Editor’s welcome

After another year of extensive research into the world’s leading IP firms, we are proud to bring you our latest extensive compilation with the 2023 Global IP Directory.

This up-to-date and exclusive directory lists a host of intellectual property firms from across the globe and does so in alphabetical country order to make the process of searching as streamlined as possible.

CTC Legal Media continues to create this publication to support and encourage intellectual property companies who want to actively promote their expertise with international clients and gain new business around the world. The publication is solely made up of listings, advertisements, and editorials from those firms actively seeking new business, in order to make your process of choosing a suitable law firm as efficient as possible.

Don’t forget - all the information in this hard-copy publication is also listed on our websites. To view the full comprehensive list or conduct a concise interactive search by country or company, visit www.patentlawyermagazine.com & www.trademarklawyermagazine.com. All listings on our website will have direct links to the required company’s email address, phone number, and website.

From all of us here at CTC Legal Media, we would like to thank the entrants for the information they submitted to us, our readers for their continued support, and all our clients for helping to compile this extensive intellectual property directory. We hope you find it to be an invaluable guide to the world’s IP firms, and we look forward to working closely with you all in the future.

Best wishes for 2023 and beyond.

Mission statement

CTC Legal Media’s publications educate and inform professionals working in the industry by disseminating and expanding knowledge globally. They feature 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 and www.trademarklawyermagazine.com.
Regions and Countries covered by The 2023 Global IP Directory

**The Americas**
- Argentina – p10
- Bolivia – p14
- Brazil – p18
- British Virgin Islands – p30
- Chile – p43
- Colombia – p56
- Dominican Republic – p64
- Ecuador – p66
- Guatemala – p76
- Guyana – p79
- Honduras – p83
- Jamaica – p108
- Mexico – p121
- Peru – p143
- The Bahamas – p195
- Trinidad & Tobago – p197

**Europe**
- Bosnia & Herzegovina – p16
- Bulgaria – p37
- Cyprus – p62
- Greece – p69
- Hungary – p85
- Italy – p105
- Malta – p119
- Poland – p154
- Portugal – p161
- Romania – p165
- Russia – p167
- Serbia – p171
- Slovenia – p173
- Sweden – p178
- Switzerland – p181
- Ukraine – p199
- United Kingdom – p205

**Asia**
- Afghanistan – p8
- Bangladesh – p12
- China – p45
- India – p90
- Indonesia – p101
- Japan – p110
- Malaysia – p116
- Nepal – p134
- Pakistan – p139
- Philippines – p152
- Sri Lanka – p175
- Taiwan – p183
- Vietnam – p214

**The Middle East**
- Jordan – p112
- Lebanon – p114
- Oman – p136
- Qatar – p163
- Saudi Arabia – p169
- United Arab Emirates – p202

**Africa**
- Cameroon – p40
- Morocco – p132
- Tanzania – p192
## Index of advertisers

<table>
<thead>
<tr>
<th>Company Name</th>
<th>Page Numbers</th>
</tr>
</thead>
<tbody>
<tr>
<td>Fenix Legal</td>
<td>179</td>
</tr>
<tr>
<td>Estudio Colmenares &amp; Asociados</td>
<td>144, 145, 146, 147, 148, 149</td>
</tr>
<tr>
<td>Elite Law Firm</td>
<td>217</td>
</tr>
<tr>
<td>DunnCox</td>
<td>109</td>
</tr>
<tr>
<td>Dumont</td>
<td>131</td>
</tr>
<tr>
<td>Dr Diana Protic-Tkalcic &amp; Partners</td>
<td>17</td>
</tr>
<tr>
<td>DUMONT</td>
<td>131</td>
</tr>
<tr>
<td>Dunncox</td>
<td>109</td>
</tr>
<tr>
<td>Elite Law Firm</td>
<td>217</td>
</tr>
<tr>
<td>Fenix Legal</td>
<td>179</td>
</tr>
<tr>
<td>Federis Law</td>
<td>153</td>
</tr>
<tr>
<td>Ferraiuoli LLC</td>
<td>219</td>
</tr>
<tr>
<td>Giant Group</td>
<td>191</td>
</tr>
<tr>
<td>Gintaseta</td>
<td>217</td>
</tr>
<tr>
<td>Gruenbaum, Possinhas &amp; Teixeira</td>
<td>26</td>
</tr>
<tr>
<td>Goodrich</td>
<td>129</td>
</tr>
<tr>
<td>Groth &amp; Co</td>
<td>180</td>
</tr>
<tr>
<td>HGF</td>
<td>212</td>
</tr>
<tr>
<td>Hong Fang Law</td>
<td>54</td>
</tr>
<tr>
<td>Hughes, Fields &amp; Stoby</td>
<td>80, 81</td>
</tr>
<tr>
<td>IDEAS</td>
<td>77</td>
</tr>
<tr>
<td>Indochine Counsel</td>
<td>215</td>
</tr>
<tr>
<td>Inventa</td>
<td>162</td>
</tr>
<tr>
<td>IP Cyprus - Ioannides Cleanthous &amp; co llc</td>
<td>63</td>
</tr>
<tr>
<td>J.D. Selleri + Co</td>
<td>198</td>
</tr>
<tr>
<td>Janak IP</td>
<td>135</td>
</tr>
<tr>
<td>Johansson &amp; Langlois</td>
<td>44</td>
</tr>
<tr>
<td>Julius &amp; Creasy</td>
<td>176</td>
</tr>
<tr>
<td>K. Tahtadjev (KT Patent)</td>
<td>38</td>
</tr>
<tr>
<td>Krishna &amp; Saurastri Associates LLP</td>
<td>98</td>
</tr>
<tr>
<td>L S Davar &amp; Co</td>
<td>97</td>
</tr>
<tr>
<td>Law Exchange Associates</td>
<td>194</td>
</tr>
<tr>
<td>LexOrbis</td>
<td>91, 92, 93, 94, 95</td>
</tr>
<tr>
<td>Lion &amp; Lion</td>
<td>160</td>
</tr>
<tr>
<td>Lim Chong Chuan &amp; Associates Sdn Bhd</td>
<td>117</td>
</tr>
<tr>
<td>Locke Lord</td>
<td>213</td>
</tr>
<tr>
<td>Mark Inventa</td>
<td>174</td>
</tr>
<tr>
<td>Marks n Brands</td>
<td>204</td>
</tr>
<tr>
<td>Marqonsult</td>
<td>118</td>
</tr>
<tr>
<td>Mérida &amp; Associados</td>
<td>77</td>
</tr>
<tr>
<td>Montaury Pimenta, Machado &amp; Vieira de Mello</td>
<td>29</td>
</tr>
<tr>
<td>Moskow Law</td>
<td>196</td>
</tr>
<tr>
<td>MSP</td>
<td>201</td>
</tr>
<tr>
<td>O’Connor &amp; Power</td>
<td>11</td>
</tr>
<tr>
<td>Obaidullah Asadi Legal Services Co</td>
<td>9</td>
</tr>
<tr>
<td>Old Bailey Chamber</td>
<td>13</td>
</tr>
<tr>
<td>OMC Abogados Consultores</td>
<td>150</td>
</tr>
<tr>
<td>Oniti Patents</td>
<td>182</td>
</tr>
<tr>
<td>Pacific Patent Multiglobal</td>
<td>103</td>
</tr>
<tr>
<td>Prawiragenara</td>
<td>102</td>
</tr>
<tr>
<td>Pakharenko &amp; Partners</td>
<td>200</td>
</tr>
<tr>
<td>Paulo C. Oliveira &amp; Cia</td>
<td>28</td>
</tr>
<tr>
<td>Pensworth</td>
<td>118</td>
</tr>
<tr>
<td>Pierola &amp; Associados</td>
<td>151</td>
</tr>
<tr>
<td>Ristic &amp; Malesevic</td>
<td>172</td>
</tr>
<tr>
<td>R K Dewan &amp; Co</td>
<td>100</td>
</tr>
<tr>
<td>Santamarina + Steta</td>
<td>122, 123, 124, 125, 126, 127</td>
</tr>
<tr>
<td>SBGK</td>
<td>86, 87, 88, 89</td>
</tr>
<tr>
<td>Simnoes</td>
<td>27</td>
</tr>
<tr>
<td>Sonoda &amp; Kobayashi</td>
<td>111</td>
</tr>
<tr>
<td>Sorvill</td>
<td>15</td>
</tr>
<tr>
<td>Sudath Pereira Associates</td>
<td>177</td>
</tr>
<tr>
<td>Sur Legal</td>
<td>67</td>
</tr>
<tr>
<td>Thornton Smith</td>
<td>31, 32, 33, 34, 35</td>
</tr>
<tr>
<td>Tobar ZVS</td>
<td>68</td>
</tr>
<tr>
<td>Trable Konarski Podreick &amp; Partners</td>
<td>155, 156, 157, 158, 159</td>
</tr>
<tr>
<td>Tri Viet &amp; Associates</td>
<td>216</td>
</tr>
<tr>
<td>Unitalen</td>
<td>46, 47, 48, 49, 50, 51, 52</td>
</tr>
<tr>
<td>UTPS</td>
<td>113, 115, 133, 137, 140, 141, 164, 170, 193, 203</td>
</tr>
<tr>
<td>Vellani &amp; Vellani</td>
<td>142</td>
</tr>
<tr>
<td>Valencia Law Office</td>
<td>151</td>
</tr>
<tr>
<td>Vardikos &amp; Vardikos</td>
<td>70, 71, 72, 73, 74, 75</td>
</tr>
<tr>
<td>Vaz e Dias Advogados &amp; Associados</td>
<td>19, 20, 21, 22, 23, 24, 25</td>
</tr>
<tr>
<td>Vera Abogados Asociados</td>
<td>57, 58, 59, 60, 61</td>
</tr>
<tr>
<td>W.A. Mendez &amp; Asociados</td>
<td>15</td>
</tr>
<tr>
<td>WDA</td>
<td>65</td>
</tr>
<tr>
<td>WebTMS</td>
<td>206, 207, 208, 209, 210, 211</td>
</tr>
<tr>
<td>WINCO</td>
<td>216</td>
</tr>
<tr>
<td>W.J. Trivedi</td>
<td>99</td>
</tr>
<tr>
<td>Zuykov &amp; Partners</td>
<td>168</td>
</tr>
</tbody>
</table>
Afghanistan

Obaidullah Asadi
Legal Services Co., Ltd.

A Law Firm specialized in providing a full range of Intellectual Property services in Afghanistan.

We have 14 years experience in the Intellectual Properties laws and Services.

Our practice areas are Trademark Registration in Afghanistan and the Relevant Services of Trademarks, Patent and Copyright.

We provide a full range of legal services.

Our Intention is your Success

Tel: +93748492601
Mob: +93700005661
Web: www.oac.com.af
Contact: Abdullah Sadiqi
Email: info@oac.com.af or azizigroup1@gmail.com
ARGENTINA

Sponsored by

Argentina

O'CONOR & POWER
ARGENTINA

EFFECTIVE PROTECTION OF IP RIGHTS IN ARGENTINA AND LatAm

CELEBRATING 10 YEARS OF GOING AHEAD AND BEYOND

San Martín 663, 9th Floor
(1004) Buenos Aires | Argentina

ocp@oconorpower.com.ar
www.oconorpower.com.ar
Bangladesh

Full Service Intellectual Property Law Firm in Bangladesh

Trademark
Patent
Copyright
IPR Licensing

IPR Litigation
Brand Protection
Customs Recordations
Investigation & Enforcement

email: mishbah@oldbaileybd.com
whatsapp: +8801727444888

www.oldbaileybd.com
Dr DIANA PROTIĆ-TKALČIĆ & PARTNERS d.o.o.

Address: 36 Kosevo, Sarajevo, Bosnia and Herzegovina, 71000
Telephone: +387 33 206 904  Fax: +387 33 444 140
Email: dprotic@bih.net.ba  Website: www.protic-tkalcic.ba
Contacts: Diana Protić-Tkalčić, Consultancy, protection, maintenance and enforcement of industrial property rights, domains and copyright.

Discover how The Trademark Lawyer Magazine can benefit you – claim your FREE sample copy

Statutory damages provide key enforcement mechanism to curb counterfeiters

Don’t miss out email chris@ctclegalmedia.com to request your FREE copy today!

www.trademarklawyermagazine.com
Brazil

VDAV is globally known for its excellence regarding all IP matters. Our trademark and patent services are rendered by professionals with technical knowledge and attorneys at law.

Phone: + 55 21 3176-6530 | Fax: + 55 21 3176-6528
Address: Rua da Rua da Assembléia number 10 offices 2422 - Centro, Rio de Janeiro - RJ, Brazil
CEP: 20011-000
Email: mail@vdaq.com.br | Website: www.vdaq.com.br

Sponsored by VDAV
Brazilian IP novelties for 2023: new and flexible rules for foreign licensors and investors in Brazil

Brazilian IP novelties for 2023: new and flexible rules for foreign licensors and investors in Brazil

The end of 2022 came up with relevant changes and good surprises that made the technology transfer environment more flexible and less dependent on state authorizations. On 30 December 2022, Federal Law no. 14,286/2021 came into force one year after its publication and introduced fundamental changes to the Brazilian technology transfer environment. One example of it is the revocation of the prior registration of technology transfer and licensing agreements at the Brazilian Central Bank (BACEN) for remittance purposes.

In addition, Provisional Measure 1,152 of 28 December 2022 was published by the President of Brazil, altering the applicable rules for withholding tax and implementing the price transfer mechanism in Brazil. Last but not the least, the Brazilian Patent and Trademark Office (BPTO) published on 30 December 2022, the Minutes of an Internal Meeting held on 28 December with resolutions to improve the recordation procedure for technology transfer agreements.

This article aims to address such changes as they have updated the legal framework for technology transfer and have made Brazil a much more competitive market for the exploitation of technology and business transactions on intangibles.

Remittance of royalties overseas

Firstly, Law 14,286/2021 revoked the requirement for registration of licensing and technology transfer agreements at BACEN for overseas remittance purposes and further established that the remittances in the form of royalties for technical, scientific, and administrative assistance will only depend on the evidence of payment of the income tax. Consequently, the remittance of payments and royalties established in technology transfer agreements is now permitted by means of payment through any commercial bank without any state authorization, apart from the prior recordation at the BPTO. This new procedure significantly speeds up the operationalization and timeframe for remittance and receipt of payments abroad since a registration layer at the authorities has been eliminated.

The recordation of the licensing agreement at the BPTO is still required under the foreign exchange control laws for royalty remittances and to produce effects before third parties.

Among them are changes that directly impact the deductibility of royalties and grant greater autonomy for related parties to negotiate.
as well as a condition for the payment to be considered an operational expense of the Brazilian licensee and, therefore, be calculated for tax deductibility purposes.

Under Law 14,286/2021, royalty remittances derived from patent and trademark applications are now accepted, since the BPTO recognized that a trademark application incorporates the ownership of the application into the holder’s equity and therefore it may be an adequate subject matter for licensing to third parties. The exclusion for this restriction was followed by the BPTO’s statement that it will not create obstacles for recording licensing and technology transfer agreements comprising Brazilian patent and trademark applications. This reinforces the freedom to negotiate between the contracting parties, in the sense that they can now expand and stipulate the calculation of royalties from the moment of filing the trademark.

The licensor does not have to await the conclusion of trademark and/or patent prosecution to receive royalties from the exploitation of its intangible in Brazil.

---

**No more limitations on parent-subsidiary remuneration**

Another relevant change in the technology transfer scenario has been the freedom for the contracting parties to set the limit of royalties when a foreign licensor and the local licensee are parent-subsidiary companies or hold a controlled-controlling relationship.

This freedom takes the lead due to the revocation of the sole paragraph of Article 50 of Law 8,383/1994 and Article 14 of Law 4,131/1962 which limited the payable royalties to a foreign licensor to the fiscal deductibility values set out by Law 3,470/1958 and Ministerial Ordinance 436/1958. According to the revoked rules, royalties would need to be within the limits of the fiscal deductibility, which range from 1% to 5% of the net revenue obtained from the sales of the licensed product depending upon the activity field in question for patents and a cap of 1% for trademarks. This was an unjustifiable hindrance to licensing and technology transfer, and its elimination was of great benefit to the parties, especially the licensor.
Therefore, according to the new ruling, the remuneration to a foreign licensor will no longer be limited by the fiscal deductibility limits and can be set by the rule of thumb, known as the ‘arm’s length principle’ or the prices commonly practiced in the international market. However, limitations imposed by the fiscal laws concerning fiscal deductibilities of royalties paid overseas to a licensor will be subject to the Transfer Pricing rules established by Provisional Measure 1.152 of December 28, 2022, as detailed below:

New transfer pricing rules

Regarding tax legislation, Provisional Measure no. 1.152/2022, signed by the President of Brazil unilaterally, as he can implement laws in specific cases, such as urgency and importance to the economy and society. This Provisional Measure provided amendments to the Brazilian tax legislation and implemented the transfer pricing for companies that carry out transactions with related parties abroad (such as parent-subsidiary). Such legislation has brought several consequences for the Brazilian tax system. Among them are changes that directly impact the deductibility of royalties and grant greater autonomy for related parties to negotiate.

Before the amendments brought by the new rules of the Provisional Measure, the parties had to follow very restrictive and outdated deductibility limits determined by Normative Act 436 of 1958. These were based on a classification of the degree of essentiality of the products and activities for the Brazilian industry. The new Measure established that transactions between related parties for technology transfer agreements must follow the general rule of the arm’s length principle and the analysis of economically relevant characteristics, such as the commercial terms and conditions of comparable transactions between unrelated parties.

It is important to note that payments due to entities established in a country with favored taxation or that benefit from a privileged tax regime are no longer deductible when the deduction of amounts results in double non-taxation.

This new legal framework aligns itself with regulations adopted by countries that are members of the Organization for Economic Cooperation and Development (OECD) and, thus, reduces the barriers that hinder Brazil’s entry into said organization.

Also, for “intangibles that are difficult to value”, the Provisional Measure provides for the need on a case-by-case situation for the taxpayer to adjust transfer prices “by determining annual contingent payments that reflect the uncertainties arising from the pricing or evaluation of the intangible”.

Provisional Measure is under effect as of January 1, 2023, for Brazilian companies that chose to apply the new transfer pricing rules, but it still needs to be approved by members of the Brazilian Parliament to be converted into federal law. In this matter that Provisional Measure is a mechanism used by the President of Brazil to tackle urgent matters and address relevant issues affecting society and the economy. Therefore, few companies are recognized to be using the transfer price rules, as they are expecting the ratification by the Parliament and specific regulation that will address issues to the applicability of the transfer price mechanism applicable to royalty remittances between related companies.

Know-how licensing

Historically, the BPTO did not allow the licensing of know-how, but only its effective transfer to the Brazilian licensee, which often represented a hindrance in the agreements involving this type of technology in Brazil. Know-how licensing is now accepted for recordation purposes under the BPTO’s publication of the Minutes of the Internal Meeting of 28 December 2022.

The practical impact of this alteration is that the BPTO no longer understands that the licensed know-how was transferred on a definitive basis to the licensee, in which means that clauses addressing the cease of the know-how use or the return of the technology to the licensor with the termination of the agreement are now accepted by the BPTO’s examiners.

This is indeed a comfort to a foreign know-how owners since there is a guarantee that once the agreement ends, the Brazilian licensee will no longer be allowed to use the know-how.

Further to that, it is understood that clauses stipulating confidentiality rules should be maintained for more than five years from the execution of the know-how licensing or the contractual termination. They are now fully enforceable under local laws.

Lesser formalities for the recordation of agreements

With regards specifically to the BPTO’s minutes of the Internal Meeting held on 28 December, the main changes have been to the formalities to the recording of licensing and technology transfer, as follows:

• Acceptance of digital signatures of the contracting parties without an ICP-Brasil certificate. Digital signatures are therefore accepted by other means of proving the authorship and integrity of electronic documents.

• Elimination of the notarization and Apostille requirements for the digital signature of the foreign party. Nevertheless, notarization and apostille are required when the signature is handwritten.

• Deletion of the requirements that set the need for the contracting parties and witnesses to place their initials on each page of the agreement. The BPTO may request, however, a statement from the attorney of the party requesting recordation to attest the veracity of the information.

• Suppression of the mandatory insertion of two witnesses in the agreement for recordation purposes when the contract indicated a Brazilian city as the place of signature.

• Elimination of the presentation of the bylaws of the Brazilian licensee, (also franchisee) for recordation purposes.

Final remarks

The new laws and regulations have eliminated unnecessary bureaucracies caused by legal and governmental interference set out since the 1950s. This means the contracting parties have more room to negotiate the rights and conditions for the exploitation of technologies, including those of a financial nature, and independently of the corporate relationship between the contracting parties.

This new business environment aligns itself with international practices for promoting technological innovation and economic development, making it possible to explore the full potential of the Brazilian market.
GPT is Global, Productive and Technological

Our mission is to provide services in the areas of Intellectual Property with excellence and competitiveness

CONTACT US

+ 55 (21) 2533-6720  
central@gruenbaum.com.br
+ 55 (21) 2544-9339  
https://gruenbaum.com.br
Brazil

Rio de Janeiro Office HQ
Rua Mal. Raul de Albuquerque, 02
4th, 6th, and 7th Floors - 24370-025
Niterói/RJ – Brazil Tel: 55 21 99498-8126

São Paulo Office
Av. Pres. Juscelino Kubitschek, 1455
Suite 406 - 04543-011
São Paulo/SP – Brazil Tel: 55 11 94564-8984

international@simoess-ip.com
https://www.simoess-ip.com/en
Patent & Trademark International extensive practice since 1938, also providing services in related areas including litigation.


Paulo Carlos de Oliveira was one of the founders in 1966 of ABPI Associação Brasileira da Propriedade Intelectual, Brazilian Group of AIPPI. He was its Director and was President of ABAPI Brazilian Association of Industrial Property Agents. His son Paulo Maurício Carlos de Oliveira was during 9 years Director of APAPI and is currently the principal partner of the firm.

Our team of experts are led by the partners of the firm Paulo Maurício Carlos de Oliveira, Daniel Pereira de Souza Campos and Marina Slade Oliveira.

Our practice includes handling of patents of invention and utility model, designs, trademarks and service marks, licensing, consultation services and litigation.

Our goal along decades has been providing high level services based in our long experience and expertise, at reasonable cost.
British Virgin Islands

Sponsored by

Even the most famous brands change hands. We’re here to seamlessly guide your IP changes in the Caribbean.

thorntonsmith.com
The licensing of trademarks in the British Virgin Islands

Jamal S. Smith of Thornton Smith details the types of trademark licenses and the use cases for each in the jurisdiction.

A trademark that is registered in the British Overseas Territory of the Virgin Islands (the “British Virgin Islands”) may be licensed for use by the trademark owner, or sub-licensed by a licensee (both cases herein referred to as the “licensor”). The license to use a trademark may be either in connection with the goodwill of a business or independently, or in relation to some or all of the goods or services for which it is registered or limited to a particular length of time, a particular manner of use or a particular geographical area, and in this case specifically the British Virgin Islands.

Although registration of licenses is not mandatory in the British Virgin Islands, they provide adequate notice to third parties, especially to assignees or other successors in title to the licensor who are bound by the license in the same manner as the licensor. This is mandatory for an exclusive license but any other type of license may provide for the means by which a successor in title becomes bound by the license. Therefore, it becomes important for the proper administration of the trademark rights to register licenses for their use in the British Virgin Islands, especially since unregistered licenses are vulnerable to later dealings or other persons claiming a similar right.

Whether or not the license is registered, a license is not effective unless it is in writing and signed by or on behalf of the licensor. The effect of having a license is that it could counter allegations of non-use in the British Virgin Islands. A trademark owner may register a trademark in several classes, without relying on a defensive trademark application, for the sole purpose of entering into merchandising, franchising or distributorship agreements with a person who holds a trade license in the British Virgin Islands or conducts international business through the internet where the currency used for conducting the online transaction is the United States dollars, which is the legal currency of the British Virgin Islands, and they provide for shipping any goods directly to the British Virgin Islands.

With certain exceptions, a license (whether registered or not) also attracts stamp duty of $5.00. There are no other applicable taxes, and the royalties would be treated as ordinary income or ordinary expense to the extent that they are monies actually or constructively received from the licensee or paid to the licensor.

(a) Exclusive licenses

The most consequential type of license is the exclusive license by which the trademark owner also promises that they will not grant any other licenses and that they will not exploit the trademark themselves in the British Virgin Islands. In effect, an exclusive license confers a right in the trademark to the exclusion of all other persons, including the trademark owner or any successor in title, as if the exclusive license had been an assignment with all the rights and remedies to the extent provided in the license.
Most significantly is that an exclusive licensee can sue infringers without having to persuade the trademark owner to take action on their behalf.

(b) Merchandise agreements
A trademark may be licensed to a manufacturer in the British Virgin Islands to make a product and apply the trademark to that product, for example, in personality and character merchandising. The protection of celebrity names and images as well as those of fictional characters is possible in the British Virgin Islands. Therefore, where celebrities and fictional characters are used to endorse and associate themselves with products and services, it is possible to manage their trademarks from abuse. Also, if a souvenir shop in the British Virgin Islands sold articles of clothing using the name or image of a celebrity or fictional character to a tourist the trademark owner, or the exclusive licensee, can initiate infringement proceedings once the trademark is registered since the British Virgin Islands is a major high-end tourist destination in the Caribbean and the sale may impact the international brand.

(c) Franchise agreements
There are no franchise-specific laws in the British Virgin Islands and contracts are governed by the common law, although government policy may prohibit franchises in certain fields of economic activities, such as fast-food restaurants. A franchise agreement will provide the framework for the contractual obligations between the franchisor and franchisee and would regulate advertising, training, premises, know-how, and provide support services.

(d) Distribution agreements
The most common form of a license in the British Virgin Islands would be through distribution agreements. A distribution agreement creates the channel through which a manufacturer regulates how its goods enters the British Virgin Islands market, and may also be referred to as a dealership agreement, especially in the automotive industry. All the considerations relevant to a merchandise agreement would similarly be relevant in a distribution agreement. For example, there are specific packaging requirements imposed by the BVI’s Tobacco Products Control Act, 2006 to distribute tobacco products in the British Virgin Islands market, and so it is important to understand the legal framework that regulate specific goods.

(e) Parallel imports
A licensor has the right to prevent the importation of goods bearing the registered mark into the British Virgin Islands only where the license grants rights in the British Virgin Islands. A licensor may wish to segment the market for a particular product and prevent parallel importation. For example, a licensor that manufactures and sells televisions under a particular registered trademark through a distributor in French St. Martin which uses European electrical sockets, may wish to prevent someone else from exporting the television from French St. Martin to the British Virgin Islands, opening the packaging, adding adaptors to enable the television to work in the British Virgin Islands which uses U.S. electrical sockets, and selling the repackaged television in the British Virgin Islands. The trademark owner can object to the resale of the television where the adaptor is of a different standard to that which would be sold with a television in the British Virgin Islands, at least if the repackaged television does not clearly indicate the origin of the new adaptors, and thereby undermining the ability of the trademark owner to control the quality of products placed on the market under its trademark.

Contact
Thornton Smith
Capitol Chambers, P.O. Box 3534
Road Town, Tortola VG1110,
Virgin Islands (UK)
Tel: +284 494 2518
Email: mail@thorntonsmith.com
Web: www.thorntonsmith.com
Discover how The Patent Lawyer Magazine can benefit you – claim your FREE sample copy

Don’t miss out email chris@ctclegalmedia.com to request your FREE copy today!

www.patentlawyermagazine.com

To book your firm’s position for the 2024 Global IP Directory please email katie@ctclegalmedia.com
M. Sc. Konstantin Tahtadjiev
Bulgarian & European Patent Attorney (EQE qualified)
Bulgarian & European Trademark & Design Attorney

Invent hard, IP it smart

We offer an individually tailored approach for getting the best possible protection for your business inventiveness and creativity in Bulgaria and Europe

TAHTADJIEV
INDUSTRIAL PROPERTY

J. Varbanov & Partners
European and Bulgarian Patent & Trademark Attorneys

PO Box 1152, BG-1000 Sofia, Bulgaria
South Park, bl.1A, 2nd fl., BG-1421, Sofia, Bulgaria
Tel.: (+359 2) 986 51 25, Fax: (+359 2) 980 32 47
e-mail: jvp@jvpatents.com

www.jvpatents.com
As OAPI licensed industrial property attorney, we offer a full range of legal services focused on advising, assisting, and representing our clients in obtaining, exploiting, maintaining, and defending their industrial property portfolios before the African Intellectual Property Organization (OAPI) whose jurisdiction covers all 17 member states to wit: Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Comoros Islands, Congo Brazzaville, Cote d’Ivoire, Equatorial Guinea, Gabon, Guinea Bissau, Guinea Conakry, Mali, Mauritania, Niger, Senegal, and Togo.

Our IP Practice is primarily centered on:

- Patents
- Trademarks
- Unfair Competition
- IP Searches and Due Diligence
- Agreements & Licensing
- IP WatchServices
- Trade Names
- Copyrights Infringements & more
- Enforcement of IP Rights
- Utility Models
- Industrial Designs
Akkum, Akkum & Associates LLP, is a leading and distinguished full-service law firm, and provides clients with comprehensive legal advisory services and solutions in multiple practice areas.

Established in 2002, the firm is a dynamic partnership registered under the laws of the Republic of Cameroon. Our main mission is to deliver premium service, quality, and value to our clients. We incorporate a rich blend of traditional legal practice with the spirit required to satisfy the constantly evolving dynamism of business in our result driven professional services.

Amongst others, we provide legal advisory services to clients relating to the development, processing, protecting and enforcing of their intellectual property rights before the 17 African Intellectual Property Organization, (OAPI), Member State Countries. Our major practice focuses on trademarks, patents, domain names, licensing law, trade secrets, entertainment and competition law.

The firm has developed a unique skill set specialized around prosecution, enforcement and litigation of IP rights, offering reliable legal counsel to both local and international clients.

With a rich legacy of 21 years, the firm is one of the most distinguished and recognized law firms and is ranked amongst the best in Cameroon/Africa, with many awards won in diverse categories.

Carlton is a founding member and the Senior Managing Partner of the firm with 23 years of hands-on experience as a legal practitioner. He has amassed quite a great deal of finesse in the legal practice and advised on several complex and cutting-edge transactions in the areas of Intellectual Property Rights, corporate restructurings like mergers and acquisitions, capital markets, corporate governance, due diligence and corporate finance, real estate, regulatory advisory services, labor and employment, competition and commercial litigation.

Carlton provides legal advisory services to clients within the upstream, midstream and downstream sectors relating to oil and gas and is currently advising two American multi-national Petroleum Corporations on a wide range of matters in the sector.
JOHANSSON & LANGLOIS

ATTORNEYS AT LAW / INTELLECTUAL PROPERTY
1945

Patents | Trademarks | Industrial Designs | Geographical Indications and Appellations of Origin | Copyright | Domain Names
| Infringement of Industrial and Intellectual Property Rights |
Unfair Competition and Consumer’s Rights Protection | Innovation and Technology Transfer

Experience in action

CHILE

mail@jl.cl - (562) 2231 2424
San Pío X 2460, 11th Floor, Santiago, Chile

www.jl.cl

Sponsored by
A leading IP Law Firm in China

Offices in 20 major commercial cities in China, and also in the U.S., Japan and Germany.

Handling over 500 IP litigations each year.

285 patent attorneys, 88 trademark attorneys and 82 attorneys at law.

Ranking first in the Top 10 patent agencies in Beijing with the most patent applications.
Ranking top on the list of agencies for many years in trademark applications.
Ray Zhao of Unitalen Attorneys at Law explains the changes proposed in the trademark law revision draft that defend against malicious trademarks, express the importance of trademark use, and introduce a transfer mechanism.

On January 13, 2023, the China National Intellectual Property Administration issued the revision draft of the Chinese Trademark Law. Although the Chinese Trademark Law has already experienced four changes in 1993, 2001, 2013, and 2019, the current Trademark Law cannot meet the new needs of trademark practice development. Problems such as malicious application, trademark hoarding, and registration without use, repetitive application and malicious litigation are prominent. In practice, it is difficult for enterprises to obtain trademark rights, and the number of trademark applications and registrations is large but the quality needs to be improved.

The revision draft upholds the concept of maintaining social fairness and justice, fair competition market order, and serving the high-quality development of the economy and society. Based on the actual needs of China, the revision draft draws on foreign legislative and practical experience, and positively responds to the problems and needs arising from the practice. The current Trademark Law has made significant changes from the system to the content. If the revision draft of the Trademark Law is accepted in whole or in part, it means that enterprises' compliance obligations in trademark layout, trademark application strategy, trademark use and other aspects will be substantially increased.

More prohibitions against malicious applications
Malicious trademark applications have always been one of the most concerning issues in the field of trademark practice. The revision draft makes bad-faith filers pay a higher price and a lot of new approaches will be adopted as follows: increase in the amount of fines against bad application and registration owners, and establishment of a compulsory transfer system against bad application and registration if bad faith is found.

For example, Article 67 and Article 83 of the Draft stipulate the administrative liability and civil compensation liability for malicious registration, that is, the maximum fine of RMB 250,000 and confiscation of illegal gains. Where a malicious application for trademark registration has caused losses to brand owners, brand owners may bring a lawsuit before the court and claim compensation for the losses. The amount of compensation shall at least include the reasonable expenses paid to deter the malicious application for trademark registration.

Establish new principle of prohibiting repetitive applications
Article 14 of the Draft first stipulates that “unless otherwise stipulated, the same applicant shall register only one identical trademark for the same goods or services”. In recent years, the phenomenon of repetitive application for trademark registration is increasing, to this end, the draft refers to the principle of "one thing, one right" in the property Law.

Article 21 of the Draft further clarifies the scope of the prohibition of duplication, that is, the trademark applied for registration shall not be the same as the prior trademark that the applicant applied for, has already been registered, or has been cancelled, revoked or invalidated by public notice within one year before the date of application. At the same time, this amendment also increases the cost of squatting. That is to say, in addition to the invalidation of the trademarks registered at a very low cost, they may also face the high loss of bearing the cost of protecting the rights of the squatted due to the squatting behavior.
The prohibition of repetitive applications in the draft is something that has never been done in previous trademark law. The revision draft raises the requirements for trademark use, and highlighted the importance of trademark use. The revision draft raises the requirements for trademark use, and highlighted the importance of trademark use.

Strengthen the trademark use obligation

By November 2022, China has 42,337 million valid registered trademarks, among which there are a large number of trademarks which occupy a large number of trademark resources. In practice, if the trademark application is rejected, there will usually be the same or similar trademark cited before, and the trademark not actually used in the cited trademark accounts for a very high proportion.

The revision draft raises the requirements for trademark use, and highlighted the importance of trademark use. The revision of several provisions of the Draft reflects the requirements for the use of trademarks when applying for trademarks and after the approval of registration. For example, according to the amendment of Article 5, trademark applicants may be required to provide evidence of use or commitment of use in future trademark applications.

Article 61 may have the greatest impact of all the amendments on the Chinese trademark application system and is the most important.
Article 61 establishes a system of description of the use of trademarks and random inspection of the use of trademarks by the administrative department of intellectual property.

Article 61: "A trademark registrant shall, within 12 months after the expiration of every five years from the date of approval of the trademark registration, explain to the intellectual property administrative department under The State Council the status of the use of the trademark on the approved commodities or the valid reasons for its non-use. A trademark registrant may explain the use of multiple trademarks within the above-mentioned time limit."

Where no explanation has been given at the time limit, the intellectual property administrative department under The State Council shall notify the trademark registrant. If the trademark registrant fails to do so within six months from the date of receipt of the notification, it shall be deemed to have abandoned the registered trademark, and the intellectual property administrative department under The State Council shall cancel the registered trademark.

The intellectual property administrative department under The State Council shall conduct random inspection of the authenticity of the description and may, when necessary, require the trademark registrant to supplement relevant evidence or entrust the local intellectual property administrative department to conduct verification. If it is proven to be untrue through random inspection, the intellectual property administrative department under The State Council shall cancel the registered trademark.

New compulsory trademark transfer mechanism against bad faith applications and registrations

The system of compulsory trademark transfer only applies to the following three situations: 1. where the registered trademark is a copy, imitation, or translation of another well-known trademark; 2. an agent, a representative, or an interested party registers a trademark in advance; 3. where a trademark that has been used by another person and has exerted certain influence is registered unreasonably, the prior right holder may request that the trademark be transferred to his own name. After the ruling confirming the transfer of a registered trademark has been made, the trademark registrant shall not dispose of the registered trademark.

Before the compulsory transfer of the trademark system, enterprises can only invalidate the registered trademark first, and then apply for a trademark in their own name after the trademark is invalid. However, there is a period of time between trademark application and registration, during which time there are certain restrictions on enterprise rights protection. After the implementation of the compulsory trademark transfer system, enterprises can request trademark authorities to transfer the registered trademarks directly to their own names, saving the time and cost of reapplying and protecting their rights in advance.

It should be noted that the compulsory trademark transfer system is only applicable to the above three situations. Enterprises that lawfully apply for trademarks and operate brands are not affected by the system. However, compliance enterprises can use the system of compulsory transfer of trademark to effectively prevent malicious registration, transfer the registered trademark to their own name as soon as possible, use the trademark that should belong to their own and carry out brand operation as soon as possible.
Leading IP Practice in China

PASSIONATE & PROFESSIONAL

As one of the leading China focused practice, the team was founded with professionals dedicating to intellectual property practice since the late 1990s.

We keep our commitment to clients and stakeholders as the top priority, and with our high standard service quality, we devote ourselves to the best tailor-made solution to clients.

“STAY ALERT, STAY CONFIDENT”

2104, 21/F, United Power International Plaza, No.1158 Jiangning Road, Shanghai 200090, China
T: 021-62581929 | F: 021-62581925 | E: public.relation@hongfanglaw.com
Shanghai | Guangzhou | Beijing
www.hongfanglaw.com

WE DO IP RIGHT

A Foundation to Your Success!
What does intellectual property have to do with food security?

Natalia Vera Matiz of Vera Abogados expresses the need for further review of the food security crisis as the protection available through IPR still fails to protect those in need due to inequitable circumstances.

A couple of years ago, when President Biden began his term in office in the United States, the authors¹ of a blog wrote vehemently about the need for this administration to address the food security crisis that has been accentuated by, among other factors, climate change. This author emphasized the benefits that emerging technologies can bring to mitigate this crisis, and therefore called for companies and leading nations in this field to invest in this specific area, which would bring them the advantage of obtaining the benefits derived from Intellectual Property.

It is here where we must stop to analyze the implications of the protection of intellectual property rights associated with food security, as this brings us to the specific field of agriculture where, for example, through the application of biotechnology, plants, and crops are improved to resist climate change, thus having as a consequence a means to mitigate this crisis. Thus, Intellectual Property has two forms of protection, patents, and plant variety protection, which, although at first glance seems to be an appropriate, equitable, and fair way of rewarding those who invest in innovation that has an impact on a vital field such as food security, it does not always bring favorable consequences for all the actors involved.

The flexibilities brought by the international treaties that address the subject, either superficially or in-depth, are not enough.

Firstly, in developing countries where farmers, or at least some of them, are used to the exchange of seeds and knowledge without barriers, this could have a significant impact, since they will have to pay the prices set by breeders and owners, who in most cases are from developed countries.

Secondly, research and development progress for the improvement of proprietary crops will be affected by intellectual property rights, because it will be difficult to find an exception that allows such research.

Thirdly, the application of this technology in developing nations may not be correct, due to a lack of training.

However, the flexibilities brought by the international treaties that address the subject, either superficially or in-depth, are not enough, since, for example, the TRIPS have been affected by the free trade agreements where the technology leader imposes its own conditions, or those international instruments that allow the use of plant varieties that are already in the public domain does not make much sense.

Thus, in order to face the food crisis, I consider it necessary to take into account the inequalities that exist between nations, because although it is true that remuneration through intellectual property rights becomes not only a reward but a necessary stimulus to advance technologically in any field, it is necessary to take into account all the actors that are part of this balance to be able to conclude that the food crisis is truly and effectively being faced.

Contact
VERA ABOGADOS ASOCIADOS S.A.
Bogotá, Colombia
Calle 70 A No. 11-43.
Tel: (+57) 60-1 3176650 - (+57) 60-1 3127928.

Quito, Ecuador
Av. 6 de dic. y la niña, Ed. Multicentro Of.603
Tel: (+59-3) 2 255 5208.

Email: info@veraabogados.com
Web: www.veraabogados.com
A law firm specialising in intellectual property law, which provides smart and pragmatic advise for Cyprus and EU matters.
Dominican Republic
SUR LEGAL ESTUDIO JURÍDICO is a team of lawyers that has stood out for its professionalism and honesty for 38 years; its members share a vision: Excellence!

SERVICES:
INDUSTRIAL AND INTELLECTUAL PROPERTY / LITIGATION
ENFORCEMENT / COPYRIGHTS

Whatsapp Contact:
+593 · 997 · 837 · 111

e-mail: amartinezm@surlegal.com

www.surlegal.com
TOBAR ZVS®

Our team is a pioneer in IP services with almost three decades of experience in Ecuador. We are well known for our comprehensive service that centralizes IP advice for our clients throughout the Andean and Latin American region, which makes clients work with us to solve all their IP concerns.

Tobar ZVS’s IP department has extensive experience in the protection of patents, trademarks, designs, copyrights, plant varieties and related rights. The Leaders League legal directory only ranks Tobar ZVS as a leading firm for our work in plant varieties and recognizes partners Alvaro Sevilla and Oscar Vela in this area.

Chambers & Partners Latin America and Global editions note: “Alfonso Rivera is a very responsive lawyer and provides his clients with very well-informed, business-oriented advice.”

As of 2022 Partner Alvaro Sevilla leads the Intellectual Property Department.

- Legal 500 - IP
  - Tier 2
- Leaders League – Plant Varieties
  - Leading – Oscar Vela, Alvaro Sevilla
- Chambers and Partners – IP
  - Alfonso Rivera – Band 3
- IP Stars
  - Oscar Vela – Trademark Star
- Leaders League – IP Litigation
  - Excellent – Alfonso Rivera

Av. 12 de Octubre N26-97 y Lincoln. Edificio Torre 1492, Oficina 1505.
Quito, Ecuador.
Tel: (593) 2 29 86 456 · Email: arivera@tzvs.ec
Website: www.tzvs.ec
innovation starts with us!

Intellectual Property, Patents & Trademarks Legal Services in Greece & Cyprus

VARDIKOS & VARDIKOS
ATTORNEYS & COUNSELORS AT LAW, TAX CONSULTANTS ESTABLISHED 1929

Our Law firm provides in Greece and Cyprus a full range of legal and professional intellectual property services, with special emphasis on:

- Advertising Law
- IP Management & Strategy
- Cancellation And Opposition Actions
- IP Related Litigation
- Data Protection
- Injunctions And Asset Freezing
- Patent And Trademark
- Filing And Prosecution
- Copyright
- Industrial Designs And Models
- Internet Contracts
- Licensing, Franchising
- Technology Transfer
- In Joint Ventures

4 Koumbari Street, Kolonaki Square, Athens, 10674 Greece
+30 210 3627888-9 | +30 210 3611505
general@vardikos.com | www.vardikos.com
Trademarks in Greece


1. Types of Trademarks
Any sign, even one with no graphical representation, can be considered registrable as a trademark. It can be words, names, illustrations, designs, letters, numbers, colors, position, sound, shape, pattern, motion, multimedia and hologram, on the premises that:

i. it distinguishes the goods of one undertaking from those of other undertakings;

ii. it is represented in the registry in a manner enabling the public to determine precisely the protection afforded to its proprietor.

The law provides also for guarantee and certification trademarks. They can’t be registered as trademarks signs that:

i. cannot constitute a trademark;

ii. are devoid of distinctive character;

iii. consist exclusively of signs or indications which have become customary in the everyday language or in the established practices of the trade;

iv. consist exclusively of signs or indications which have become customary in the everyday language or in the established practices of the trade;

v. consist exclusively of the shape imposed by the nature of the product or it is necessary to obtain a technical result or gives substantial value to the product;

vi. are contrary to public order or to principles of morality;

vii. are deceiving;

viii. are contrary to applicable legislation.

2. Scope of protection
The registration of a trademark confers on its proprietor the exclusive right to use it, to affix it to the goods or services intended to distinguish, to use it for characterization of the provided services, to affix it to covers and packaging of goods and to any other printed material and to use it in electronic or audiovisual media.

The proprietor is entitled to prohibit any third party from using:

i. A sign identical to the registered trademark for goods or services identical to those for which the trademark has been registered;

ii. A sign identical with or similar to the registered trademark, when due to the simultaneous identity or similarity of the goods or services there is a likelihood of confusion, including the likelihood of association.

iii. A sign which is identical or similar to a trademark with a reputation, where use of that sign without due cause would take unfair advantage of, or would be detrimental to the distinctive character or its reputation, regardless whether the sign is intended to distinguish goods or services that are similar to products or services of the earlier trademark.

The Law introduces a special provision that empowers the proprietor to prevent third parties from bringing goods in the course of trade into Greece.

The proprietor can request that the reproduction of the trademark in a dictionary, encyclopedia or similar reference work is accompanied by an indication that it is a registered trademark.

The right to a trademark can be transferred, in life or after death, for all or part of the goods or services for which an application for a trademark has been filed or registered, regardless of the transfer of the undertaking.

The proprietor can grant a license, exclusive or not, for the use of a national or international trademark or trademark declaration valid in Greece, for part or all of the products or services and for all or part of the Greek Territory. The trademark license agreement must be in writing.

The protection of the trademark is dependent on its use: if the proprietor fails to continuously use the trademark within five years from the date of its initial registration ("grace period").
they may be faced with an application for cancellation or proof of use of their mark filed by a new applicant. The proof of use by the proprietor must include all the goods and services for which it is registered, otherwise the protection of the trademark will be limited to those which actually make use of the trademark.

3. Registration
The trademark application is filed before the competent Greek Trademarks Authority. By virtue of the Joint Ministerial Decision No 48793/2022, the competent Authority from May 2022 is the Greek Patent Office.

The examiner reviews the application on procedural and substantive grounds. The ex officio examination of relative grounds for refusal is abolished; the publication of the approval decision to the designated website serves as notification for third parties which could have an interest to oppose the application.

The examiner’s decision accepting the registration of a trademark’s application can be opposed within a three-month deadline commencing from the day after its publication on the designated website.

The proprietor of the trademark may divide the trademark application or registration, stating that part of the products or services contained in the original declaration or registration will be the subject of one or more partial declarations or registrations.

4. Enforcement

Administrative Courts
The Administrative Courts are competent to adjudicate appeals against the Trademark Committee’s decisions that rule on the decisions of the examiners regarding objections or applications for dispute resolution.

Appeals are required to be filed within sixty days from the day of the publication of the decision.

Civil Courts
The Civil Courts are competent to adjudicate the following:

i. Disputes regarding the trademark infringement;
ii. Oppositions of article 583 of Civil Procedure Code against the Trademark Committee’s decisions on the application of trademark’s revocation or invalidity;
iii. Claims and counterclaims of restraining orders on trademark’s revocation or invalidity;
iv. Claims related to trademark assignments;
v. Actions on the right to information.

The new law abolishes the provision according to which civil courts were bound by the final decisions of the Trademarks Committee and the Administrative Courts i.e., they have the jurisdiction to adjudicate on the validity of the registered national and European Union trademarks, provided that the proprietor of the trademark is entitled to counterclaim for the declaration of invalidity of the trademark or revocation.

The claim for revocation or invalidity can only be brought as a counterclaim and the defendant has to notify the Trademarks Registry by the latest by the date of the court hearing, otherwise the action is inadmissible. Additionally, once the infringement action has been filed by the claimant, the defendant can no longer challenge the validity of the trademark by filing a separate action before the Trademarks Registry. If the action has been filed before the filing of the civil claim, the court has the discretion to suspend the proceedings brought before it, ordering provisional measures. The defendant has the same right in interim injunction proceedings.

The objection of the proof of use has to be raised at the hearing of the opposition otherwise it will be inadmissible. The claimant is granted at least 30 calendar days to submit material proving the use of the earlier mark along with a supporting writ. The defendant is granted at least 25 calendar days, starting on the day after the aforementioned deadline expired, to evaluate the proof material and submit a writ. Within three calendar days following the expiration of the second deadline, both parties submit their rebuttals. The Administrative Trademark Committee can rely on facts that are so well known, that no doubt remains that they are true.

The burden of proof in revocation proceedings is put on the proprietor of the contested trademark.

The proprietor can request to have the full court decision or parts thereof published on social media.

Interim measures are filed by the individual who has the trademark registered in their name.

Penal Proceedings
The Greek Law provides for criminal offenses, such as imprisonment and fine, in case of trademarks infringement for those who:

i. use a trademark without having such right;
ii. launch, possess, import or export products or offers services using another’s trademark;
iii. intentionally use a reputation mark to exploit or damage its reputation;
iv. intentionally use symbols and signs of public interest.

Mediation
In light of the Mediation Law 4640/2019, the trademark disputes can be submitted to mediation.

About Vardikos & Vardikos
Vardikos & Vardikos is a fully-fledged Athens headquartered law firm, with offices in Cyprus, the Caribbean Islands of Dominica, and St Lucia, providing inter alia Intellectual Property services, ship/yacht registration and is a Government-approved service provider for the respective Citizenship by Investment programs of both islands.
To book your firm’s position for the 2024 Global IP Directory please email katie@ctclegalmedia.com
Guyana

To subscribe please email: chris@ctclegalmedia.com

http://www.lslawmag.com/
Hughes, Fields & Stoby
Attorneys at Law

ABOUT HUGHES, FIELDS & STOBY
Established in 1972, Hughes, Fields & Stoby is a leading provider of superior, professional intellectual property services to corporate and individual clients, both local and international. It is one of the core areas on which the reputation of our chambers has been built.

Whilst we are registered trade mark and patent agents with decades of experience in filing applications for trade marks, patents and designs, we also provide legal advice and intellectual property enforcement services at standards which are second to none.

VISION
Our vision embraces the motto “We strive to provide our clients, local or international, corporate, or individual with the highest quality services available. We focus on the unique needs of each client, which is the driving force behind our long-term success.”

MEMBERSHIP
In June, 2019, Hughes, Fields and Stoby distinguished itself as Guyana’s leading chambers when the firm was admitted as the sole member of the global network of Law Firms, Lex Mundi.

The firm is a member of the International Trademark Association (INTA) and a founding member of the Intellectual Property Caribbean Association (IPCA).

SCOPE OF SERVICES
Our firm offers several services as set out below:

- LEGAL CONSULTATION AND ADVICE.
- APPLICATIONS FOR TRADE MARKS.
- APPLICATIONS FOR PATENTS.
- APPLICATIONS FOR DESIGNS.
- APPLICATIONS FOR GEOGRAPHICAL INDICATIONS.
- APPLICATIONS FOR DOMAIN NAME REGISTRATION.
- APPLICATIONS FOR HEALTH/SANITARY REGISTRATIONS.
- INFRINGEMENT INVESTIGATIONS AND PROSECUTION.
- LITIGATION.

CONTACT US
Feel free to contact us:
Hughes, Fields & Stoby
62 Hadfield & Cross Streets, Werk-en-Rust,
Georgetown, Guyana, South America.

Tel. office (592) 227-7956 or (592) 227-4857 ext 1014
Email: hfsip@guyanalaw.net; n.hughes@guyanalaw.net; hfslaw@guyanalaw.net
Website: www.guyanalaw.net
Cameron & Shepherd
Attorneys-at-Law

Patent and Trade Mark Agents

2 Avenue of the Republic, P.O. Box 10109, Georgetown, GUYANA, South America
Tel: +592 226 2671  Fax: +592 226 7809
Email: csmain@cameronandshepherd.com  |  Web: cameronandshepherd.com

Partners: Hari N. Ramkarran SC, Josephine Whitehead SC, Rafiq T. Khan SC,
Nikhil N. Ramkarran & Kamal Ramkarran
Associate Counsel: Rebecca Aly Khan, LLB (Dist.)
Consultant: Joseph Arthur King, SC

Subscribe now!
To subscribe please email: chris@ctclegalmedia.com

www.patentlawyermagazine.com
HONDURAS

Bufete Mejía & Asociados

Your key to Central America

TRADEMARKS
PATENTS
COPYRIGHT
LITIGATION
REGULATORY AFFAIRS
DOMAIN NAME

(504) 2550-7744
1 (914) 412-5719

1 y 2 Calle S.O., 20 Ave. “A”, Col. Rio de Piedras
P.O. Box 1744, San Pedro Sula, Honduras, C.A.
www.bufetemejia.com

bma@bufetemejia.com

Hungary

Sponsored by
With more than 50 years of professional experience, SBGK Attorneys at Law and Patent Attorneys provide outstanding services in all commercial law areas, especially in intellectual property law, to both domestic and international clients from more than 20 sectors. Our lawyers and patent attorneys have decades of experience in all fields of defending and enforcing intellectual property rights. SBGK’s clients can rely on the expertise of our attorneys and patent attorneys in the area of legal proceedings required for securing intellectual property rights and utilizing the acquired rights. SBGK’s team of paralegals perform routine jobs associated with our clients’ intellectual property rights quickly and with precision subject to oversight by attorneys and patent attorneys. This includes intellectual property rights portfolio management, patent annuities payment, preparing trademark searches and patent freedom to operate searches, as well as the completion of trademark, domain and customs monitoring related work. SBGK’s IP department is a well-known, reliable partner and an innovative, constantly available and up to date legal service provider.

SBGK’s attorneys at law are qualified to represent clients before the EU Intellectual Property Office (EUIPO), the EU General Court and the Court of Justice of the European Union. Similarly, SBGK’s patent attorneys are all registered as European patent attorneys and can represent clients before the European Patent Office and the EUIPO.

For example, SBGK has represented UNILEVER NV before the Court of Justice of the European Union (CJEU) in the first preliminary ruling referral to the CJEU from a Hungarian court in a trademark matter. Similarly, our firm also represents Rubik’s Ltd., one of the most well-known brands in the toy industry, before the General Court and the European Court of Justice in a landmark trademark case which received high media and press publicity. Furthermore, SBGK provided legal advice in a case which was referred to the CJEU in relation to the interpretation of Article 9 (7) of the Enforcement Directive. The interpretation of the article has an important effect on patent litigation and in particular on compensation claims resulting from unjustified preliminary injunctions.

In addition to SBGK’s strong IP practice, it helps foreign investors set up their business in Europe and provides them with all the necessary legal services in company establishment, mergers and acquisitions, competition law, employment law matters and various other commercial transactions.

Network
SBGK, as the leading IP law firm in Hungary, offers not only professional services, but also a broad network of international contacts, which includes well-known national and international firms of attorneys at law and patent attorneys, guaranteeing high-quality services. SBGK’s attorneys at law and patent attorneys are members of and hold various positions in international IP organizations such as the International Association for the Protection of Intellectual Property, the International Trademark Association, the International Federation of Intellectual Property Attorneys, the European Communities Trademark Association, MARQUES, UNION, the Pharmaceutical Trademarks Group, the Licensing Executives Society International and the Institute of Professional Representatives before the EPO.

Gateway to Europe
SBGK is looking to broaden its professional network and form partnerships with foreign patent and trademark attorneys, to represent clients from Europe and further afield in international IP matters. SBGK can provide a one-stop shop for European patent, Patent Cooperation Treaty, EU trademark and registered Community design applications.

Contact
SBGK
Tel: +36 1 461 10 00
Fax: +36 1 461 10 99
mailbox@sbgk.hu
sbgk.hu
Dr. Katalin Szamosi
Managing partner
szamosi@sbgk.hu
Practice areas: advising and contract drafting in technology transfer matters, strong focus on contentious patent, trademark, industrial design and copyright-related matters, representation before the Court of Justice of the European Union, arbitration in domain disputes, mediation and advising on consumer protection and antitrust matters.

Dr. Péter Lukácsi
Partner, Attorney at Law
lukacsi@sbgk.hu
Practice areas: advising, prosecution and litigation in various fields of IP law, strong focus on trademarks, copyrights and designs, and advising and litigation in the field of competition and antitrust law, negotiating and drafting distribution, franchising, licencing agreements.

Dr. Ádám György
Partner, Attorney at Law
adam.gyorgy@sbgk.hu
Practice areas: providing full scope of IP legal advice, with special focus on designs and trademarks, as well as providing legal representation before HIPO, EUIPO and litigation in the field of IP, also providing mentoring activity for the Hungarian Fashion and Design Agency and for national start-ups.

Zsolt Szentpéteri
Co-managing partner
szentpeteri_zs@sbgk.hu
Practice areas: advising in patent prosecution, validation and litigation, special focus on inorganic and organic chemistry, polymer chemistry, food chemistry, pharmaceutical chemistry and biotechnology.

Katalin Mészárosné Dónusz
Deputy managing partner
donusz@sbgk.hu
Practice areas: preparing national, European and PCT patent applications covering the automotive, construction and toy industries, as well as representation in trademark and industrial design prosecution matters before the Hungarian Intellectual Property Office and the EU Intellectual Property Office.

Szabolcs Farkas
Partner, Patent counsel
farkas@sbgk.hu
Practice areas: innovation and IP counselling, with a special focus on chemical and biotech IP solutions and R&D projects, preparing national, European and PCT patent applications covering biotech, chemical and biomedical device solutions, representation in plant variety protection and utility model prosecution matters before the Hungarian Intellectual Property Office.
YOUR MOST TRUSTED IP PARTNER

- MIP IP Star, 2021 – Manisha Singh listed as Patent Star
- IAM Patent 1000, 2021 – LexOrbis listed as Recommended Firm; Manisha Singh ranked for Prosecution; Abhishek Pandey ranked for Litigation
- BusinessLaw – Most Trusted Law Firm to Watch in 2021
- WIPR 2021 Leaders Award – Manisha Singh featured
- 2021 Asia IP Trademark Survey – Tier 1 for Trademark Prosecution
- 2020 India Business Law Journal – A List: Manisha Singh has been recognized and listed in the category of “India’s Top lawyer”
- 2020 Asia IP – Recognized as “India’s patent firm of the year”
- WTR 1000 – The World’s Leading Trademark Professionals 2021 guide – LexOrbis is recognized for the category “enforcement and litigation & prosecution strategy”.
- Asia IP – Manisha Singh & Abhishek Pandey has been recognized as “Top 100 IP Experts in India”
- 2020 the winner of Asia IP Magazine’s inaugural India IP Awards for “IP Prosecution Firms of the Year”.
- 2020 Asian Legal Business – Manisha Singh has been recognized among “Top Disputes Lawyers”.
- 2020 Leaders League – LexOrbis has been ranked as “highly recommended” in category “Best Law Firms for Patent Prosecution & Litigation” and “Best Firms for Trademark Prosecution & Litigation”
- 2020 AsiaLaw Profiles and Leading Lawyers 2021 edition has recognized LexOrbis as the most recommended firm in India for the Intellectual property.
- 2020 IAM Strategy 300 – Manisha Singh has been recognized as leading IP strategist.
- 2020 - IAM 1000 – LexOrbis is recognized as “Recommended Firm”
- 2020 The Asia-Pacific Trademark Law Firm Rankings (India) – LexOrbis is recognized most well-respected law by The Trademark Lawyer Magazine.

NEW DELHI • MUMBAI • BENGALURU
www.lexorbis.com / mail@lexorbis.com / T: +91 11 2371 6565
Exclusivity over “Sub” in Subway v Suberb: timeline

Manisha Singh and Anvita Sharma of LexOrbis review a recent case that called into question deceptive similarity in a dispute over name and logo between two rival brands.

Abstract:
One of the world’s largest restaurant brands serving customizable and signature sandwiches, wraps and salads – “Subway”, recently filed an infringement suit against Delhi-based fast-food shop “Suberb”. The suit alleged that the Defendant’s brand name and logo “Suberb”, which is represented in the color scheme of green and yellow, just as the Plaintiff “Subway”. The Defendant also used the marks “Veggie Delicious” and “Sub on a club” which were deceptively similar to Plaintiff’s registered marks “Veggie Delite” and “Subway Club”. The signage, décor, menu cards, napkins, staff uniforms, photographs and wall art in the outlets were also identical to that of the Plaintiff, and the food preparation procedures, recipes, formulae, and placement of the service counters were also alleged to be identical. Additionally, it was alleged that many of the names of Suberb’s sandwiches, signage, décor, menu cards, napkins, staff uniforms, photographs and wall art in the outlets were identical to that of the Plaintiff. While the Defendant has made the effort to change the color combination, names of its sandwiches, and modify their outlets, the Plaintiff filed for an interim injunction again.

The single bench of the Delhi High Court rejected Subway’s prayer for seeking an interim injunction for its mark “Subway” by way of an order passed on January 12, 2023.

On February 15 2023, the division bench of the Delhi High Court set aside the order passed by the Single bench, citing that the impugned order has not given due weightage to the aspect of ‘bad faith’, considering that some of the respondents were operating as a Franchisee of the Plaintiff and had not given due weightage to the aspect of ‘bad faith’, considering that some of the respondents were operating as a Franchisee of the Plaintiff. They also submitted that the efforts made by the Defendant to make such modifications to differentiate themselves from the Plaintiff were blatant. It was further stated that “Subway” and “Suberb” are deceptively similar to each other as word marks even if the color scheme of both the marks is changed. The Plaintiff stated that the Defendant to make such modifications to differentiate themselves from the Plaintiff were blatant. It was further stated that “Subway” and “Suberb” are deceptively similar to each other as word marks even if the color scheme of both the marks is changed. The Plaintiff stated that the defendant was a franchisee holder of the Plaintiff.

On the other hand, the Defendant denied the allegations of infringement and passing off, and submitted that they had incorporated the changes in both of their outlets in Delhi and Gurgaon - which included changes in wall décor, menu card and staff uniforms. They had also made changes in the colour scheme, with the logo no longer resembling the logo of the Plaintiff. They also submitted that the Plaintiff cannot claim exclusivity of the “Sub” part of the “Subway” mark, as “Sub” was generic in respect of the products to which it is used.

“ It was further stated that “Subway” and “Suberb” are deceptively similar to each other as word marks even if the color scheme of both the marks is changed.

Arguments submitted
The Plaintiff claimed that they already hold registrations for the word mark and logos under “Subway” in Classes 29, 30, 32, 35, 42 and 43. They also submitted that the efforts made by the Defendant to make such modifications to differentiate themselves from the Plaintiff were blatant. It was further stated that “Subway” and “Suberb” are deceptively similar to each other as word marks even if the color scheme of both the marks is changed. The Plaintiff stated that the Defendant to make such modifications to differentiate themselves from the Plaintiff were blatant. It was further stated that “Subway” and “Suberb” are deceptively similar to each other as word marks even if the color scheme of both the marks is changed. The Plaintiff stated that the Defend

Court’s analysis and decision on January 12 and February 15, 2023
In an order dated January 12, 2023, the Single Bench of the Delhi High Court rejected Subway IP
LLC’s application seeking for injunction for its mark “Subway” against Infinity Food’s mark “Suberb”.

The Single Bench held firstly that the Defendant’s mark “Suberb” was not phonetically similar to the Plaintiff’s mark “Subway”. Secondly, the court stated that the common syllable “Sub” is known to represent Submarine Sandwiches which has an identity of its own and could not be monopolized by the plaintiff, particularly when used for sandwiches. It was stated that the word “Sub” is publici juris, common knowledge under Sections 56 and 57 of the Indian Evidence Act, 1872 and common to trade.

It was also ruled that the terms “Veg” and “Club” were also publici juris, which, when used in the context of club sandwiches, were commonly used.

Since the logo of the Plaintiff held no Indian or WIPO Registration, no infringement could be alleged in that regard. Otherwise as well, the court observed that both the logos of the parties stood dissimilar. The one point of similarity between the logos, the green-yellow color scheme, as pointed out by the Plaintiff before, has been removed post modifications.

It was also analyzed the “Anti-dissection rule” and the “Rule of dominant feature” to examine whether any part of the Plaintiff’s registered trademarks constitutes a “dominant part” which stands infringed by the defendant or has acquired any secondary meaning by a long usage.

With respect to the rule of passing off, the Court stated that there is no likelihood that a person of average intelligence who desires to visit the Plaintiff’s restaurants would walk into the outlet of Defendant. Accordingly, the court refused to grant an interim injunction in favor of Plaintiff.

Lastly, it was also rejected the arguments of similarity based on the layout, décor or appearance of both restaurants. The Plaintiff had cited decisions of the High Court of Canada which were not taken into consideration, citing that the Indian Law does not allow a claim of exclusivity as of yet. Nonetheless, the Defendants have modified their outlets so as to differentiate themselves from the Plaintiff in this regard.

The said conclusion and order of the Single Bench was set aside by the Division Bench of the Delhi High Court on February 15, 2023, after the respondent submitted that the website SUBERB/www.suberb.in by the name SUBERB has been pulled down and deleted, has changed the name to HUBERB on the social media website Instagram and written letters to food delivery applications Swiggy and Zomato to change their name to HUBERB in their display. The Respondent also assured that they also aim to change the name to HUBERB, shall change the logo to ‘H’ and shall use the color combination of red and white on the logo ‘H’ on display everywhere.

The principle of ‘bad faith’ was also considered, which was earlier not analyzed by the Single Bench. Considering that some of the respondents were operating as a Franchisee of the Plaintiff when they started the new restaurant under the mark SUBERB and copied many aspects of the Plaintiff including Trade/Service marks, artworks, literary works, menu cards, website content, trade dress/color scheme/getup/interior/layout of the Plaintiff under the trademark SUBWAY, the court decided to set aside the impugned order.

Conclusion

The Single Bench had passed the order based on principles of ‘anti-dissection’ with reference to the ‘dominant feature’ rule, descriptiveness of ‘Sub’, ‘Veg’ and ‘Club’ and considered these being publici juris. The court however, did not take into account the earlier connection between the parties where the Respondent was a Franchisee of the plaintiff, an argument which was also raised by the Plaintiff earlier.

The division bench then took into consideration the earlier arrangement of the parties and calculated it to be of bad faith.

Subway IP LLC vs. Infinity Food & ors., CS (COMM) 843/2022 Order.

Subway IP LLC vs. Infinity Food & ors., CS (COMM) 26/2023 Order.

2 http://164.100.60.183/writereaddata/OrderSAN_PDF/chs/2019/349459660064582023.pdf

3 http://164.100.60.183/dhcqrydisp_o.asp?ch=280610263/28203yysdyp_o.asp

Contact
LexOrbis
709/ 710, Tolstoy House, 15-17, Tolstoy Marg, New Delhi - 110001
Tel: +91 11 2171 6565
Email: mail@lexorbis.com
Web: www.lexorbis.com
ANAND AND ANAND

PRACTICE AREAS

Patents | Litigation and Dispute Resolution | Trademarks | Designs
Art and Antiquities | Competition | Antitrust | Compliance | Regulatory
Plant Variety | Biodiversity | Contractual and Commercial IP | Copyrights
IT law and Domain name disputes | Sports law | Fashion and Luxury law
Media and Entertainment law | Licensing and Franchising | Advertising law
Anti-Counterfeiting | Criminal law | Customs and Border Enforcement

Patents
- Patent Search and Analytics.
- Patent Drafting and Filing Services.
- Preparing Drawings and Illustrations.
- Patent Prosecution Services.
- Opposition/Third Party Observations.
- Patent Monitoring and Mining.
- Annuity Services.

Designs
- Prior Art Design Search along with detailed Legal Opinion.
- Filing and Prosecution of Design Applications.
- Design Portfolio Management including Complementary Journal Watch Services.
- Cancellation and Rectification Proceedings.
- Design Renewals.

Trademarks
- Trademark Searches, Filing, Registration and Renewal.
- Trademark Opposition Proceedings.
- Trademark Litigation: Infringement and Passing Off.
- Border Enforcement.
- Foreign Filing throughout the World.
- Trademark Portfolio Management.
- International Registration.

IP and Allied Services
- Copyrights.
- Geographical Indications.
- Unfair Competition and Trade Secrets, Piracy, Anti-Counterfeiting and Border Control Measures.
- Internet and Social Media Watch Services.
- Domain Disputes.
- Drafting and Vetting of Agreements.
- IP Licensing, Audit, Valuation and Due Diligence.
- Technology Transfer Support.
- Alternative Dispute Resolution.
- Commercial Litigation.
- IP Counselling and Risk Management.
- Portfolio Management.
- Data Privacy and Protection.
Krishna & Saurastri Associates LLP is a full-service Intellectual Property and Technology law firm, focused on rendering business-friendly legal advice. The firm was formed in 1992 and merged with a law practice set up in 1956. Ever since, the firm has been navigating complex intellectual property and techno-legal issues for its diverse client base. To keep pace with the growth of its business and be ever-present for its clients, the firm has 170 people spread across offices in the major economic centers of Mumbai, New Delhi, Bengaluru, Pune, Ahmedabad and Chennai.

The firm represents clients from all major industries and sectors. The firm’s team includes specialists with niche expertise and industry experience, which is leveraged to provide clients - maximum value from legal counseling. Additionally, most of the firm’s professionals have formative degrees in natural sciences, engineering, arts or business, prior to qualifying as lawyers, which is useful while navigating complex intellectual property and techno-legal issues.

Over the years, the firm has been ranked among the top-tier Indian intellectual property and technology law firms consistently by leading domestic and international publications.

**AREAS OF PRACTICE**

- Patents
- Trademarks and Geographical Indications
- Designs
- Copyrights
- Mergers and Acquisitions, Technology Transfers, Licensing, Franchising, Joint Ventures
- Litigation and Arbitration
- Plant Varieties
- Biodiversity
- Competition Laws
- International Trade Laws
- Regulatory Issues
- Food, Drug and Medical Device Laws
- Media, Advertising, Broadcasting and Entertainment Laws
- Trade Secrets, Data Protection and Information Technology Laws
- Anti-Counterfeiting
- Customs and Border Enforcement

Y. J. Trivedi & Co.
Patent & Trademark Attorneys & Advocates

Head Office: City Square, 2nd Floor, Opp. Kashiram Hall, Polytechnic, Ahmedabad 380015, Gujarat (India)
Phone: +91 79-2630 3777, 2630 5040 | Email: info@yjtrivedi.com
Other Offices: US / Mumbai / Jaipur / Delhi

www.yjtrivedi.com
CHANDRAKANT M. JOSHI
LEADING INDIAN IPR LAW FIRM
(Established in 1968)

SOLITAIRE-II, 7th FLOOR,
OPP. INFINITY MALL, LINK ROAD,
MALAD (WEST), MUMBAI-400 064, INDIA

Tel.: +91-22-28886858, 28886856, 28886857
Fax: +91-22-28886859, 28886865
Email: patents@cmjoshi.com
cmjoshi@cmjoshi.com
Web.: www.cmjoshi.com

Other Offices:
New Delhi, Kolkata, Ahmedabad, & Chennai

Member:
IPR Professional Associations:
U.S.A., U.K., Germany, Japan,
France, Italy et.al.

Languages:
English, French, German and Italian.

Areas of Practice:
- Patent and Trade Mark Search, Patent and Trade Mark Watch
- Registration, post registration and Infringement etc. for Patent, Trade Marks, Design and Copyright
- Translation of Patent Specification
- Franchise and Joint Venture Agreements, Cyberlaw, Mergers and Acquisition

Contact Person:
Mr. HIRAL CHANDRAKANT JOSHI

For over 75 years, our professionals have been delivering insightful advice and services to assist our clients in upholding and protecting their Intellectual Property Rights throughout India and globally.

An ISO 9001:2015 certified firm
Mumbai | New Delhi | Pune | Chennai | Kolkata | Indore | Bengaluru
dewan@rkdewan.com www.rkdewan.com
PACIFIC PATENT MULTIGLOBAL

Address: DIPO Business Center 11th Floor, Jl. Jend. Gatot Subroto Kav. 51-52, Jakarta 10260, Indonesia
Telephone: +62 21 2986 5888 (Hunting)  Fax: +62 21 2986 5858
Email: pacific@pacificpatent.com
Website: www.pacificpatent.com
Contact: Lanny Setiawan

To book your firm’s position for the 2024 Global IP Directory
please email katie@ctclegalmedia.com

YOUR TRUSTED PARTNER FOR
IP PROTECTION IN INDONESIA
For more than five decades, GLP has been offering a complete range of services for the structured protection of intellectual property.

Our Clients range from artisans to some of the Top Companies on the Forbes 500 list, for whom we provide initial consultancy and support in lawsuits – both as plaintiff and defendant – throughout the world.

The quality of our services, commitment of our team and ability to achieve our Clients' highest objectives, led GLP to be a world-class leader in the IP business.
Japan

YOUR TRUSTED IP PARTNER IN JAPAN SINCE 1891

Tennoz Central Tower, 2-2-24, Higashi-Shinagawa, Shinagawa-ku, Tokyo 140-0002, Japan
T: +81 3 5715 8651
F: +81 3 5460 6310
E: asamura@asamura.jp
W: www.asamura.jp/en

Sonoda & Kobayashi Intellectual Property Group

Create. Protect.
One-stop patent protection in Japan and China

www.patents.jp
Your reliable partners for intellectual property matters in Pakistan, South East Asia, Arabian Gulf, Middle East & Africa

**United Trademark & Patent Services**

International Intellectual Property Attorneys

Trademark, Patent, Design, Copyright, Domain name registration, litigation & enforcement services

**Head Office:** (New Postal & Visiting Address)
85 - The Mall Road, Lahore 54000 Pakistan
(Opposite Ferozsons books store / adjacent radio time center)

TEL: +92-42-36285589-80, +92-42-36285581-84
FAX: +92-42-36285585, 36285586, 36285587
Email: UnitedTrademark@UnitedTm.com
Websites: www.utmtps.com and www.unitedip.com

**Dubai (UAE)**
Suite 401-402, Al-Hawi Tower
Sheikh Zayed Road, Dubai
Tel: +971-4-3437 544
Fax: +971-4-3437 546
Email: Dubai@UnitedTm.com

**Oman**
Suite No. 702, 7th Floor
Oman Commercial Centre, Ruwi
Tel: +968-24-787550, 704788
Fax: +968-24-794467
Email: Oman@UnitedTm.com

**Jordan (Amman)**
Suite 2, 2nd Floor
Chicago Building, Al Abdil
Tel: +962-6-5683088
Fax: +962-6-5683089
Email: Jordan@UnitedTm.com

**Qatar**
Villa # 40, Al Amir Street
Al Msheireb Area, Doha, Qatar
Tel: +974-444 3939, 444 3939
Fax: +974-444 7311
Email: Qatar@UnitedTm.com

**Sudan (Khartoum)**
Flat No. 1, 3rd Floor, Al Hurmya St.
Shah Al Deen Brothers Bldg.
Tel: +249-183-760364
Fax: +249-183-760361
Email: sudan@UnitedTm.com

**Lebanon**
6th Floor, Suji Alda masal Building,
Tabarhom, Beirut, Lebanon
Tel: +961-1-21-5373
Fax: +961-1-21-5374
Email: Lebanon@UnitedTm.com

**Saudia Arabia**
Belvedere Mall of Al Shawarif
30th Street-Clayba, Riyadh 11444
Tel: +966-11-4616157, 4665477
Fax: +966-11-4616156, 4662134
Email: SaudiaArabia@UnitedTm.com

**Morocco**
58, Rue Ibn Batouta,
P.P. No. 4, 1 er Etag, Casablanca, Morocco
Tel: +212-522206296
Email: Morocco@UnitedTm.com

**Sharjah (UAE)**
Suite 203, Al Buhairah Building
Buhairah Corniche, Sharjah
Tel: +971-6-5722742
Fax: +971-6-5722741
Email: UAE@UnitedTm.com

**Tanzania**
Shalla Mooy Area,
Pugu Road
Dar Es Salaam
Tel: +255-222852900
Email: Tanzania@UnitedTm.com

**Yemen**
6th Floor
Ideal Clinic Building
Hadeea Street, Sana’a, Yemen.
Tel: +967 181 9642
Email: yemen@UnitedTm.com
Your reliable partners for intellectual property matters in Pakistan, South East Asia, Arabian Gulf, Middle East & Africa

Head Office: (New Postal & Visiting Address)
85 -The Mall Road, Lahore 54000 Pakistan
(Opposite Ferozesons books store / adjacent radio time center)
TEL: +92-42-36285588-90, +92-42-36285581-84
FAX: +92-42-36285585, 36285586, 36285587
Email: UnitedTrademark@UnitedTm.com
Websites: www.utmips.com and www.unitedip.com

DUBAI (UAE)
Suite 401-402, Al-Hisnai Tower
Sheikh Zayed Road, Dubai
Tel: +971-4-5343744
Fax: +971-4-5343746
Email: Dubai@UnitedTm.com

OMAN
Suite No. 702, 7th Floor
Oman Commercial Centre, Muscat
Tel: +968-24-785705, 704788
Fax: +968-24-744474
Email: Oman@UnitedTm.com

SRI LANKA
105, Entrance Lake Road, Colombo 02,
Sri Lanka.
Tel: +94 11 432290-1
Email: sri Lanka@UnitedTm.com

JORJAN (Amman)
Suite 1, 2nd Floor
Chicago Building, Alabdil
Tel: +962-6-5830368
Fax: +962-6-5830369
Email: Jordan@UnitedTm.com

QATAR
Villa 84, Al Amir Street
Al Mijleia Area, Doha, Qatar
Tel: +974-444 3893, 444 3093
Fax: +974-444 7311
Email: Qatar@UnitedTm.com

LEBANON
508, Jbd. Al-Moawda, Beirut
Tel: +961-1-21 5373
Fax: +961-1-21 5374
Email: Lebanon@UnitedTm.com

SAUDI ARABIA
Belved Maitaba Al Shawwaf
30th Street-Adliya, Riyadh 11444
Tel: +966-11-4616157, 4655477
Fax: +966-11-4616156, 4655134
Email: SaudiArabia@UnitedTm.com

TANZANIA
Shaaini Zoro Area,
Pugu Road
Dar Es Salaam
Tel: +255-222852900
Email: Tanzania@UnitedTm.com

SHARJAH (UAE)
Suite 203, Al Bahar Building
Al Bahar Corniche, Sharjah
Tel: +971-6-5727742
Fax: +971-6-5727741
Email: UnitedTm.com

YEMEN
6th Floor
Ideal Clinic Building
Hadidas Street, Sanaa, Yemen
Tel: +961 181 9642
Email: yemen@UnitedTm.com
Your Trusted IP Partner

SUSTAINABLE PRACTICES

LIM CHONG CHUAN & ASSOCIATES SDN BHD
IP Specialist in Malaysia (139400-L)
SINCE 1987

Malaysia
(6012) 6777 236
Singapore
(65) 8649 5449
ip@iplcca.com
www.iplcca.com
MALAYSIA

WHERE INTEGRITY MATTERS

Delivering Effective IP Solutions & Strategies since 2002:

✔ Quick Response Time
✔ Affordability & Adaptability
✔ Quality & Integrity Assured
✔ In-depth Client counselling
✔ Result-oriented

8706, Level 7, Block B, Kelana Square, Jalan SS7/26 Kelana Jaya, 47301 Petaling Jaya, Selangor Darul Ehsan MALAYSIA.
T: +603-788 20 456 F: +603-788 20 457 E: ip@marqonsult.com

www.marqonsult.com

2023 GLOBAL IP DIRECTORY
We have provided multinational clients with expert advise on the creation, protection and enforcement of Intellectual Property Rights and have assisted clients with litigation in this area of law.

Level 3, Valletta Buildings, South Street, Valletta VLT 11 03, Malta
T (+356) 21238989 • info@camilleripreziosi.com • camilleripreziosi.com

Discover how The Patent Lawyer Magazine can benefit you – claim your FREE sample copy

China’s drug Patent Linkage System – is it working?

Don’t miss out email chris@ctclegalmedia.com to request your FREE copy today!

www.patentlawyermagazine.com

Our experts provide high-quality services by making our clients’ challenges their own. We provide efficient and complex IP services with a business perspective to different industries.

We protect, defend and enforce your intangible assets, such as:

- Patents
- Copyrights
- Franchises
- Trademarks
- Plant Varieties
- Industrial Designs
- Trade Secrets
- Geographical Indications
- Domain Names

José Pablo Pérez Zea
jperez@s-s.mx

Daniel Legaspi J.
dlegaspi@s-s.mx

Efrain Olmedo
eolmedo@s-s.mx

Mexico City
+52 55 52795400

Monterrey
+52 81 81336000

Querétaro
+52 442 2900290

Santamarinasteta.mx
Patentability of mobile applications in Mexico

Santamarina + Steta experts explain the available methods for protecting software innovations in the mobile applications.

A patent is an exclusive right granted on an invention that has the following properties:

(i) Novelty, which, according to Mexican legislation, anything that is not considered to be “prior art”, i.e., that is information in the public domain; (ii) Industrial Application, which implies that the invention must have a practical utility that results in a benefit to society, being susceptible to its production and use in any branch of economic activity, for determined purposes; and (iii) Inventive Activity, which represents the technical development, consisting in the creative process whose results should not be deduced from the prior art in an obvious or evident way for a technician in the field.

This exclusive right empowers its owner to decide whether the invention may be used by third parties and, if so, in which manner, since patent protection means that an invention may not be produced, used, distributed for commercial purposes, or sold without the owner’s consent.

Now, mobile applications have become an indispensable part of daily life in the digital world. Their economy has grown exponentially, driven by a vast community of software developers. In order to understand the figure for its protection, it is necessary to understand the difference between a computer program, software, and a mobile application.

First of all, a computer program is an original expression in any form, language, or code, of a set of instructions that, with a specific sequence, structure, and organization, is intended for a computer or device to perform a specific task or function. On the other hand, the software is a set of computer programs, instructions and computer rules that allow the execution of different tasks, that is, a computer program is the foundation of software since several programs are needed to create it.

Now then, mobile applications are usually small software units with different functions that provide users with quality services and experiences, designed to run on a mobile device. There is no doubt that mobile applications come from human invention and therefore should find protection in Intellectual Property; however, the mechanisms for their protection depend on the jurisdiction in which protection is sought.

It would be possible to patent a mobile application as long as it has a technical nature and meets the requirements of novelty, inventive activity, and industrial application.

“The idea of patenting a mobile application under industrial property rights is common in other jurisdictions; however, the Federal Law for the Protection of Industrial Property applicable in Mexico, in its article 47 stipulates that computer programs cannot be considered inventions by themselves. In the same sense, the last paragraph of the aforementioned article establishes the possibility of patenting a computer program, as long as it is not only claimed as part of the invention but is composed of additional inventive elements.

Consequently, although the existing computer programs and software on the market cannot be protected by the patent figure, it would be possible to patent a mobile application as long as it has a technical nature and meets the requirements of novelty, inventive activity, and industrial application. In order to achieve this, the mobile application should satisfy different requirements such as interacting autonomously with its environment, gathering information, and returning results based on data collection, or being part of a medical device, for example.

It should not be forgotten that a patent is granted for a unique invention that is developed to provide a technical solution to a certain problem and the solution to this problem cannot replace other existing technical or physical solutions.

On the other hand, it is important to point out that computer programs (source code or object) are protected by copyright in Mexico. Thus, according to our legislation, the protection of works is granted from the moment they have been fixed in a material medium, regardless of their merit, destination or mode of expression.

In this regard, it is important to note that the moral rights of the work will always belong to its author. On the other side, the patrimonial rights of the work will be in force during the life of the author, plus one hundred additional years counted from his death or one hundred years after having been disclosed.

Likewise, according to our legislation, it is possible to assign the patrimonial rights of a work, but unlike trademark rights, this assignment is not indefinite or perpetual, since after a certain term the patrimonial rights must return to their original owner. Our Law stipulates that, in the event that the parties do not expressly establish an agreement, this term will be five years and that the term may only be longer than 15 years when the investment or the magnitude of the project demands.

Fortunately, with respect to computer programs, Article 103 of the Federal Copyright Law establishes an exception, which allows the assignment of rights of these works to be not limited to a defined term. On the other hand, it is also important to note that the Law provides that the ownership of computer works that have been entrusted by employers to their employees, as a function of their work, will belong to the employer.
Notwithstanding the foregoing, it is always advisable that in those cases where the creation of the computer program is entrusted to third parties, without any employment relationship between the parties involved, a “work for hire” contract is executed, which will allow that from the moment of the creation of the computer program, the ownership of the economic rights is recognized to the person who entrusted the creation of the work.

In this sense, the economic rights of a computer work entitle its owner to authorize or prohibit: i) the permanent or provisional reproduction of the program, ii) the translation, adaptation, arrangement or any modification to the program, as well as the reproduction of the resulting program, iii) any form of distribution of the program or any copy thereof, iv) the decompilation, reverse engineering, and disassembly and, v) the public communication of the program.

Consequently, seeking the protection of mobile applications, in addition to allowing their owners to take the previously mentioned actions with respect to the work, also allows an adequate defense of the same against third parties who make unauthorized use or reproduction of the same. This allows that at a commercial level exists legal actions against those competitors who reproduce the work or use it, either to market it under another name or to manage their business.

An important element to take into consideration is that, although computer programs are protected by the Federal Copyright Law per se, the fact is that the knowledge of infringement proceedings in the field of commerce is taken before the Mexican Institute of Industrial Property, which at the request of the owner may initiate actions consisting in the seizure of merchandise, prohibition of commercialization, closing of the establishment, among other precautionary measures.

In this regard, it should be noted that contrary to the protection provided by the patent, copyright protection has an extraterritorial scope and is recognized in several jurisdictions as a result of the signing of international treaties on the subject. However, those programs that manage to obtain patent protection will only enjoy an exclusive right in the jurisdiction that grants the registration.

This should be taken into consideration when seeking protection for mobile applications, specifically in Mexico.

Contact
Santamarina • Steta
Campos Eliseos, 345 floors 2 and 3
Polanco Chapultepec, Miguel Hidalgo 11560, Mexico City, Mexico.
Tel: +52 55 52795400
Web: santamarinasteta.mx

References:
Patentes. OMPI Organización Mundial de la Propiedad Intelectual. Recuperado de: https://www.wipo.int/patents/es/
Derechos de Autor. OMPI Organización Mundial de la Propiedad Intelectual. Recuperado de: https://www.wipo.int/copyright/es/
https://anincubator.com/que-es-una-aplicacion-movil/
https://definicion.de/software/
https://www.upcounsel.com/software-patent

Authors:
Ivanna Craviotto
icraviotto@s-s.mx
Faride Hage
fhage@s-s.mx
Samantha Maldonado
smaldonado@s-s.mx

Co-authors:
José Pablo Pérez Zea
jperez@s-s.mx
Daniel Legaspi
legaspi@s-s.mx
EXPERT LEGAL CONSULTING

• Prosecution and defense of IP rights
• Patents (including drafting)
• Trademarks
• Copyrights
• Domain names
• Trade Secrets
• Anti-counterfeiting
• Corporate
• Mergers and acquisitions
• Due Diligence
• Regulatory compliance
• Anti-Counterfeiting & Anti-Piracy
• Entertainment Law

• Technology Strategy
• Freedom to operate
• Technology transfer (negotiation, legal, valuation, business planning, etc.)
• IP audits, technology searching, competitive intelligence, etc. (in-house team)
• Knowledge Management
• Risk management based
• Knowledge Management tools
• Franchise and Distribution

BC&B Law & Business
@bcbmexico
bcb.com.mx

GOODRICH RIQUELME ASOCIADOS

• Industrial and Intellectual Property
• Litigation
• Licensing Enforcement
• Entertainment and Sport Law
• Copyrights

Enrique A. Diaz ediaz@goodrichriquelme.com (5255) 5525 1422
Jaime Delgado jdelgado@goodrichriquelme.com (5255) 5207 5324
Juan Carlos Suarez jcsuarez@goodrichriquelme.com (5255) 5207 9261
Guillermo Sosa gsosa@goodrichriquelme.com (5255) 5207 7561

e-mail: mailcentral@goodrichriquelme.com
website: www.goodrichriquelme.com

Paseo de la Reforma 265, M2
Col. y Del. Cuauhtemoc, 06500 Mexico, D.F.
Tel. (5255) 5533 0040, Fax. (5255) 5207 3150
Our specialized team of attorneys and professional IP practitioners have the competences and expertise that allows us assisting all kind of IP cases, bringing our clients full support and certainty on our management and results.

**IP Boutique**

“Creating solutions to protect creativity”

Contact us: Tel. (5255) 5536 5959
e-mail: info@alvarezedelucio.com

WWW.DUMONT.MX
Janak Bhandari & Associates

**Intellectual Property Attorneys**

- Trademarks
- Patents
- Designs
- Copyrights
- Anti-Counterfeiting
- Enforcement
- Litigations
- Oppositions
- Filing & Renewals
- Licensing & Franchising
- Assignment & Recordals
- Searches & Investigation

3rd Floor, Radhakuti Arcade, Putalisadak, Kathmandu- 29, Nepal.
Phone: + 977 1 4010556, Fax: + 977 1 44 19 675,
E-mail: nepalip@janakip.com
WWW.JANAKIP.COM
Your reliable partners for intellectual property matters in Pakistan, South East Asia, Arabian Gulf, Middle East & Africa

UNITED TRADEMARK & PATENT SERVICES
International Intellectual Property Attorneys
Trademark, Patent, Design, Copyright, Domain name registration, litigation & enforcement services

Head Office: (New Postal & Visiting Address)
85 -The Mall Road, Lahore 54000 Pakistan
(Opposite Ferozesons books store / adjacent rado time center)
TEL: +92-42-36285588-90, +92-42-36285581-84
FAX: +92-42-36285585, 36285586, 36285587
Email: UnitedTrademark@UnitedTm.com
Websites: www.utmtps.com and www.unitedip.com

DUBAI (UAE)
Suite 401-402, Al-Hawai Tower
Sheikh Zayed Road, Dubai
Tel: +971-4-3437 544
Fax: +971-4-3437 546
Email: Dubai@UnitedTm.com

OMAN
Suite No. 702, 7th Floor
Oman Commercial Centre, Muscat
Tel: +968-24787505, 704785
Fax: +968-2478447
Email: Oman@UnitedTm.com

SRI LANKA
105, Hulphatika Lake Road, Colombo 02,
Sri Lanka
Tel: +94 11 4322790-1
Email: srilanka@UnitedTm.com

JORDAN (Amman)
Suite 7, 2nd Floor
Chicago Building, Al Abdali
Tel: +962-6-5683988
Fax: +962-6-5683996
Email: Jordan@UnitedTm.com

QATAR
Villa # 40, Al Amir Stret
Al Msheik Area, Doha, Qatar
Tel: +974-444 3693, 444 3093
Fax: +974-444 7311
Email: Qatar@UnitedTm.com

SAUDI ARABIA
Belved Malhala, Al Shawwaf
30th Street-Galay, Riyadh 11444
Tel: +966-11-4616157, 4655477
Fax: +966-11-4616156, 4622134
Email: Saudiarabia@UnitedTm.com

SHARJAH (UAE)
Suite 203, Al Buhairah Building
Buhairah Corniche, Sharjah
Tel: +971-6-5722742
Fax: +971-6-5722741
Email: Sharjah@UnitedTm.com

TANZANIA
Shauri Moyo Area,
Pugu Road
Dar-Es-Sabau
Tel: +255-222852990
Email: Tanzania@UnitedTm.com

YEMEN
6th Floor
Ideal Clinic Building
Haddas Street, Sana'a, Yemen
Tel: +967 1819462
Email: yemen@UnitedTm.com
Nominate for The Patent Lawyer Award Winning Law Firm Rankings

www.patentlawymagazine.com/law-firm-rankings/

STAY UP-TO-DATE

sign up to our newsletter

Become part of The Patent Lawyer team.

Apply to be a 2024 Editorial Board Member:

www.patentlawymagazine.com/editorial-

Sponsored by
Your reliable partners for intellectual property matters in Pakistan, South East Asia, Arabian Gulf, Middle East & Africa

**Head Office:** (New Postal & Visiting Address)
85 - The Mall Road, Lahore 54000 Pakistan
(Opposite Ferozsons books store / adjacent radio time center)

**TEL:** +92-42-36285588-90, +92-42-36285581-84
**FAX:** +92-42-36285585, 36285586, 36285587

**Email:** UnitedTrademark@UnitedTIm.com

**Websites:** www.utmps.com and www.unitedip.com

**DUBAI (UAE)**
Suite 401-402, Al – Hazira Tower Sheikh Zayed Road, Dubai
Tel: +971-4-3437 544
Fax: +971-4-3437 546
Email: Dubai@UnitedTIm.com

**OMAN**
Sult No. 702, 7th Floor
Oman Commercial Centre, Ruwi
Tel: +968-24-797554, 704788
Fax: +968-24-79447
Email: Oman@UnitedTIm.com

**SRI LANKA**
105, Hunupitiya Lake Road, Colombo 02,
Sri Lanka.
Tel: +94 11 4322790-1
Email: srilanka@UnitedTIm.com

**JORDAN (Aman)**
Suite 2, 2nd Floor
Chicago Building, Al Abadi
Tel: +962-6-5883088
Fax: +962-6-5883089
Email: Jordan@UnitedTIm.com

**QATAR**
Villa 40, Al Amir Street
Al Mirqab Area, Doha, Qatar
Tel: +974-444 3083, 444 3093
Fax: +974-444 7311
Email: Qatar@UnitedTIm.com

**LEBANON**
6th Floor, Bldg Al-Ghazal Bldg,
Tabarzin, Beirut, Lebanon
Tel: +961-1-21 5373
Fax: +961-1-21 5374
Email: Lebanon@UnitedTIm.com

**SAUDI ARABIA**
Behind Maktab Al Shawaf
30th Street-Clayya, Riyadh 11444
Tel: +966-11-4615157, 4655477
Fax: +966-11-4616150, 4622134
Email: SaudiArabia@UnitedTIm.com

**TANZANIA**
Shauri Moyo Area,
Pugu Road
Dar-Es-Salam
Tel: +255-222862800
Email: Tanzania@UnitedTIm.com

**LEBANON (Kamoon)**
Suite 203, Al Bahsha Building,
Al Burj Al Bahsha, Beirut, Lebanon
Tel: +961-1-21 5373
Fax: +961-1-21 5374
Email: Lebanon@UnitedTIm.com

**SRI LANKA**
105, Hunupitiya Lake Road, Colombo 02,
Sri Lanka.
Tel: +94 11 4322790-1
Email: srilanka@UnitedTIm.com

**M. AMIN & COMPANY**
Intellectual Property Protection Services

**Address for visiting & couriers:**
First Floor, Mall Plaza Building
(Opposite Ferozsons)
85 Shar-e-Qad Azam, Lahore, 54000 Pakistan.

**Postal address:**
G.P.O. Box 325, Lahore-54000 Pakistan
Tel: 0092-42-36285580 Fax: 0092-42-36285577

Email: email@amin.com.pk

Undertaking all matters for protection of Intellectual Property Rights in Pakistan, Afghanistan, Bangladesh, India, Iran, Africa, Gulf & Middle East through the local network of correspondents in these countries. Trademark Renewals, Patent Annullities & Regional Filing Program Projects Specialist for Trademarks, Patents and Designs
Vellani & Vellani is a premier full-service law practice established in 1937, with a particular focus on Intellectual Property. Our lawyers have a deep understanding of the issues faced by clients, and the expertise to provide advice that is practical, comprehensive, timely and helps meet the clients’ aspirations.
Enhance your business.
Keep this card for the best IP service in Latin America.

Exclusivity in IP prosecution and litigation since 1904

https://colmenares.com.pe/
email@colmenares.com.pe
https://www.linkedin.com/company/estudio-colmenares-asiociados/
https://www.linkedin.com/company/estudio-colmenares-asiociados/

Colmenares & Asociados
IP Since 1904
Lima - Peru
Ariana Gayoso Echevarria of Estudio Colmenares & Asociados evaluates the protection secured through patents compared to trade secrets and offers examples of when each is beneficial.

“The secret of my influence has always been that it remained secret.”

Salvador Dali

Trade secrets and patents make the difference in a firm’s economic success or failure and it is key for a manager to know which intangible assets are valuable to be patented or to be kept private. Taking references from successful businesses can give us insight into what comes into play when deciding on strategies.

For most organizations there is relevance in secrecy. This can encompass all areas of business, from publicity strategies, manufacturing processes, new developments, client contacts, etc. that could be protected as copyright. Secrets coming out to the competition are sometimes a threat and managers have to consider how competitors can get that information in bad faith.

When patenting a formula or invention it is required to publish exactly how it can be reproduced and the specific use behind it. This grants exclusivity rights to the owner of the patented asset for a limited time. Trade secrets have no exclusive rights, the information is kept secret simply because it gives the company significant economic advantage over others and without time constraints. However, these secrets can be broken through independent discovery and accidental or intentional disclosure within the company which drastically affects their image and profit. The main consideration of a patent vs. a trade secret is the cost and the time it takes to be approved.

A part of Coca-Cola’s marketing success was keeping its formula secret.

As a first example, we have the Coca-Cola formula, a famous trade secret. Estudio Colmenares has patented several inventions in favor of its client The Coca-Cola Company, but none of those pertain to the specific formula of their popular soda.

Some of Coca-Cola’s patent inventions refer to methods that recognize contaminants, specific recipients, refrigerants and other types of sample-taking systems. In a book of “Big Secrets” William Poundstone found some basic components in the formula like vanilla extract, lime juice flavoring and the famous coca leaf that gives it its name. (Coca leaf gives the drink its stimulant properties, it is a plant that derives from South American countries, mainly Peru, and its regular use there is to chew on it to get an energy boost). Nevertheless, the exact composition of the formula is unknown to the public and has gone through many changes over the years.

On the other hand, with today’s technological advances, many organizations are able to figure out the exact chemical composition of certain pharmacological drugs, drinks and/or manufacturing processes of products, therefore it makes sense to patent and benefit from the time limit for as long as possible for economic and strategic market success.

As a second example, we have a mechanical patent, the Glock pistol that revolutionized the firearm industry due to its lightweight materials, simple use and other properties that made it unique.

Mr. Gaston Glock filed his first patent in 1953, initially meant for the Austrian military and law enforcement because of its fast performance and at the same time providing safety against accidental discharge. The Glock that later revolutionized the market, the G17, didn’t appear...
until 1985 in the United States (issued Patent Number 4,539,889). The Glock pistol’s design was innovative, easy to build and extremely durable.

From a business point of view, it was a smart strategy to patent the Glock design as it could be easily replicated. After the lapsing of the Glock patent, many gun companies have manufactured guns with the same properties that once were unique for The Glock Inc. But having exclusive rights gave the brand recognition and leadership; meaning that a patent can be an investment for businesses to remain top players in the market after it expires.

Returning to the opposite example, if Coca-Cola had filed its formula as a patent their competitors would have already begun selling generic versions of the product that would be almost identical to the original. A part of Coca-Cola’s marketing success was keeping its formula secret, not only as information that derives economic value but as a mystery that continues to keep customers interested. People naturally gravitate towards the hidden and mysterious, giving it intrinsic value. This is related to how the customer perceives the brand. Perception, as a psychological concept, is how people picture, interpret or understand the brand in their minds. This has great impact on their behavior, which is what a company is interested in: purchases and loyalty.

On a third but different example, we have Elon Musk’s company; Tesla’s electric cars have changed how we view the car industry. This particular case refers to an open-sourced patent, meaning that the owner controls how others use their invention but it is not maintained as a trade secret nor are others legally prevented from using it. In this case, according to Tesla, there is no specific economic plan behind this action but rather an altruistic one. Their enemies are the big gasoline car companies; therefore, they wish to create more competition from other electric car companies for a more sustainable future and address the carbon crisis.

Here, we observe a business model that shares their patents because otherwise it would be against their mission. According to their ideals, true competitive advantage comes from innovation instead of preventing competition advancement. They want the future of electric cars to accelerate in order to help the environment and they even made the statement that their goal wasn’t to make profit. This business model is completely different from the other two we observed before, Tesla does not patent their cars or use trade secrecy. They believe this system will strengthen Tesla’s position instead of weakening it.

To summarize, here are some practical solutions to the question of how to strategize intangible assets in a business. If opting for a patent, having an exclusive register that gives a limited use of time can be an economic advantage when having an easily replicated invention. It can also grant the company status and positioning in the market, forming customer loyalty. When opting for a trade secret a business has to evaluate if they have the resources to maintain the secret as long as it has commercial and economic value, the secret has to be characteristic, and irreplicable. Finally, there are additional innovative options that do not fit into either category, these are outside of regular parameters which give us a new outlook towards new ideas of business and IP protection.
Pierola & Asociados

Patent and trademark prosecution and litigation. 48 years of professional practice in all areas of IP practice representing clients from several countries.

Address: Manuel Almenara 265, Lima 18, Peru • Telephone: + 51 1 447 2454
Email: estudio@pierola.com.pe • Website: www.pierola-asociados.com
LinkedIn: https://pe.linkedin.com/in/josedepierola • Contact: Jose de Pierola

“LOCAL CONNECTIONS MAKE ALL THE DIFFERENCE WHEN THE IP MATTERS CROSS BORDERS”

304 W 51st St, Suite 400 Chicago, IL 60616 USA

2023 GLOBAL IP DIRECTORY
FEDERIS AND ASSOCIATES
PHILIPPINES

SUITES 2002 TO 2005
88 CORPORATE CENTER, 141 VALERO ST.
SALCEDO VILLAGE, MAKATI CITY 1227
PHILIPPINES

PHONE (632) 8 889 6197/98
MAIL@FEDERISLAW.COM.PH
MFEDERIS@FEDERISLAW.COM.PH
WWW.FEDERISLAW.COM.PH
YOUR IP PARTNER IN POLAND

Full-service law firm
- office@traple.pl
- www.traple.pl
ChatGPT and intellectual property

Agnieszka Wachowska and Marcin Ręgorowicz of Traple Konarski Podrecki and Partners shed light on the much-debated topic of IP protection, and indeed infringement, for AI-created works.

One of the principal topics in the recent intense debate on the subject of development and use of artificial intelligence (AI), and of the system that is best known as ChatGPT, is the question of intellectual property rights. In fact, examination of this issue and the legislation enacted to address it will have significant implications with respect to the areas into which use of these systems expands, due to its potential – especially for commercial applications.

There are three main legal problems relating to this issue:
1. Possible infringement of third-party intellectual property rights when the system is “learning” and when it is launched;
2. The status of the generated content and how to protect it;
3. Who holds the right to use the generated content.

Machine learning and copyright

The issue of machine learning is a highly emotive one and has already led to specific legal measures being taken in particular lawsuits against AI system suppliers. Training the system concerned requires systemic analysis and processing of huge amounts of data, including data that constitutes works protected under copyright law in various jurisdictions. The debate centers around the right of operators of systems that “learn” to make use of databases that are in the public domain. The main claim against operators of systems of this kind is that they unlawfully extract and process available data in a massive and automatic manner (i.e., so-called “web scraping”), which is then used to create their own content. The parties that raise claims say that this conduct infringes the rights of the original authors or other rightsholders. Importantly, holders of rights to databases on which AI systems “learn” are able to file similar claims.

Legislators in various countries around the world and in the EU have discerned this problem, and in the EU, elements of a regulatory framework addressing the issue were implemented in the DSM Directive. Under the DSM Directive, national legislatures are required to pass laws enabling third parties to reproduce databases or works in the meaning of copyright law for the purpose of machine learning. This applies to both academic and commercial use, while a rightsholder can refuse to give consent with respect to commercial use. The respective laws have been passed in some EU countries. In the case of Poland, the legislative process and work on amendments is ongoing as of the moment this article went to press.

---

Clearly, this issue is very interesting from a legal point of view, while in the view of the authors, it is crucial primarily for creators and providers of systems of this kind, taking into account the practical aspects of using ChatGPT and similar tools. It is these parties that will firstly face a risk due to the claims being pursued.

Whether or not it is a copyrighted work

The other issue with many more practical implications for users of ChatGPT and similar systems is the status of the generated content. The starting point for considering this issue is the question of whether this content constitutes copyrighted works. The debate among experts has become very important, and resolving the issue has now become a matter of urgency. The concerns stem from the fact that in most legal systems, one of the essential criteria for an element to be considered a copyrighted work in the meaning of copyright law, as the legal requirement of human creative output is not met. This approach means that copyright protection does not apply, and therefore it is permitted for example to freely copy, adapt, and make commercial use of content of this kind.

The opposite viewpoint is also taken, that content generated by ChatGPT and similar systems can be considered copyrighted works under current copyright law, because ultimately the creator is human. There are various proposals in this regard, while in this approach the author is identified for instance as the operator of a particular system (or the party that constructed and "trained" it), or also the end-user, as the end-user defines the criteria for the generated content, and thus plays the fundamental creative role in creation of the content.

This issue is currently unresolved. Intervention of the legislature in specific jurisdictions is needed to address these concerns. Of course, the issue could be settled in court rulings on the issues described above. The first cases have now been filed in courts in various countries around the world.

In the authors’ view, in the context described, the institution of *computer-generated works* is noteworthy, which has existed for years in certain jurisdictions such as the United Kingdom. Under the UK’s 1988 Copyright, Designs and Patents Act, *the work is generated by computer in circumstances such that there is no human author of the work*. These works are protected by copyright, while the copyright to the work is held by the person who performed the essential actions to create it.

The numerous legal concerns regarding the status of content generated by ChatGPT and similar systems also include the issue that if this content is considered to constitute a work, the next debate arises as to the relationship between this content and works used in the "training" of the system in question (such as ChatGPT). The extreme view is that content generated using AI must be considered a derivative work or the equivalent of this content. The issue could prove to be an infringement of third-party rights at a certain point.

There is no doubt that in the current debate on the legal aspects of AI systems, the most fundamental issues need to be addressed, above all whether content generated by tools of this kind is protected by law, and on what grounds. On the other hand, the benefits of technological systems of this kind are so great that many persons and institutions have begun using them in their business activity or will consider doing so. Clearly, therefore, we can expect an exciting debate on the fundamental concepts of copyright law in the new social and economic reality.

In our view, this is not a correct position, reached due to not being aware of the "technical" nature of operations of ChatGPT and similar tools. Meanwhile, it is an excellent illustration that fundamental issues regarding use of this revolutionary technology remain unresolved, and of the high level of legal uncertainty surrounding its use. More importantly, the current copyright framework is based on rules formulated at a time when artificial intelligence did not exist, and was talked about in the realm of science-fiction. Clearly, the main copyright institutions are not suited to this new reality. At the moment, it is essential to reflect on elements of law as fundamental as the characteristics of a work. For this reason, ChatGPT users need to follow the ongoing debate closely, as use of generated content could prove to be an infringement of third-party rights at a certain point.

Contact

Traple Konarski Podrecki and Partners
ul. Królowej Jadwigi 170 30-212 Kraków, Poland
Tel: (+48) 12 426 05 30
Email: office@traple.pl
Web: www.traple.pl/en/
CAIADO GUERREIRO
INTERNATIONAL LAW FIRM

PROTECT YOUR BRAND
PORTUGAL | MACAO | ANGOLA | MOZAMBIQUE | S. THOMAS AND PRINCE | CAPE VERDE | TIMOR

Av. José Gomes Ferreira, 15–3 L Algés, Portugal
+351 21 324 15 30
agcunhaferreira.pt
marcpat@agcunhaferreira.pt

Europe & Africa IP Law Firm
Protecting Intelligence®

www.caiadoguerreiro.com

2023 GLOBAL IP DIRECTORY
Your reliable partners for intellectual property matters in Pakistan, South East Asia, Arabian Gulf, Middle East & Africa

Romania

United Trademark & Patent Services
International Intellectual Property Attorneys
Trademark, Patent, Design, Copyright, Domain name registration, litigation & enforcement services

Head Office: (New Postal & Visiting Address)
85 -The Mall Road, Lahore 54000 Pakistan
(Opposite Ferozsons books store / adjacent radio time center)
TEL: +92-42-36285588-90, +92-42-36285581-84
FAX: +92-42-36285585, 36285586, 36285587
Email: UnitedTrademark@UnitedTm.com
Websites: www.utmmps.com and www.unitedip.com

Dubai (UAE)
Suite 401-402, Al-Hawiya Tower
Sheikh Zayed Road, Dubai
Tel: +971-4-3437 544
Fax: +971-4-3437 548
Email: Dubai@UnitedTm.com

Oman
Suite No. 703, 7th Floor
Oman Commercial Centre, Muscat
Tel: +968-24-797555, 704788
Fax: +968-24-794447
Email: Oman@UnitedTm.com

Sri Lanka
106, Hunupitiya Lake Road,
Colombo 02, Sri Lanka.
Tel: +94 11 4322790-1
Email: srlanka@UnitedTm.com

Jordan (Amman)
Suite 7, 2nd Floor
Chicago Building, Al Abdali
Tel: +962-6-5830388
Fax: +962-6-5830389
Email: Jordan@UnitedTm.com

Qatar
Villa # 40, Al Amir St.
Al Mirqab Area, Doha, Qatar
Tel: +974-444 3083, 444 3093
Fax: +974-444 7317
Email: Qatar@UnitedTm.com

Lebanon
6th Floor, Burj Al-Ghazal Bldg.,
Tabarja, Beirut, Lebanon
Tel: +961-1-21 5373
Fax: +961-1-21 5374
Email: Lebanon@UnitedTm.com

Saudi Arabia
Behind Maktaba Al Shawwal
30th Street-Chiyah, Riyadh 11444
Tel: +966-11-4616157, 4655477
Fax: +966-11-4616150, 4622134
Email: SaudiArabia@UnitedTm.com

Tanzania
Shama Moyo Area,
Pugu Road
Dar-Es-Salaam
Tel: +255-222862900
Email: Tanzania@UnitedTm.com

Morocco
58, Rue Ibn Batouta,
P.P. No. 4, 1 er Etage,
Casablanca, Morocco
Tel: +212-52270299
Email: Morocco@UnitedTm.com

Sharjah (UAE)
Suite 203, Al Buhairah Building
Buhairah Comiche, Sharjah
Tel: +971-6-5722742
Fax: +971-6-5722741
Email: UAE@UnitedTm.com

Yemen
6th Floor
Izade Clinic Building
Hadda Street, San'a'a, Yemen.
Tel: +967 181 8642
Email: yemen@UnitedTm.com
CABINET M. OPROIU
EUROPEAN PATENT AND TRADEMARK ATTORNEYS

Address: Popa Savu Street No. 42, Ground Floor, P.O. Box 2-229, Bucharest, Romania
Tel: +40 21 260 2833; +40 21 260 2834
Fax: +40 21 260 2835; +40 21 260 2836
Email: raluca@oproiu.ro
Website: www.oproiu.ro
IP SERVICES IN RUSSIA, EURASIA, UAE AND CIS COUNTRIES

IP LITIGATION

PATENTS

TRADEMARKS

AGREEMENTS

Russian Federation
Moscow, 129090, Grokholskiy per., d. 28, 2nd floor, Tel: + 7 (495) 775-16-37
email: info@zuykov.com

Belarus
Minsk, 220004, 23/1 Pobediteley Avenue
Tel: +375 17 204-16-37
email: bel@zuykov.com

Kazakhstan
Almaty, 050042, 28/8 Ryskulbekov Str., Office 59
Tel: +7 727 312 16 37
email: kz@zuykov.com

UAE
Dubai, Barsha Heights, Madison Residency, Office 611,
Tel: +971-50-425-1637
email: info@zuykovae
Your reliable partners for intellectual property matters in Pakistan, South East Asia, Arabian Gulf, Middle East & Africa

Head Office: (New Postal & Visiting Address)
85 -The Mall Road, Lahore 54000 Pakistan
(Opposite Ferozsons books store / adjacent radio time center)

TEL: +92-42-36285588-90, +92-42-36285581-84
FAX: +92-42-36285585, 36285586, 36285587
Email: UnitedTrademark@UnitedTm.com

Websites: www.utmpps.com and www.unitedip.com

DUBAI (UAE)
Suite 401-402, Al-Hayat Tower
Sheikh Zayed Road, Dubai
Tel: +971-4-3437 544
Fax: +971-4-3437 548
Email: Dubai@UnitedTm.com

OMAN
Suite No. 702, 7th Floor
Oman Commercial Centre, Ruwi
Tel: +968-24-787555, 704788
Fax: +968-24-784647
Email: Oman@UnitedTm.com

SRI LANKA
105, Hunupitiya Lake Road,
Colombo 02,
Sri Lanka.
Tel: +94 11 4322739-1
Email: srilanka@UnitedTm.com

JORDAN (Amman)
Suite 7, 2nd Floor
Chicago Building, Al Abdali
Tel: +962-6-5683088
Fax: +962-6-5683089
Email: Jordan@UnitedTm.com

LEBANON
6th Floor, Burj Al-Ghazal Bldg.,
Tabarja, Beirut, Lebanon
Tel: +961-1-21 5373
Fax: +961-1-21 5374
Email: Lebanon@UnitedTm.com

QATAR
Villa # 40, Al Amir Street
Al Msayraf Area, Doha, Qatar
Tel: +974-444 3083, 444 3093
Fax: +974-444 7311
Email: Qatar@UnitedTm.com

SAUDI ARABIA
Behind Maktaba Al Shawwaf
30th Street, Olaya, Riyadh 11444
Tel: +966-11-4616157, 4655477
Fax: +966-11-4616150, 4621234
Email: SaudiArabia@UnitedTm.com

TANZANIA
Shampango Area,
Pugu Road
Dar-Es-Salaam
Tel: +255-222802900
Email: Tanzania@UnitedTm.com

MOORE
59 Rue Ibn Batouta,
P.O. No. 4, 1er Etagie,
Casablanca, Morocco
Tel: +212-52208398
Email: Morocco@UnitedTm.com

SHARJAH (UAE)
Suite 203, Al Buhaith Building
Buhamrah Comiche, Sharjah
Tel: +971-6-5722742
Fax: +971-6-5722741
Email: UAE@UnitedTm.com

YEMEN
6th Floor
Ideal Clinic Building
Hadda Street, Sana'a, Yemen.
Tel: +967 181 8642
Email: yemen@UnitedTm.com
WE GOT YOU COVERED

Protecting Your IP Rights Every Step of the Way

Representing clients from all over the world in more than 30 countries:

Andorra
Albania
Armenia
Azerbaijan
Belarus
Bosnia
Bulgaria
Croatia
Cyprus
Czech Rep.
Estonia
Georgia
Greece
Hungary
Kazakhstan
Kosovo*
Kyrgyzstan

Latvia
Lithuania
Moldova
Montenegro
N. Macedonia
Poland
Romania
Russia
Serbia
Slovakia
Slovenia
Tajikistan
Ukraine
Turkey
Turkmenistan
Uzbekistan

Makedonska 32 • Belgrade • Serbia
+381 11 3226189 • office@risticmalesevic.com

risticmalesevic.com
Sri Lanka

Your Intellectual Property agent in Eastern Europe and Asia
European Patent and Trademark Attorneys
Domain name registrar (.si)

European countries
Slovenia | Croatia | Bosnia and Herzegovina | Serbia | Kosovo | Montenegro | North Macedonia | Albania | Bulgaria | Czech Republic | Cyprus | Greece | Hungary | Poland | Romania | Slovak Republic | Turkey | Estonia | Lithuania | Latvia

Eurasia
Russia | Armenia | Azerbaijan | Belarus | Georgia | Kazakhstan | Kyrgyzstan | Moldova | Tajikistan | Turkmenistan | Ukraine | Uzbekistan | Mongolia

Mark-Inventa Co., Ltd.
Glinška ulica 14, SI-1000 Ljubljana, Slovenia
P.O. BOX 2948, 1001 Ljubljana, Slovenia
p: +386 1 4256 503 and +386 1 5404 331
f: +386 1 2510 508 and +386 1 5243 118
e: office@mark-inventa.si
url: www.mark-inventa.com
Julius and Creasy is one of the oldest civil law firms in Sri Lanka. Founded in 1879, the firm has established itself on rich tradition and the highest professional principles. Julius and Creasy’s wealth of expertise and experience in a wide range of specialized fields of Law enables it to offer innovative legal and business solutions to a diverse, sophisticated and high profile clientele.

Our firm from its inception has been involved in intellectual property work. We advice on all aspects of Intellectual Property. Our work relates to both contentious and non-contentious matters. We file a large number of trademark applications for overseas clients being instructed by our associates in several countries including UK, European Union, USA, India, Singapore, Hongkong, Australia, New Zealand, Japan and Korea.

We are also involved in registering overseas trademarks of well known exporters of Sri Lankan products.

In contentious matters we represent clients both at the National Intellectual Property Office in opposition proceedings and in infringement proceedings before Courts. Infringement proceedings are instituted in the Commercial High Court and where necessary criminal proceedings are also instituted in the Magistrate’s Court.

Although our practice is to a great extent trademarks, we have substantial portfolio of patents as well. A large part of this portfolio is related to PCT applications filed in Sri Lanka. We also file number of design applications for overseas clients in Sri Lanka and for Sri Lankan clients overseas through our associates in various countries. We also have trained staff and do Patent drafting on behalf of our clients. We also advise on copyright issues including reviewing of copyright agreements and advise publishers. We engage ourselves in IP due diligence work and also file applications for registration at the Sri Lanka Customs.

Sweden

INTERNATIONAL PATENT AND LAW FIRM

SWEDEN • SCANDINAVIA • EUROPE

European Patents
EU Trade Marks
Community Designs
Copyright & Marketing Law
IP Due Diligence & Business Law
Domain Name Disputes & Internet Law
Mediation
Social Network Law
Artificial Intelligence

info@fenixlegal.eu
www.fenixlegal.eu

Östermalmstorg 1 • 114 42 Stockholm • Sweden
info@fenixlegal.eu • www.fenixlegal.eu

2023 GLOBAL IP DIRECTORY
Discover how The Trademark Lawyer Magazine can benefit you – claim your FREE sample copy

Statutory damages provide key enforcement mechanism to curb counterfeiters

Nicholas J. Naudé, Matthews IP,,Zuber   

Don’t miss out email chris@ctclegalmedia.com to request your FREE copy today!

www.trademarklawyermagazine.com
IP Right Prosecution & Litigation
Corporate Legal & Consulting
IP Value-Added Services

Quality | Reliable | Invaluable

Focus: Patents, Trademarks, Copyrights, Trade Secrets, Unfair Competition Licensing, Counseling, Litigation, Transaction
Territories: Taiwan, Mainland China, Hong Kong, and Macau Fields: Mechanics, Chemistry, Pharmacy, Biology, Electronics, Optics, Telecommunications, and Computer Sciences

Address: 13th Floor, 27, Sec. 3, Chung San N. Road, Taipei, Taiwan
Telephone: 886-2-25856688
Fax: 886-2-25989900/25978989
E-mail: email@deepnfar.com.tw

Quality | Reliable | Invaluable

IP Right Prosecution & Litigation
Corporate Legal & Consulting
IP Value-Added Services

Focus: Patents, Trademarks, Copyrights, Trade Secrets, Unfair Competition Licensing, Counseling, Litigation, Transaction
Territories: Taiwan, Mainland China, Hong Kong, and Macau Fields: Mechanics, Chemistry, Pharmacy, Biology, Electronics, Optics, Telecommunications, and Computer Sciences

Address: 13th Floor, 27, Sec. 3, Chung San N. Road, Taipei, Taiwan
Telephone: 886-2-25856688
Fax: 886-2-25989900/25978989
E-mail: email@deepnfar.com.tw
Yu-Li Tsai, Partner and Patent Attorney, of DEEP & FAR Attorneys-at-Law raises a practical examination case to help those in the information technology applications field better understand the patent application process for neural network systems.

I. Purpose
Five major information technology application fields, including artificial intelligence, big data, blockchain, Internet of Things and cloud applications are becoming increasingly popular in recent years, so it is very important for a player in this field to know how the examiner in Taiwan would examine the patent application related to the innovation in these fields.

Therefore, this article would like to raise a practical examination case related to a neural network system for the reader to have a brief idea what is the examiner’s logical thinking during the examination.

II. Facts about a neural network system case
1. [Problem to be solved] The modern neural network system needs to introduce a nonlinear relationship between the output and the input; otherwise the output of the next layer in the system is a linear combination of the input from the previous layer (that is, matrix multiplication), and the output and input are still kept with linear relationships rather than modern neural networks used for nonlinear statistical data modeling.

2. [Technical means] The command is executed by a system with a processor and a memory, and the command uses an activation function to convert the input initial data into linear rectified data.

3. [Efficacy] By converting the initial data into linear rectified data through an activation function (ReLU function), a nonlinear relationship between the output and the input can be introduced into the neural network system.

4. Claim 1:
A neural network system, comprising: a memory, capable of storing one or more commands; a processor, coupled to the memory, capable of accessing and executing the one or more commands of the memory; the one or more commands include: receiving initial data to a first area, the first area includes at least one activation function in the neural network, the activation function is a ramp function, which can convert the initial data into linear rectified data; the linear rectified data is further transmitted to a second area to generate a learning result corresponding to the initial data.

5. Claim 2:
A neural network system, comprising: a memory, capable of storing one or more commands; a processor, coupled to the memory, capable of accessing and executing the one or more commands of the memory; the one or more commands include: receiving initial data to a first area, the first area includes at least one activation function in the neural network, the activation function is a ramp function, which can convert the initial data into linear rectified data; the linear rectified data is further transmitted to a second area to generate a learning result corresponding to the initial data.

6. [Specification] The neural network system can include computing layers such as convolutional layers, activation layers, pooling layers, and fully connected layers. This system uses a computer system including a processor and memory to execute the neural network model and limits the activation function of the activation layer to be a ramp function, which can perform nonlinear filtering on the output value of the convolutional layer, and endow the neural network system with a nonlinear relationship between the output and the input.
III. Examiner’s Logic

1. Claim 1 does not meet the definition of invention
2. Claim 2 meets the definition of invention.

3. The steps for judging subject matter eligibility are as follows:
   (1) Whether it obviously meets the definition of invention: the inventions of the Claims 1 and 2 do not implement a control of the machine, nor is it a process accompanying the control. In addition, the information processed by the inventions of claims 1 and 2 is data, and there is no limitation on what the data is, so the information processing based on the technical nature of the object is not performed. Therefore, the inventions of claims 1 and 2 did not obviously meet the definition of invention.
   (2) Whether it obviously does not meet the definition of invention: the inventions of claims 1 and 2 are “system” inventions, so it is implied that they are jointly completed by software and hardware, so it is not obviously ineligible and should be further judged from the perspective of software.
   (3) Judging from the perspective of software: [Claim 1] Although Claim 1 discloses that a processor is used to execute commands to enhance a data’s nonlinear characteristics, it only discloses the execution commands, and does not disclose how to process the data to enhance its nonlinear data characteristics. Therefore, it does not specifically disclose software using hardware resources to achieve specific information processing and does not meet the definition of invention.
   [Claim 2] Claim 2 discloses a processor execution command, which has clearly disclosed that its activation function is a ramp function, and the processed data also specifies the initial data of the first area, which becomes linear rectified data after being processed by the activation function data, and transmits the linear rectified data to the second area to generate a learning result; therefore, the data to be processed becomes linear rectified data after being transmitted, flowed and processed by the activation function between the neural networks, and continues to be computed to generate a learning result, and it is also clearly disclosed that the activation function is a ramp function, so the invention of this claim has disclosed that the specific software and hardware work together to achieve specific information processing, which meets the definition of the invention.

IV. Conclusion and suggestion

In view of the above case study, we would like to conclude and suggest that when an invention is related to software, such as a neural network system, a claim directed to the invention should not merely recite that a processor is used to execute certain unspecific commands to achieve some expected efficacy. If no specific algorithm or operation corresponding to the execution commands for achieving the expected efficacy is disclosed, the claim will be judged as not specifically disclosing the software using hardware resources to achieve specific information processing, which does not meet the definition of invention.
ALIPO values your creation, innovation and solution

24+
Established years

People
- 30% of our staff has 10+ years of industrial experience
- 80% of our staff is officially certificated in IP management
- Continues on-the-job training and skill improvements

Services
- Sophisticated transactions at reasonable costs
- Customized, scalable patent portfolio strategies
- Tailored customer education

Management
- ISO 9001 quality certification
- Proprietary computerized docket system
- Access-controlled secure archives

Taiwan | China | Japan | United States

- Patent Monitoring
- Translation & Training Courses
- Worldwide Patent Prosecution
- Infringement Analysis
- Trademark Applications
- Litigation Related to IP and Copyright

www.giant-group.com.tw  +886-2-87683696  ggi@giant-group.com.tw
Your reliable partners for intellectual property matters
in Pakistan, South East Asia, Arabian Gulf, Middle East & Africa

Head Office: (New Postal & Visiting Address)
85 -The Mall Road, Lahore 54000 Pakistan
(Opposite Ferozesons books store / adjacent radio time center)
TEL: +92-42-36285588-90, +92-42-36285581-84
FAX: +92-42-36285585, 36285586, 36285587
Email: UnitedTrademark@UnitedTm.com
Websites: www.utmps.com and www.unitedip.com

UNITED TRADEMARK & PATENT SERVICES
International Intellectual Property Attorneys
Trademark, Patent, Design, Copyright, Domain name registration, litigation & enforcement services

DUBAI (UAE)
Suite 401-402, Al-Haweil Tower
Sheikh Zayed Road, Dubai
Tel: +971-4-3437 544
Fax: +971-4-3437 546
Email: Dubai@UnitedTm.com

OMAN
Suite No. 702, 7th Floor
Omran Commercial Centre, Rowd
Tel: +968-24-787500, 704788
Fax: +968-24-786447
Email: Oman@UnitedTm.com

SRI LANKA
105, Hupupiya Lake Road, Colombo 02,
Sri Lanka
Tel: +94 11 4322790-1
Email: sri.lanka@UnitedTm.com

JORDAN (Amman)
Suite 7, 2nd Floor
Chicago Building, Al Abdali
Tel: +962-6-5883888
Fax: +962-6-5883899
Email: Jordan@UnitedTm.com

QATAR
Villa # 40, Al Amir Street
Al Mirqab Area, Doha, Qatar
Tel: +974-444 3983, 444 3993
Fax: +974-444 3311
Email: Qatar@UnitedTm.com

SAUDI ARABIA
Belved Malabibi Al Shawwaf
30th Street-Olaya, Riyadh 11444
Tel: +966-11-4616157, 4653477
Fax: +966-11-4616156, 4622134
Email: SaudiArabia@UnitedTm.com

SHARJAH (UAE)
Suite 203, Al Buheirah Building
Buheirah Corniche, Sharjah
Tel: +971-6-5727242
Fax: +971-6-5727241
Email: UAE@UnitedTm.com

TANZANIA
Dar Es-Salaam
Tel: +255-222892900
Email: Tanzania@UnitedTm.com

YEMEN
6th Floor
Ideal Clinic Building
Haddas Street, Sana’a, Yemen
Tel: +967 181 9642
Email: yemen@UnitedTm.com
Welcome to LawExchange Associates, a full-service law firm providing innovative legal solutions to its domestic as well as international clients.

- Intellectual Property
- Property & Conveyancing Law
- Corporate & Commercial Law
- Tax Law
- Competition Law
- Contracts Law
- Labour and Employment Law
- Insurance Law
- Notarial Practice
- Family Law
- Administrative and Public Law
- Banking and Finance Law
- Energy Law
- Probate, Succession and Trusts
- General Litigation/Alternative Dispute Resolution
- Consultancy on matters of Tax
- Entertainment Law.
The specialist firm
at the forefront
of Intellectual Property
legal services in The Bahamas
with a wealth of knowledge
and experience.
Founded in 1882, J.D. Sellier + Co. is the oldest law firm in Trinidad and Tobago. Today, the firm has expanded to over 20 attorneys-at-law and 77 employees offering its clients quality legal services in all areas of Civil Law; including Intellectual Property, Corporate/Commercial, Banking and Finance, Admiralty and Shipping, Tax, Real Estate and Conveyancing, Probate, Litigation and Dispute Resolution.

The Intellectual Property Practice Group can trace its records to 1929, and its team of very experienced Attorneys offer in depth advice and analysis of issues concerning any area of Intellectual Property Law. We work closely with our clients in ensuring the protection and enforcement of their IP rights in Trinidad and Tobago and throughout the Caribbean.

“None to compare in this hemisphere”

Members of:

- **AIPLA** - American Intellectual Property Law Association
- **AIPPI** - International Association for protection of IP
- **ASIPCI** - Latin American Intellectual Property Association
- **CITMA** - The Chartered Institute of Trademark Attorneys
- **INTA** - International Trademark Association
- **IPCA** - Intellectual Property Caribbean Association

**Address:** P.O. Box 116, 129-131 Abercromby Street, Port of Spain, Trinidad and Tobago  
**Telephone:** +1 868 623 4283/7 ext. 1137/1158 Fax: +1 868 623 4281  
**Contact:** Mr. Brien de Gannes (Partner): bdegannes@jdsellier.com; Ms. Ariane Ramnath (Partner): aramnath@jdsellier.com
IPR GROUP

Intellectual Property and Regulatory services in CIS countries

- 30+ years of experience
- 8000+ clients trust us
- 13 jurisdictions
- 250+ in-house IP and RA professionals

Our offices:
- Azerbaijan
- Georgia
- Kazakhstan
- Kyrgyzstan
- Lithuania
- Moldova
- Ukraine
- Uzbekistan

Main Office
72 Velyka Vasylkovska Str.,
03150 Kyiv, Ukraine
Tel.: +380 (44) 593 96 93
Fax: +380 (44) 451 40 48
pakharenko@pakharenko.com.ua

To book your firm’s position for the 2024 Global IP Directory
please email katie@ctclegalmedia.com

pakharenko.ua
United Arab Emirates

Your reliable partners for intellectual property matters in Pakistan, South East Asia, Arabian Gulf, Middle East & Africa

United Trademark & Patent Services
International Intellectual Property Attorneys
Trademark, Patent, Design, Copyright, Domain name registration, litigation & enforcement services

Head Office: (New Postal & Visiting Address)
85 -The Mall Road, Lahore 54000 Pakistan
(Opposite Ferozesons books store / adjacent radio time center)
TEL: +92-42-36285588-90, +92-42-36285581-84
FAX: +92-42-36285585, 36285586, 36285587
Email: UnitedTrademark@UnitedTm.com
Websites: www.utmps.com and www.unitedip.com

DUBAI (UAE)
Suite 401-402, Al-Hawal Tower
Sheikh Zayed Road, Dubai
Tel: +971-4-3437 544
Fax: +971-4-3437 545
Email: Dubai@UnitedTm.com

OMAN
Suite No. 702, 7th Floor
Oman Commercial Centre, Muscat
Tel: +968-24-787550, 704785
Fax: +968-24-784467
Email: Oman@UnitedTm.com

SRI LANKA
105, Hunupitiya Lake Road, Colombo 02,
Sri Lanka
Tel: +94 11 4322790-1
Email: Sri Lanka@UnitedTm.com

JORDAN (Amman)
Suite 7, 2nd Floor
Chicago Building, Al Abdal
Tel: +962-6-5853986
Fax: +962-6-5853886
Email: Jordan@UnitedTm.com

QATAR
Villa # 40, Al Amir Street
Al Mirgab Area, Doha, Qatar
Tel: +974-444 3083, 444 3093
Fax: +974-444 3311
Email: Qatar@UnitedTm.com

LEBANON
6th Floor, Suite A-Ghazal Bldg., Tabaris, Beirut, Lebanon
Tel: +961-1-21 5373
Fax: +961-1-21 5374
Email: Lebanon@UnitedTm.com

SAUDI ARABIA
Belved Malatba, Al Shawafi
30th Street-Olaya, Riyadh 11444
Tel: +966-11-4616157, 4655477
Fax: +966-11-4616156, 4622134
Email: SaudiArabia@UnitedTm.com

TANZANIA
Shauri Moyo Area, Pugu Road
Dar Es Salaam
Tel: +255-222852900
Email: Tanzania@UnitedTm.com

SHARJAH (UAE)
Suite 203, Al Bahar Building
Bahar Corniche, Sharjah
Tel: +971-6-5722742
Fax: +971-6-5727741
Email: Sharjah@UnitedTm.com

YEMEN
6th Floor
Ideal Clinic Building
Hadda Street, San'a'a, Yemen.
Tel: +967 181 9642
Email: yemen@UnitedTm.com
Any Help?

We Are Here to guide you.
Protecting your IP Rights across the Middle East

Our Services

- Patents & Trademark Commercialization
- Licensing & Franchise
- IP Due Diligence
- Brand Valuation
- Domain Names
- IP Rights Counselling

Reach Us
+971 56 936 7973
info@marksnbrandsip.com
marksnbrandsip.com

United Kingdom

Sponsored by

http://www.lslawmag.com/
WebTMS Turns 25 this year!

It's a big year for the WebTMS team who spent 25 years building a reputation as a trusted partner for IP professionals, delivering outstanding, innovative software, exceptional support, and constructive customer relationships.

Get in touch and we’ll show you how WebTMS combines intuitive design with intelligent automation to maximise efficiency for your IP team.

sales@webtms.com
www.webtms.com
Celebrating 25 years in IP Software and setting our sights on the future

It’s a big year for the team behind WebTMS. 2023 marks 25 years since we first took our award-winning trademark management software to the market. During that time, we have seen the intellectual property sector grow and change almost beyond recognition. The roles and responsibilities of trademark attorneys and paralegals have evolved, and the volume of filings has soared as globalization has opened new markets and lowered barriers to entry. Awareness of the value of IP has risen, too, leading to a corresponding rise in activities to protect brands and defend them from infringement in a market that now includes virtual, as well as geographical and online spaces.

When we first launched WebTMS, we knew that trademark management was crying out for digitization. By digitizing records and adding automatically generated data drawn from national trademark databases across areas such as renewals, filing dates and more, we could help trademark administrators work faster, improve accuracy, and lift the administrative burden.

Over time, we have evolved our software to meet the demands of our industry, always in close consultation with our clients. This means our solution truly complements the expertise of IP professionals. As those needs grow more sophisticated, solutions must keep up, so we maintain a close watch on potential applications of new technology. In our experience, the following are key features software needs to get right so it adds value and make users’ lives easier:

**Intelligent automation for efficiency and accuracy**

There’s one thing no legal professional has enough of, and that’s time. Consequently, a tool that drives efficiency – without compromising on all-important accuracy – will always be attractive.

This is where process automation comes in. Identifying the core processes involved in a task and applying automation lets tech do the heavy lifting, reduces the administrative burden and removes errors that can creep in when humans are asked to undertake repetitive tasks.

Our solutions deploy automation to support IP management processes in various ways. In our increasingly globalized workplace, we recognize that many clients are managing worldwide portfolios, so we looked for a way to use automation to make their lives simpler. Our DataSync feature, for example, allows clients to have their trademark records automatically updated from more than 180 jurisdictions in real time. This eliminates manual updating, ensuring that users’ proprietary records always reflect their official status.

Another important feature of any tool that uses automation is control. Users need full visibility over what’s being automated and the ability to audit when needed, to ensure outcomes are expected - and are therefore trusted.

**Intuitive and user-friendly**

It seems like a no-brainer that technology should be easy-to-use, but it’s surprising how often this isn’t the case. Successful software links intuitively with the process it is designed to assist, and users can see logically how to incorporate it into their workflow. This requires developers to have a strong working understanding of what their users are trying to achieve and how they have gone about this in the past.

---

Rita O’kyere, Brid Madeley and Andrew Partridge of WebTMS reminisce over the developments of the past 25 years and express their excitement for new advancements on the horizon.
One such area which is seeing rapid growth and desirability is the use of API technology to easily combine and overlay different data sets together. This can be very insightful for brand owners as it can help them highlight interesting patterns within their portfolio, or indeed help make important economic business decisions based on the powerful data they’re presented with.

Failure to get this right results in poor adoption and sees technology investment failing to deliver ROI as users continue to do things the same way they’ve always done.

Support will always be essential
Intuitive software can get you a long way, but there will always be moments when you need to get one-to-one support tailored to the problem you’re trying to solve. That’s why we believe that the facility to have responsive, informed support available when you need it should be part of any decision to invest in an IPTech solution.

Future roadmap from the team behind WebTMS
The world of intellectual property is constantly changing, which means IPTech needs to keep evolving, too. The team behind WebTMS has spent 25 years building a reputation as a trusted partner for IP professionals, delivering outstanding, innovative software, exceptional support, and constructive customer relationships that have seen client suggestions incorporated into new software features. This is in our DNA and we will be taking it forward as we continue to develop WebTMS using client feedback, market trends, and collaboration.

There are exciting innovations in AI-powered searching and brand protection solutions on the horizon, and advances in robotic process automation that can lift the admin burden even further. One such area which is seeing rapid growth and desirability is the use of API technology to easily combine and overlay different data sets together. This can be very insightful for brand owners as it can help them highlight interesting patterns within their portfolio, or indeed help make important economic business decisions based on the powerful data they’re presented with.

The intelligent application of automation and availability of advanced data analysis will free IP professionals to focus on the parts of their role that machines just can’t replace, such as designing robust and creative protection strategies and liaising with clients to understand their priorities and ambitions for their brand.

Ultimately, the aim of IPTech must be to make our users’ professional lives simpler, make them more effective in their role, and support job satisfaction. That is the goal of everything our team does, and we look forward to sharing the next phase of our journey with the clients who have been with us for 25 years, and those we’ve yet to meet.
Global expertise from a European base

Harnessing 100+ Years of Combined IP Experience

On Behalf of the World’s Best-Known Brands

Trust Locke Lord’s cross-border team of Intellectual Property lawyers in London, Brussels and 18 offices in the United States to manage, defend and enforce your IP portfolio and maximise your strategic goals, innovatively and cost-effectively.

Read about our international IP capabilities at www.lockelord.com/ipinternational.

www.lockelord.com
Attorney Advertising © 2023 Locke Lord LLP
Indochine Counsel is a leading business law firm in Vietnam, with strong IP & technology practice in Indochina, including the following:

**Intellectual Property**

We offer a broad range of services in intellectual property and IP-related matters. Our IP & Technology Practice Group assists local and international clients in creation, protection, enhancement and enforcement of their intellectual property rights in Vietnam, Laos, Cambodia and other countries through our networking with IP agents and patent firms worldwide.

- Availability searches and pre-filing advice
- Registration of trademarks, copyrights, designs and patents in Vietnam and other countries worldwide
- Assignments & renewals
- Licensing, technology transfer, franchising and IP-related contracts
- Intellectual property audits & investigations
- IP counseling and management of IP portfolios for the clients
- Passing off & anti-piracy actions
- Domain names
- Enforcement of intellectual property rights

**Technology & Media**

Our Technology & Media Practice is the most dynamic practice in the context of developments in the fast growing economy of Vietnam particularly in the IT, media and telecom industries. Indochine Counsel represents and advises technology firms, telecom companies, media & entertainment companies, internet service providers and value-added service suppliers.

- E-commerce and internet laws
- Data privacy and security
- Media & entertainment laws
- IT outsourcing agreements
- Content/production agreements
- Procurement/supply agreements for IT & telecom products and services
- IT & telecom projects

---

Head Office:  
Unit 305, 3rd Floor, Centec Tower, 72-74 Nguyen Thi Minh Khai  
District 3, Ho Chi Minh City, Vietnam  
Tel: +84 28 3823 9640  Fax: +84 28 3823 9641  
E: info@indochinecounsel.com

Hanoi Office:  
Unit 705, 7th Floor, CMC Tower, Duy Tan Street  
Cau Giay District, Hanoi, Vietnam  
Tel: +84 24 3795 5281  Fax: +84 24 3795 5262  
E: hanoi@indochinecounsel.com
ELITE LAW FIRM
Address: 255 Hoang Van Thai Street, Thanh Xuan District, Hanoi, Vietnam.
Tel: (+84-24) 37373051 Mobile: (84) 904110976
Fax: (+84-24) 37373056 Email: info@lawfirmelite.com
Website: www.lawfirmelite.com Contact: Mr. Nguyen Tran Tuyen
ELITE LAW FIRM is born to provide professional and qualified legal services in the field of Intellectual Property and Business Law in Vietnam.
ANNAM IP & LAW is one of the most professional intellectual property & law firms in Vietnam with a staff consisting of lawyers and patent and trademark agents practicing in the IP field since 1992. We provide 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. The firm also advises on corporate and business law. The firm is a member of APAA, INTA and VIPA.

CONTACT US:
3rd Floor, 72 Xuan Dieu Street,
Tay Ho District, Hanoi, Vietnam
T. (84 24) 3718 6216
F. (84 24) 3718 6217
E. mail@annamlaw.com.vn; annamlaw@vnn.vn
W. www.annamlaw.com
Reg. Address: No. 10, Lane 34, Au Co Street,
Tay Ho District, Hanoi, Vietnam

LOOKING FORWARD is more than our motto, it’s our culture
www.ferraiuoli.com
787-766-7000
Providing professional Patent Translation for over 35 years.

We specialise in:

- Prior Art
- Applications
- Claims
- Abstracts
- Litigation Documents
- Descriptions and Drawings
- and much more...

info@intonation.com
01329 828438
intonation.com

Quote ‘Global IP Mag’ for 5% discount on your first order.