

Address: Mehta & Mehta Associates, Mehta House, B-474, Sushant Lok-1, Sector-27, Gurgaon-122002, NCR, India
Tel: +91-124-410 8474, 410 8475
Fax: +91-124-410 8476
Website: www.mehtaip.com
Email: mehta@mehtaip.com
Contacts: Dr. Ramesh Kr. Mehta, Founder
Ankush Mehta, Principal Attorney

INDIA

R. K. DEWAN & CO.
ADVOCATES, TRADEMARK
& PATENT ATTORNEYS
INDIA
Established in 1942

Maximum Leverage
Minimum Stress

New Delhi, Chennai, Pune, Indore, Mumbai, Kolkata, Bengaluru, China

www.rkdewan.com
dewan@rkdewanmail.com

LUXEMBOURG

Patent 42

Patent 42 is a law firm acting in Industrial Property. Our job is to help and assist companies and entrepreneurs in protecting and defending their investments in innovation and creation.
If innovation is first of all a state of mind, it is also a necessity and a source of development and growth for your company. Investments carried out to develop new products or new activities deserve to be protected.seeking to protect valuable original creations.

Address: 34, rue Dicks
L-4081 Esch-sur-Alzette
Luxembourg
Tel: +352 691 999 350
Fax: +352 24 61 10 10
Email: info@patent42.com

MACAU

IPSOL

IPSOL is a key service line focused on the planning, registration and management of trademark, patent and other IP rights portfolios, offering solutions that enable to maximize the protection of your IP assets in Macau and worldwide.

Address: Avenida da Praia Grande, 759, 5° andar, Macau
Tel: (853) 2837 2623
Fax: (853) 2837 2613
Website: www.ipsol.com.mo
Email: ip@ipsol.com.mo
Contact: Emalita Rocha

MEXICO

Goodrich Riquelme Asociados

Our staff of attorneys, engineers and computer specialists help adapt foreign patent specifications and claims to Mexican law, secure patent inventions and trademark registrations and maintain them by handling the necessary renewals. Our computer system, which is linked to the Mexican Patent and Trademark Department, permits us to provide our clients with a timely notice of their intellectual property matters. We also prepare and register license agreements.

Address: Paseo de la Reforma 265, M2, Col. Y Del. Cuauhtemoc, 06500 Mexico, D.F.
Tel: (5255) 5533 0040
Fax: (5255) 5207 3150
Website: www.goodrichriquelme.com
Email: mailcentral@goodrichriquelme.com
Contact: Enrique Diaz
Email: ediaz@ goodrichriquelme.com

Directory of Services

MEXICO CITY

TOVAR & CRUZ IP-LAWYERS, S.C.

We are a specialized legal firm providing intellectual property and business law services. Founded in 2009. The purpose is that our clients not only feel safe, besides satisfied since their business needs have been resolved, so, our professional success is also based on providing prompt response and high quality, personalized service. “Whatever you need in Mexico, we can legally find the most affordable way”

Tel: 525556611278
Website: www.tciplaw.mx
Email: ecruz@tciplaw.mx
mtovar@tciplaw.mx
contactus@tciplaw.mx

Contact: Elsa Cruz, Martin Tovar

NIGERIA

Aluko & Oyebode

We are a full-service law firm focusing on patent prosecution rated for Patent Contentious by Managing Intellectual Property. The Firm was named Law Firm of the Year 2015 and Intellectual Property & Technology Team of the Year 2017 by Law Digest Africa Awards. The Firm was also named the Law Firm of the Year 2016 and Intellectual Property Team of the Year 2017 by ESQ Nigerian Legal Awards. We will continue to advise clients on patent strategy in Nigeria, Ghana, OAPI and ARIPO.

Address: 1 Murtala Muhammed Drive, Ikoyi, Lagos, Nigeria
Tel: +234 1 462 8360 / +234 806 680 3387
Website: www.aluko-oyebode.com
Email: Uche.Nwokocha@aluko-oyebode.com
aoip@aluko-oyebode.com
Contact: Uche Nwokocha, Partner

PAKISTAN

Bharucha & Co.

Established in 1948, Bharucha & Co. is one of the leading Intellectual Property law firms in Pakistan providing full range of IP services including all aspects of patents, trademarks, designs, copyright, domain names, licensing, franchising and litigation. The firm is ranked among the leading law firms in Asia by most of the prestigious legal referral guides.

Address: F-7/1, Block 8, K.D.A Scheme 5, Kehkashan Clifton, Karachi, Pakistan.
Tel: +92-21-3537 9544
Fax: +92-21-3537 9557-58
Website: www.bharuchaco.com
Email: email@bharuchaco.com
Contact: Mohammad Fazil Bharucha, Abdul Aziz

PAKISTAN

United Trademark & Patent Services

International Intellectual Property Attorneys specialising in Trademarks, Patents, Designs, Copyrights, Domain Name Registration, Litigation & Enforcement services.

Address: 85 The Mall Road, Lahore 54000, Pakistan
Tel: +92 42 36285588, +92 42 36285590, +92 42 36285581, +92 42 36285584
Fax: +92 42 36285585, +92 42 36285586, +92 42 36285587
Website: www.utmps.com & www.unitedip.com
Email: unitedtrademark@unitedtm.com
Contact: Yawar Irfan Khan, Hasan Irfan Khan

PHILIPPINES

Romulo Mabanta Buenaventura Sayoc & de Los Angeles

Founded in 1902, the firm is now 114 years old. A full-service IP firm, it has pioneered in Intellectual Property law practice, and some of its key cases decided by the Philippine Supreme Court have been featured in Philippine Reports, formerly the repository of the decisions of the Philippine Supreme Court, and now in the Supreme Court Reports Annotated (SCRA).

Address: 21st Floor, Philamlife Tower, 8767 Paseo de Roxas, Makati City 1226 Philippines
Tel/Fax: (632) 5559555; (632) 8134558; (632) 8103110
Website: romulo@romulo.net
Email: rogelio.nicandro@romulo.com
Contact: Rogelio Nicandro; Joaquin V. Sayoc

RUSSIA

Sojuzpatent

Sojuzpatent is the oldest leading IP law firm on the territory of the former USSR, with seven offices in Russia, and associates in all the neighboring countries. We employ more than 150 people, including 50+ patent attorneys and litigation lawyers, to achieve seamless prosecution and successful litigation. We offer everything you may need for protecting your IP in the whole region.

Address: Myasnitskaya St., 13, Bldg. 5, Moscow, 101000, Russia
Tel: +7 495 221 88 80/81
Fax: +7 495 221 88 85/86
Website: www.sojuzpatent.com
Email: info@sojuzpatent.com
Contact: Svetlana Felitsina, Managing Partner
Tatiana Petrova, Head of Trademark Department

RUSSIA

Vakhnina and Partners

One of the leading IP firms in Russia. Advising our clients on all aspects of IP in Russia, Ukraine, ex-USSR countries and Baltic States. Using our own trademark search engine. Services: Patents, trademarks, designs, utility models, copyright, litigation and enforcement. Members of Russian PA Association, INTA, AIPPI, LESI, ECTA, PTMG, GIPC.

Address: Bld. 6, Preobrazhenskaya Pl., Moscow, 107061, Russia
Tel: +7-495-231-4840
Fax: +7-495-231-4841
Website: www.vakhnina.com
Email: ip@vakhnina.ru
Contact: Dr. Tatyana VAKHNINA
Dr. Alexey VAKHNIN

SWEDEN

Fenix Legal

Fenix Legal, a cost-efficient, fast and professional Patent and Law firm, specialized in intellectual property in Europe, Sweden and Scandinavia. Our consultants are well known, experienced lawyers, European patent, trademark and design attorneys, business consultants, authorized mediators and branding experts. We offer all services in the IP field including trademarks, patents, designs, dispute resolution, mediation, copyright, domain names, IP Due Diligence and business agreements.

Tel: +46 8 463 50 16
Fax: +46 8 463 10 10
Website: www.fenixlegal.eu
Email: info@fenixlegal.eu
Contacts: Ms Maria Zamkova
Mr Petter Rindforth

TAIWAN, ROC

Deep & Far Attorneys-at-law

Deep & Far attorneys-at-law deal with all phases of laws with a focus on IPRs, and represent some international giants, e.g. InterDigital, MPS, Schott Glas, Toyo Ink, Motorola, Cypress. The patent attorneys and patent engineers in Deep & Far normally are generally graduated from the top five universities in this country. More information regarding this firm could be found from the website above-identified.

Address: 13 Fl., 27 Sec. 3, Chung San N. Rd., Taipei 104, Taiwan
Tel/Fax: 886-2-25856688/886-2-25989900
Website: www.deepnfar.com.tw
Email: email@deepnfar.com.tw
Contact: C.F. Tsai, Yu-Li Tsai

To enter your firm in the Directory of Services section please email katie@ctclegalmedia.com

Directory of Services

TURKEY

Destek Patent

We are a multinational legal practice that has provided full range Intellectual Property services including trademarks, patents, designs, plant variety protection and more since 1983. With more than 200 qualified in-house staff, including 50 patent and trademark attorneys, we are able to assist domestic and international clients worldwide.

Address: Eclipse Business D Blok No:5, ISTANBUL
Tel: +90 212 329 00 00
Website: www.destekpatent.com
Email: global@destekpatent.com
Contact: Claudia Kaya (claudia.kaya@destekpatent.com)
Murat Bürkev (murat.burkev@destekpatent.com)
Simay Akba (simay.akbas@destekpatent.com)

Uganda

SIPI Law Associates

SIPI Law Associates is a boutique commercial law practice in Uganda, with a bias to Intellectual Property Law. Our IP advisory services cover all transactional aspects of Patents, Trademarks, Copyright, Industrial designs, Trade Secrets and licensing aspects. The firm philosophy is based on providing first class legal services based on the integrity of our staff, giving our clients sound legal and timely advice, as well as holding our clients' information in the utmost confidentiality.

Address: PO BOX 4180, KAMPALA, UGANDA
Visiting: Jocasa House, Third Floor, Unit 5 Plot 14 Nakasero Road.
Tel/fax: +256 393 272921/ +256 414 235391 / +256 752 403 763
Website: www.sipilawuganda.com
Email: info@sipilawuganda.com
Contact: Paul Asiimwe; Dinnah Kyasimiire

UKRAINE

Pakharenko & Partners

Pakharenko & Partners provides full IP service coverage in Ukraine, CIS countries and Baltic states and has offices in Kyiv and London. We pride ourselves on an exclusive expertise and experience in the fields of IP law, anti-counterfeiting and anti-piracy, pharmaceutical law, competition law, advertising and media law, corporate law, litigation and dispute resolution.

Address: P.O.Box 78, 03150 Kyiv, Ukraine
Visiting: Business Centre 'Olimpiysky', 72 Chervonoarmiyska Str., Kyiv 03150, Ukraine
Tel/Fax: +380(44) 593 96 93 +380(44) 451 40 48
Website: www.pakharenko.com
Email: pakharenko@pakharenko.kiev.ua
Contact: Antonina Pakharenko-Anderson Alexander Pakharenko

UNITED STATES

Young & Thompson

Young & Thompson, established in 1903, is a full service intellectual property law firm focusing on U.S. patent and trademark prosecution of the highest quality while maintaining costs at a moderate level. Young & Thompson has been recognized as an industry leader for innovation in new technologies and procedures, being among the first law firms adopting a paperless workplace, and co-developed an automated solution for creating and executing all workflows.

Address: 209 Madison Street, Suite 500, Alexandria, VA 22314
Tel: 703-521-2297
Fax: 703-685-0573
Website: www.young-thompson.com
Email: embon@young-thompson.com
Contact: Andrew Patch

VIETNAM

Annam IP & Law

ANNAM IP & LAW is one of the most professional Intellectual Property & Law Firms in Vietnam, member of APAA, INTA and VIPA. We provide our clients with a full range of IP services to protect their inventions, trademarks, industrial designs and related matters not only in Vietnam, but also in Laos, Cambodia, Myanmar and other jurisdictions. We also provide our clients with legal advices on Finance and Corporate and Business Law.

Tel: (84 24) 3718 6216
Fax: (84 24) 3718 6217
Website: https://annamlaw.com/
Email: mail@annamlaw.com.vn annamlaw@vnn.vn
Contact: Le Quoc Chen (Managing Partner) Dzang Hieu Hanh (Head of Trademark Department)

VIETNAM

ELITE LAW FIRM

ELITE LAW FIRM, with a team having solid expertise in a broad range of Intellectual Property, provides professional and highest quality in IP matter in Vietnam as well as many countries around the world such as Laos, Cambodia, Myanmar, Thailand… Optimizing client's benefits is our top goal. We commit to obtain IP rights for our diverse cilents by expeditious solutions and in the most effective way.

Address: 255 Hoang Van Thai Street, Thanh Xuan District, Hanoi, Vietnam
Tel: (84-24) 37373051
Fax: (84-24) 37373056
Website: lawfirmelite.com
Email: info@lawfirmelite.com
Contact: Mr. Nguyen Tran Tuyen – Managing Partner/ Patent and Trademark Attorney

VIETNAM

Pham & Associates

Established in 1991, staffed by 110 professionals including 14 lawyers and 34 IP attorneys, Pham & Associates is one of the largest legal practices in Vietnam specialized in IP. The firm is one of the biggest filers of patents, trademarks and industrial designs each year and has been renowned for appeals, oppositions, court actions and handling IP infringements. The firm also advises clients in all aspects of copyright law.

Tel: +84 24 3824 4852
Fax: +84 24 3824 4853
Website: www.pham.com.vn
Email: hanoi@pham.com.vn
Contact: Pham Vu Khanh Toan, Managing Partner
General Director
Tran Dzung Tien, Senior IP Consultant

To list your firm in this section, please email katie@ctclegalmedia.com

Bazaar of bizarre inventions

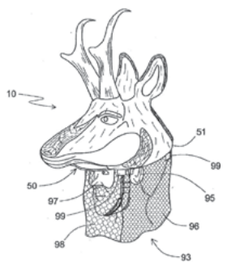
Glen Kotapish, Founder of Planet Patent, shares some of his weird patent discoveries with a quest to continue the search.

Never done a patent search before? Have you ever wondered what a patent search actually involves? It's not like finding the proverbial needle in the haystack. It's more like discovering the right needle in a stack of over 100 million patent "needles" from over a hundred countries! But, searching for that needle can be fun, especially when you uncover a patent that is both clever and outlandish. Some patents are inventions that appear, to say the least, weird, but at times turn out to be a solution to a problem.

I've made a hobby of featuring "bizarre" patents on my website. I often think some of these would make very entertaining patent models or good material for T-shirts.

Glen Kotapish

The Beerbrella



User Wearable Animal Decoy

One of my favorite patents is what I call "Beetle Mania", not related to The Beatles, but to the famous Volkswagen Beetle. At first glance this may look like a device to turn the VW bug into a wind turbine, but in reality, it's a complex but still humble automobile protector. It's unfortunate that the attached pin wheel is intended only as an "ornamental device", not a propeller to make this beetle fly over a traffic jam. US4154254 spins out more details about this "whirligig".

A handful of images from my bizarre patents collection, including "Beetle Mania", have also found their way onto mugs that I give to clients. To my pleasure and surprise, and to some of my clients' surprise as well, some of these bizarre inventions were from patents they had prosecuted. One such invention, sure to keep things cool, is the Beerbrella—an umbrella for a bottle of beer. I enjoyed sending this client a mug with this image on it. Unfortunately, I have not been able to find this product in the market. For this beer "necessity" see US6637447.

At times some seemingly bizarre patents, and even published patent applications, cover inventions that have been successfully made into products for sale. The User Wearable Animal Decoy is one such product. This device is currently being sold under the Be the Decoy name. User testimonials share that wearing a hat that makes them look more like an elk or goat has made them successful hunters. Now that's using your head. Hunt for more details about this invention by reviewing US20120272428.

Visit our Bazaar of Bizarre Inventions at PlanetPatent.com/laugh. Perhaps one day you, or a client of yours, may want to add a bizarre brainstorm to this collection. If you have a favorite invention or patent, please let us know, and I'll add it to our collection. Email it to Search@PlanetPatent.com.

Résumé

Glen Kotapish, Founder of Planet Patent

Glen Kotapish is the founder of PlanetPatent.com, a patent research firm. Glen's background is in aerospace and manufacturing engineering. For many years Glen was president of the Inventors Network of the Capital Area (INCA) where he still serves as a volunteer. He has also served on the board of the United Inventors Association (UIA).
Mr. Kotapish has written articles that have been published in Inventors Digest magazine. Glen currently enjoys computer aided design (CAD) and 3D printing.

Contact

Planet Patent
Tel: +1-866-846-8368/+1-866-U-invent
PlanetPatent.com
Search@PlanetPatent.com