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Originally formed for investment opportunities in 2006, the cohesion between Brazil, Russia, India, and China, with South Africa joining in 2010, has expanded into a geopolitical bloc advantageous to the nations involved as a result of the multilateral policies that promote mutual success. As of January 2024, the BRICS intergovernmental organization now includes Egypt, Ethiopia, Iran, Saudi Arabia, and the United Arab Emirates.

Considered the foremost geopolitical rival to the G7 bloc (comprising Canada, France, Germany, Italy, Japan, the UK, and the US) of leading advanced economies, encompassing 45% of the world’s population, the BRICS countries are certainly an influential force, and their influence on the development of IP will be no different.

CTC Legal Media brings you the BRICS Annual 2024 to update you on IP-specific updates and implications from the BRICS nations. Delving into key developments, we bring you an introduction to China’s IP transformation; advice for Russian utility models; non-use cancellation actions under new Brazilian IP Law; a guide to protection in Africa; a review of patent instruction at the EAPO; an exploration of the pitfalls in patent amendments; the position of Argentina; an update on IPRs in the UAE; the impact of joining BRICS for Egypt; and an evaluation of trade secret protection in Brazil.

With the growing influence of the BRICS nations, it will be vital to stay up to date on rules, requirements, and case law tendencies. Enjoy the issue.

Faye Waterford, Editor
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Mission statement

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

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China is a hub of innovation and opportunity, with an IP ecosystem that has developed at an astonishing pace over the past 30 years. Trademark squatting has been an issue since 1992. Over the decades, we’ve witnessed China’s IP legislation and practice transitioning to world-class sophistication. Now China is the IP powerhouse of the BRICS bloc, and the country is stating its ambitions for IP leadership in the wider world too.

China is currently ramping up efforts to ensure that IP protection is a central part of its new development strategy. Following the approval of its 14th Five Year Plan in 2021, the Chinese government has released a 15-year plan for developing the country into an Intellectual Property leader. According to the plan, by 2025 China aims to have-improved the value of its patent-intensive industries to 13% of GDP and its copyright industries to 7.5% of GDP. The country wants its IP system to be among the best in the world. The country’s IP system is then set to be a complete framework for multi-level participation and international cooperation in the global governance of IP. To support the speed of this development, China has amended and enacted a number of IP-protection laws in trademarks, patents, competition, eCommerce, trade secrets, and more. With these new laws – and more on the horizon – IP protection in China has improved significantly in recent years.

China improves trademark protection from registration to enforcement

For a long period, the key focus of China’s trademark authorities was to tackle the bad-faith trademark squatters that have traditionally plagued the country’s trademark registration system. While challenges persist, the China National Intellectual Property Administration (CNIPA) has made significant progress in its efforts to crack down on these bad-faith filings. Based on statistics from CNIPA annual reports, the overall supporting rate of registry enforcement actions has increased year by year. For example, the supporting rate of opposition increased from 40.8% in 2018 to 56.1% in 2022. The supporting rate of invalidation has consistently been above 70% over the past four years, with a peak of 79.5% in 2022.

The CNIPA has also had success in rejecting bad-faith trademark applications. Just over two million trademarks were registered in 2023 – a drop of more than 45% compared to a year earlier. This was the result of a reduction in applications filed by both bad faith and legitimate applicants. Bad faith applicants are severely discouraged by the government’s restriction measures, while legitimate applicants see laws need to file a large number of defensive applications.

Market enforcement in China has also improved significantly. Administrative enforcement actions via local government authorities are typically considered the most cost-effective approach for resolving market infringements. These authorities have traditionally been most inclined to act when cases are straightforward. But in recent years officers have started taking on more difficult cases too.

Market supervision departments across the country have witnessed a rise in the number of trademark infringement cases investigated. From 31,000 in 2019 to 37,500 in 2022. At the same time, the overall value of these cases has increased within a three-year span, reaching an impressive CNY 1.4 billion in 2022. Such figures highlight the growing magnitude of these cases and underline the Chinese government’s attitude to fighting IP infringement.

Civil litigation remains the main tool to crack down on complex infringement and claim damages. To bring IP-infringement cases to trial, China has established four IP Courts, one IP Chamber in the Supreme People’s Court (SPC), and 27 specialized IP Chambers in local courts.

The nationwide number of newly filed first-instance Intellectual Property civil cases rose by almost 95% between 2018 and 2023. The peak was reached in 2021 when more than 550,000 cases were recorded. Notably, two to three times higher damages are now being granted to brand owners than in earlier times. Punitive damages of up to five times the compensation against bad faith infringers have also been widely applied by local courts.

The vicious suits raised by bad faith parties to attack legitimate brand owners are now hard to win as courts will examine trademark rights were acquired. This trend has upset bad faith filers from pirating other parties’ trademarks or from trying to sue legitimate brand owners.

The positive impact of eCommerce enforcement

There has also been a shift in the approach taken by China’s popular eCommerce platforms, which play a vital role in IP protection in China. In earlier days, these online platforms often viewed complaints on absolute grounds based on two primary reasons: lack of distinctiveness and misleading issues. There has also been an increase in refusals based on the potential negative social impact of a trademark. Together these refusals seem to be an effective attempt at slimming China’s overcrowded trademark register, which already has more than 44 million marks.

The mark Kim’s Kitchen was rejected due to the fact that the brand owner also provided other services beyond restaurants, such as running day-care establishments. In another example, the trademark for teas of the world was rejected for using the slogan: “The finest teas of the world” and the slogan: “The finest teas of the world”. This was deemed to be misleading to Chinese consumers.

It should be noted that if a mark is deemed as misleading in China, it’s very difficult to overturn the decision. The success rate is less than 20%

The mark for the streetwear brand MLGB was not allowed to register by the Chinese authorities. This makes online enforcement the quickest of all enforcement solutions for removing online infringements. The typical timeframe is between three and 15 working days.

A brand owner can simply notify a platform with preliminary evidence against a seller’s infringement. The platform then communicates the complaint to the seller for clarification. Failure to provide a reasonable explanation or a counterargument to the infringement claim may lead to the platform taking down the products to avoid the joint liability of infringement.

How to avoid absolute-gounds refusal during trademark registration

Despite much progress in developing its framework for IP protection, challenges remain with registering trademarks in China. Standards have in fact become much stricter in recent years.

The CNIPA commonly refuses trademark applications on absolute grounds based on two primary reasons: lack of distinctiveness and misleading issues. There has also been an increase in refusals based on the potential negative social impact of a trademark. Together these refusals seem to be an effective attempt at slimming China’s overcrowded trademark register, which already has more than 44 million marks.

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The same refusal rate is present for any marks containing words with a sexual or immoral connotation. The MGB streetwear brand was not allowed to register, for example, as the name coincides with the initials of a commonly used four-letter vulgar term in the Chinese language.

In the fast lane: an introduction to China’s intellectual property transformation

Already the IP powerhouse of the BRICS bloc, China now has an ambitious goal of global IP leadership. Flora Fang of Rouse and Robert Zang of Lusheng look at how the country is developing its IP landscape to achieve this vision.
China’s IP transformation

As local counsel, Rouse typically assesses the risk of rejection and advises its clients accordingly before they file an application. If there is a risk, it may be better not to file an application at all. This is because a rejection creates a public record. Local enforcement authorities may then use this data against the use of a mark that has been rejected on absolute grounds.

Patent examinations aligned with international standards

One of China’s key strategic goals is the promotion of innovation as a means of ensuring sustainable economic development. In this context, the country amended its patent law in June 2021 and joined the Hague Agreement Concerning the International Registration of Industrial Designs in May 2022. The aim is to provide more comprehensive protection in alignment with international practices.

China introduced partial design and prolonged the protection duration of a design patent from 10 years to 15 years in order to align with the Hague Agreement. This alignment also provides increased protection scope and a longer duration for patent owners.

In addition, China has introduced an ‘open licence’ system. With this, a patentee makes a statement to the CNIPA that anyone wishing to implement the patented subject matter can obtain a licence to do so by paying the prescribed licence fee. This system will encourage technology transfer and the use of patented technology to the benefit of both patentees and potential licencees.

A copyright-protection system that keeps pace with the times

China’s copyright industry has also recently flourished and achieved significant results.

The year 2021 marked the 70th anniversary of the implementation of the Copyright Law of the People’s Republic of China. This newly amended Copyright Law – which came into force on 1 June 2021 – aims to solve the outstanding problems in practice, improve the definition of works and the means of enforcement, and better balance the interests in the dissemination of works. It also aligns China with the international conventions, laws, and regulations to which the country has acceded.

It has now become a basic consensus in China to strengthen IP protection and increase the cost of infringement. The country’s newly amended Copyright Law has raised the maximum statutory damage from CNY 500,000 to CNY 5 million, setting a minimum statutory damage of CNY 500.

The country’s newly amended Copyright Law has raised the maximum statutory damage from CNY 500,000 to CNY 5 million, setting a minimum statutory damage of CNY 500

Résumés

Flora Fang is a Senior Manager at Rouse’s office in China. Flora has been practicing IP laws for over 12 years. She advises on a wide range of IP issues, in both contentious and non-contentious matters, including filing applications, oppositions, cancellations, reviews, availability searches and clearance opinions, renewals, infringement opinions, and overall IP protection strategies for both domestic and foreign companies. In particular, she has handled the IP portfolios of a range of US (and EU) MNCs in the technology, pharmaceuticals, life sciences, FMCG, and retail industries.

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Particularities of Russian utility model applications

Elena L. Davydova, Deputy General Director and Chief of Inureka’s IP Protection Department, explains the advantages and disadvantages of filing for patent utility model protection for both Russian and foreign applicants with clarifications of what is and is not permissible.

For the last few years, there has been growing interest in patenting utility models in Russia among our foreign clients. It is not surprising since the process of obtaining a utility model patent and a patent for a utility model itself have a variety of advantages. Nevertheless, there are a lot of pitfalls that should be taken into account by the applicants who are thinking about filing applications for utility models with the Rospatent. In this article, I will assess the advantages and disadvantages of Russian utility models and the particularities of their preparation and examination to make the decision process of whether to apply for a utility model or to prefer an invention application easier for foreign applicants.

Needless to mention the official fees for filing and substantive examination of utility models are much cheaper than the official fees for inventions, and examination of utility models is faster and simpler than the examination of applications for inventions. These matters will be regarded further; but there are some important points that should be taken into account by applicants prior to filing utility model applications with the Rospatent.

First of all, a potential applicant should be aware that in Russia only a single device/apparatus/machine can be protected as a utility model, neither a machine as a whole nor a system nor a substance is accepted to be an object matter of a Russian utility model.

In order to make it clearer for potential applicants what can specifically be protected as a utility model in Russia, it is helpful to review some quotations from the Russian regulatory documents. According to Item 35 of the Rospatent’s Requirements to Document a Utility Model Application “thereafter the Requirements” “1. Devices are considered to be products that consist of one (or more) parts which are interconnected by assembly operations and being in functional and structural unity (assemblies units). Whether the functional and structural unity is confirmed or not is determined during examination and based on the content of the description of a utility model. Written that, mention of such elements as a body, and providing the information that the rest of the elements are fixed inside the body or at least in-serted into it, contribute to the recognition of the disclosed technical solution to be a single device. On the other hand, providing information that some elements communicate with other elements via Wi-Fi, cloud, remote communication channels, or the like causes the claimed solution not to be considered as a single device. Consequently, again in accordance with the requirements Item 35 item 1 - the following features are used to characterize devices:

- Presence of one detail, its shape, structural concept,
- Presence of several parts (details, components, as-
  sembles, blocks) connected to each other by assembly
  operations, including screwing, joining, riveting,
  welding, soldering, pressure testing, expansion, glu-
  ing, and stitching that ensure construction unity and
  implementation of a general functional purpose of
  the device (functional unity),
- Constructive implementation of the device parts (de-
  tails, components, assemblies, blocks) characterized
  by the presence and functional purpose of the device
  parts, their mutual arrangement.

• Parameters and other characteristics of device parts
  (details, components, assembling, blocks) and their
  interconnections;
• Material from which parts of the device and/or the
  device as a whole are made;
• Physics medium that performs the function of a part
  of the device (1).”

Thus, there can be only one object matter claimed in the scope of a utility model application. In other words, the Claims of a utility model must contain the only independent claim and the number of dependent claims is limited, which is not allowed to include any alternatives. This is because, according to Item 41 of Rospatent’s “Rules for Drafting, Filing, and Examination of Utility Models Documents,” if the independent claim of a utility model contains alternative features, it means there is more than one technical solution in the independent claim of a utility model. Such a dependent claim can be divided into several dependent claims, because the presence of several dependent claims that are alternative to each other is not prohibited in the Claims of a utility model.

Another subtlety is that, at the moment of filing applications, each additional claim over the 10th claim in the Claims of a utility model results in an additional official fee, while an increase in the number of claims of the Claims when responding to the Office Action does not require payment of additional fees. Thus, the problem of alternatives in dependent claims is solved quite easily.

One more important point, which should be taken into account by a potential applicant that is going to file a utility model in Russia, is that according to the Requirements, Item 35 item 17 “/...while disclosing the essence of a utility model, one technical result provided by the utility model or technical results associated by a cause-effect relationship should be indicated.” Therefore, if the relevant section of the description of a utility model (which normally follows the wording of the essence of the utility model) contains an indication of several technical results that are not associated with a cause-effect relationship, the examiner will issue an Office Action demanding to specify the technical result or results of the Claims of a utility model, and even disproves the novelty of some dependent claims. It might be that the technical result claimed in the pending application is also achieved by a technical solution disclosed in the opposed document, then the examiner’s arguments can be overcome by including in the independent claim those features of dependent claims or those features mentioned only in the description that are not known from the document opposed by the examiner, but the matter of the technical result will arise again. Indication of a new technical result that was not mentioned in the description...
Russian utility model application

Whether the functional and structural unity is confirmed or not is determined during examination and based on the content of the description of a utility model

Résultés
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Table 1

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<th>Utility Models</th>
<th>For filing an application</th>
<th>For substantive examination</th>
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<td></td>
<td>150</td>
<td>+ 1000 for each claim over the 1st</td>
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<tr>
<td>Inventions</td>
<td>2310</td>
<td>+ 1000 for each claim over the 1st</td>
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Under the Paris Convention When a utility model is filed under the Patent Cooperation Treaty (PCT) as well as under the Paris Convention, a certified copy of the priority document must be provided in paper form, but a paper copy of the priority document can be filed later after filing an application at no charge. In view of the above, if an applicant has an application containing just one independent claim (no matter how many dependent claims) where the object matter is a device, apparatus, or machine, it may be better to file such an application as a utility model, not as an invention, despite the validity period of utility model patents is shorter (by 10 years) if compared with the validity period of invention patents, that is 20 years.

The short validity period of utility model patents, of course, is another disadvantage. Nevertheless, utility model patents can be effective instruments used in litigation cases for the protection of your clients' intellectual properties in Russia. One of our clients has recently received compensation in the amount of more than one million rubles paid by an infringer of our client's utility model patent.

Even in the case where a patent holder finds evidence of patent infringement after the utility model patent expires but the patent infringement has been made during the time of the patent validity, the patent holder still has the right to initiate a court trial against an alleged infringer and to claim compensation. In conclusion, and in order to sum up all the above, I would like to note that it is obvious that, despite having a lot of particularities, patenting utility models in Russia looks quite attractive and has certain advantages for Russians as well as for foreign applicants.
An overview of non-use cancellation actions under Industrial Property Law 9,279/97

Igor Simoes and Georgia Chicoski of Simoes IP Law Firm provide a comprehensive overview of Brazilian Industrial Property Law, exploring nuances, legitimate justifications, and recent legal updates.

Trademark cancellation stands as a vital legal process, ensuring the integrity of Brazil's industrial property landscape. Non-use cancellation is a mechanism designed to emphasize active utilization of trademarks, by specific articles within Industrial Property Law 9,279 (IPL). Brazil's approach to trademark cancellation is multifaceted and continually evolving. This comprehensive overview delves into the intricacies of Brazilian IPL, exploring the nuances of non-use cancellation actions, legitimate justifications for non-use, recent legal updates, and recent case law.

Understanding these complexities is essential for trademark owners navigating Brazil's intellectual property landscape, ensuring their trademarks retain legal standing and competitive edge in the market.

Brazilian IP law on trademark cancellation

Trademark cancellation refers to the legal process through which a trademark registration can be ordered invalidated. In Brazil, trademark cancellation finds its legal base in Articles 142-146 of IPL. The initial steps of trademark cancellation actions fall under the competence of the administrative sphere, overseen by the Brazilian Patent and Trademark Office (BPTO). A second instance, it may be taken to the courts. This process is essential to maintain the integrity of the trademark system, ensuring that registered marks are used in compliance with the law.

Technical Note No. 03/2022 – updates on the non-use cancellation action procedure

The BPTO recently introduced significant updates to the non-use cancellation action procedures through Technical Note No. 03/2022. The technical note delineates the meticulous evaluation criteria used in the process. According to the document, the first step of the analysis involves the consideration of admissibility requirements for petition acceptance, coupled with an in-depth assessment of the requester's legitimacy. In this regard, legitimacy may rely on prior rights or the anticipation of rights, notably, existing registration or pending application for a similar trademark intending to identify related products. The same applies to the registration or application for a geographical indication, a highly renowned mark, or an industrial design reproduced by the trademark facing potential cancellation. In addition, personality rights and copyright are also incorporated into this scope.

Investigation of legitimate reasons

In light of the provisions established by the technical note, legitimate reasons for non-use are those characterized by situations of force majeure and conditions beyond the owner's control. Scenarios such as business restructuring and brand repurposing, or economic, financial, and commercial difficulties associated with such changes, do not qualify as legitimate grounds for the lack of trademark use. According to the BPTO, these factors do not excuse the absence of active use of the registered trademark.

Investigation of effective use

The inquiry into the trademark's usage extends over a five-year period preceding the action for cancellation. Any kind of evidence admitted in law may be presented, such as invoices, advertising material, and business proposals. For such documents to be admissible, they must be issued by the registered owner or licensee, with proof of proper licensing or authorization for use. Furthermore, it is imperative that the trademark featured in the documents provided as evidence of use is unaltered, preserving its original distinctive character as delineated in the official registration certificate. Any modifications that could potentially compromise the trademark's distinctive features, as stated in the registration documentation, may lead to invalidation of the presented evidence.

To sustain effective usage, it must align with the primary purpose of trademarks, which is ensuring consumers can readily identify the origin of a good or service, by providing distinction between those of other origins. Substantiation requires the use to be both public and effective, involving identification in commercial activities. For that matter, private or internal usage within a company does not qualify as effective use. Furthermore, the trademark must be applied to goods or services currently available to consumers or circulating in the market, excluding mere preparatory activities like label printing or packaging development from the scope of commercial use.

As assured by law, any person with legitimate interest is allowed to request a cancellation by non-use.
In the case of jointly owned trademarks, the burden falls on every co-owner to prove that the stated reasons justify the non-utilization.

**The case law**
The assessment of non-use cancellation involves a careful examination of the documents and arguments presented by the holder of the trademark registration. Following a comprehensive examination, a trademark can be either fully or partially canceled or, alternatively, the action can be rejected, depending on the evidence provided by the owner.

Partial cancellation is declared when usage for the period under examination is unverified or non-use is inadequately justified for specific goods or services. In such instances, only those particular items within the specification are canceled, preserving the validity for other designated goods or services.

Decisions issued by the BPTO with respect to cancellation requests are subject to appeal to a second instance at the BRPTO. From the date of the decision, the beneficiary of the registration becomes vulnerable to cancellation due to non-use.

To mitigate this risk, it is advisable, when possible, to register a word mark, like a company or product name, instead of solely a design or composite mark. Word marks are generally more stable over time, even after rebranding. The BPTO examiners also accept various presentations of a word mark as evidence of use. Applicants can freely alter the font, style, color, and other aspects of their word mark while still adhering to the requirements set by the BPTO. This approach ensures greater flexibility for companies to adopt their branding to new market tendencies while maintaining the integrity of their trademark registration.

**Case law on non-use cancellation action**

The Superior Court of Justice (STJ) in Brazil acts as the final court for non-constitutional cases, ensuring consistent interpretation of federal laws nationwide and providing fundamental principles for various legal matters. Despite the presence of robust legislation and the dedicated entity like the BPTO, in exceptional circumstances, issues related to industrial property rights find their way to the STJ. Evidently, the STJ’s rulings stand as pillars of legal precedent, directing the application and enforcement of Industrial Property Law (IP) in Brazil.

In November 2022, the Third Chamber of the Superior Court of Justice (STJ) unanimously annulled three registrations related to the PERMABOND trademark, understanding that the owner acted in bad faith by requesting the expiration of the trademark and then registering it for his own benefit.

The case involved Permabond LLC, a foreign company, filing a lawsuit against the owner and his Brazilian company, PermabondAdesivos Ltda. The owner had initially requested the expiration of the trademark and then promptly registered it for personal gain. The foreign company claimed that the owner had previously worked for the company, which would demonstrate that the registration of the expired trademark by the former employee constituted customer diversion and unfair competition.

The STJ decision hinged on the fact that Permabond LLC was the original owner of the trademark in Brazil until 2006. However, they failed to utilize it in the country and did not seek an extension of the registration within the legal timeframe, leading to its expiration. The former employee, having prior knowledge of this trademark, attempted to exploit the idea commercially by registering it for his own use. The STJ judged it as a clear act of bad faith, given a high likelihood that the PERMABOND trademark in Brazil could be easily associated with the same mark used internationally.

As stated by Minister Ricardo Villas Bôas Cueva, such actions violated Article 144, items V and XXIII, of the Industrial Property Law and Article 103 of the Paris Convention. Cueva further emphasized that the law not only protects highly reputable trademarks, but also guards against the registration of trademarks that imitate distinguishing elements of other businesses, even if they lack immediate renown in the local market.

As evidenced in the aforementioned case and by many other examples from the recent legal scenario, non-use cancellation action is a widely applied strategy to cancel prior registrations that may be hindered by the requirements set by the BPTO. This approach ensures greater flexibility for companies to adapt their branding to new market tendencies while maintaining the integrity of their trademark registration.

Despite a robust industrial property law, judicial decisions often prevail, overruling the provisions established by the IPI and the standard processes within the BPTO. In this regard, specialized IP assistance plays a fundamental role in supporting owners through legal procedures. Intellectual Property agents are well versed with the IP laws in the national and international framework, having expertise in anticipating risks and elaborating effective strategies. Guided by professional legal advice, owners have more chances to succeed in safeguarding their trademarks’ integrity in the market.

Upon the BPTO’s issuance of Technical Note No. 03/2022, the non-use cancellation action procedures saw a significant enhancement in the depth of analysis conducted upon evidence of use. Trademark holders must be acutely aware of these changes, as adhering to the updated guidelines is paramount for safeguarding trademarks in the evolving legal landscape of Brazilian industrial property law.

This nuanced approach motivates trademark owners to maintain genuine and consistent use of their marks, while also protecting their rights by recognizing legitimate circumstances that may impede such use. The non-use cancellation action in Brazil serves as an essential mechanism to uphold the integrity and functionality of the trademark system, promoting a healthy and competitive marketplace.

Much has still to come in the analysis of non-use cancellation actions in Brazil and the BPTO’s decisions or rules must be updated, bearing in mind that the case law and the courts will always be an important source of information.

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**Résumés**

Igor Simoes, Managing Partner

With over 25 years’ experience, Igor is the managing partner of Simoes IP Law Firm, having graduated in Chemical Engineering from Fluminense Federal University (UFF) and in Law from Candido Mendes University. He is also an Industrial Property Agent, registered before the Brazilian Patent and Trademark Office (IBPTO) since 2002.

Igor has knowledge in all areas of Intellectual Property, demonstrating extensive experience in litigation before Brazilian State and Federal Courts, as well as in all administrative petitions before the IBPTO. His practice also involves prior art searches, and technical and legal consultancy in IP, focusing on patents, industrial designs, trademarks and copyrights, and software.

Georgia Chicoski, Patent Specialist

With a Bachelor’s Degree in Chemical Engineering from Fluminense Federal University (UFF), Georgia worked at one of the largest companies in the Brazilian water supply sector. At Simoes, she began her journey as an intern in the technical sector and today is an associate.

With courses focused on Intellectual Property and Software registration, Georgia works in the analysis and preparation of technical responses to client’s requests, and in the administrative procedures of patents and trademark cases before the IBPTO.

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A guide to protecting your IP in Africa

Bastiaan Koster, Partner at Von Seidels, provides a breakdown for filing in Africa, including specific advice for the BRICS nation South Africa, to assist companies in achieving their commercial goals in the continent, which is expected to experience a significant growth spurt.

When asked about looking at Africa as a potential market in their intellectual property strategy, many foreign IP rights owners reply that Africa is big, complex, and somewhat of an unknown entity, and they find it challenging to decide where to file and what approach to use.

Africa is huge. It has a land area of 30.3 million sq km (11.7 million sq mi). This is the land area of the United States, China, India, Japan, Mexico, and many European nations, combined.

The African continent has a population of over 1.4 billion people which is growing at an average of 2.5% a year and it has 58 countries including surrounding islands. The political situations in some African countries are not always stable, and in some poverty is a problem. But there is a flip side to this coin.

The United Nations predicts that Africa’s population will grow to 2.5 billion by 2050. There are 331 million people in Africa who are middle-class according to the African Development Bank (AfDB). Africa therefore has the fastest-growing middle-class population in the world. It is a continent with abundant resources and farming opportunities. Experts predict Africa will become the breadbasket of the world. A number of countries in Africa are among those with the fastest economic growth rates in the world.

All of this will result in increasing the buying power of consumers in Africa. The continent therefore becomes a very attractive foreign investment opportunity and potential market for goods and services, notwithstanding some of the challenges.

For foreign businesses wanting to embrace Africa, outlined below are some of the commercial realities and practical considerations for filing IP rights in Africa.

Key countries and insights
South Africa has a well-developed legal system where intellectual property rights can be and are often enforced. IP litigation in many other African countries does not happen that frequently.

The enforcement angle has the potential to become a negative factor for foreign companies exploiting the potential of South Africa and Africa. A better approach may be to look at it from a commercial perspective. In this regard the following insights are relevant about South Africa and the rest of Africa.

South Africa has been labelled the most advanced and diversified economy in Africa. While this may still be true there are various important factors about other African countries that must be considered including the size of their economy, how fast they are growing and their key industries.

The table below shows some key facts on the 10 largest economies in Africa.

In the latest predictions by the International Monetary Fund (IMF), South Africa is set to overtake Nigeria in 2024 and reclaim its position as Africa’s largest economy with a GDP of $401 billion. Nigeria is expected to be Africa’s second-largest economy with $395 billion GDP and Egypt third largest with $358 billion GDP. Africa is the world’s fastest-growing continent. Its 10 fastest-growing economies can be seen in table 2.

But what do foreign IP owners do with these facts and figures?

The real commercial question is therefore not necessarily what is going on in Africa right now, but what is likely to develop over the short and medium term.

The protection of intellectual property in Africa should be considered slightly differently from a trademark perspective and a patent perspective.

Let’s look at trademarks first
There is huge potential in the increasing buying power of Africa for consumer goods. And consumer brand owners interested in selling goods and services in Africa’s 1.4 billion consumers will have to compete in that market. It therefore makes sense for brand owners who are doing business in Africa or who intend on selling their products in Africa in the future to look at trademark protection. A logical guideline will be to look at the countries with larger economies by GDP per capita and larger populations.
The real commercial question is therefore not necessarily what is going on in Africa right now, but what is likely to develop over the short and medium term.

The main question then is where to start. Start in the countries in which the company is currently doing business, wants to do business, or will sell products in the future. But what if the company does not know these answers yet?

Many international companies wishing to expand into Africa start by filing patents or trademarks in South Africa as it is generally considered to be the gateway to Africa due to its geographic advantages and logistics infrastructure. The filing costs are also reasonable and the enforcement of patents and trademarks are effective.

Résumés
Bastiaan Koster is a partner, patent attorney and trademark practitioner at African intellectual property law firm, Von Seidels. He has extensive experience in South African and international IP matters including IP registration, strategy and commercialisation to gain a competitive edge. He has a long-standing involvement in IP associations and committees. He is a regular speaker on the IP landscape and opportunities in Africa at international IP conferences and regional summits including BRICS.

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Sources: African Development Bank (AfDB), IMF, UN, CIA (2023)

Table 2

<table>
<thead>
<tr>
<th>Country</th>
<th>Growth rate</th>
<th>GDP (US$)</th>
<th>Population (M)</th>
<th>Area (sq km)</th>
<th>Industries</th>
</tr>
</thead>
<tbody>
<tr>
<td>Rwanda</td>
<td>8.3%</td>
<td>13 billion</td>
<td>11 million</td>
<td>263,530</td>
<td>Textiles, food processing, tourism, chemicals, pharmaceuticals, hydrocarbons, construction, cement, metals, light manufactures.</td>
</tr>
<tr>
<td>Ivory Coast</td>
<td>8.3%</td>
<td>42 billion</td>
<td>32 million</td>
<td>322,463</td>
<td>Agriculture, food processing, construction, cement, materials, electricity.</td>
</tr>
<tr>
<td>Benin</td>
<td>5.2%</td>
<td>6 billion</td>
<td>10 million</td>
<td>113,262</td>
<td>Textiles, food processing, construction, materials, cement.</td>
</tr>
<tr>
<td>Uganda</td>
<td>5.4%</td>
<td>10 billion</td>
<td>4 million</td>
<td>77,400</td>
<td>Sugar processing, beverages, tobacco, cotton textiles, cement, steel production.</td>
</tr>
<tr>
<td>Tanzania</td>
<td>5.2%</td>
<td>8 billion</td>
<td>5 million</td>
<td>945,050</td>
<td>Agriculture processing (sugar, beer, cigarettes, sisal), mining (diamonds, gold, and iron), salt, soda ash, cement, oil, gold mining, textile, fertiliser.</td>
</tr>
<tr>
<td>Kenya</td>
<td>5.0%</td>
<td>47 billion</td>
<td>45 million</td>
<td>582,650</td>
<td>Agriculture, transportation, cement, manufacturing, construction, telecommunications, tourism, retail.</td>
</tr>
<tr>
<td>Togo</td>
<td>4.6%</td>
<td>2 billion</td>
<td>8 million</td>
<td>56,789</td>
<td>Phosphate mining, agricultural processing, cement, handtrucks, textiles, beverages.</td>
</tr>
<tr>
<td>Senegal</td>
<td>4.6%</td>
<td>36 billion</td>
<td>13 million</td>
<td>1,325,371</td>
<td>Agricultural and fish processing, phosphate mining, fertilizer production, petroleum refining, zinc, iron and gold mining, construction materials, ship construction, ship repair.</td>
</tr>
<tr>
<td>Madagascar</td>
<td>4.0%</td>
<td>33 billion</td>
<td>1 million</td>
<td>2,593,000</td>
<td>Meat processing, seafood, soap, beer, leather, sugar, textiles, glassware, cement, automobile assembly plant, paper, petrol, tourism, mining.</td>
</tr>
<tr>
<td>Algeria</td>
<td>3.8%</td>
<td>26 billion</td>
<td>8 million</td>
<td>2,381,741</td>
<td>Petroleum, natural gas, light industries, mining, electrical, petrochemical, food processing.</td>
</tr>
</tbody>
</table>

Sources: African Development Bank (AfDB), IMF, UN, CIA (2023)

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<th>Industries</th>
</tr>
</thead>
<tbody>
<tr>
<td>Egypt</td>
<td>5.8%</td>
<td>388 billion</td>
<td>85 million</td>
<td>1,001,450</td>
<td>Textiles, food processing, tourism, chemicals, pharmaceuticals, hydrocarbons, construction, cement, metals, light manufactures.</td>
</tr>
<tr>
<td>Nigeria</td>
<td>5.2%</td>
<td>380 billion</td>
<td>203 million</td>
<td>356,663</td>
<td>Textiles, food processing, beverages, leather, garments, chemicals, metals processing, cement, construction, telecommunications.</td>
</tr>
<tr>
<td>South Africa</td>
<td>5.0%</td>
<td>320 billion</td>
<td>55 million</td>
<td>1,221,094</td>
<td>Steel production, petroleum refining, zinc, iron, salt, soda ash, cement, oil refining, shoes, apparel, wood products, fertiliser.</td>
</tr>
<tr>
<td>Algeria</td>
<td>5.0%</td>
<td>12 billion</td>
<td>2 million</td>
<td>210,518</td>
<td>Petroleum, natural gas, light industries, mining, electrical, petrochemical, food processing.</td>
</tr>
<tr>
<td>Ethiopia</td>
<td>4.6%</td>
<td>126 billion</td>
<td>8 million</td>
<td>1,103,784</td>
<td>Food processing, beverages, textiles, leather, garments, chemicals, metals processing, cement, construction, telecommunications.</td>
</tr>
<tr>
<td>Morocco</td>
<td>5.4%</td>
<td>147 billion</td>
<td>37 million</td>
<td>443,056</td>
<td>Automotive parts, phosphate mining and processing, aerospace, food processing, leather goods, textiles, construction, energy, tourism.</td>
</tr>
<tr>
<td>Kenya</td>
<td>4.5%</td>
<td>125 billion</td>
<td>42 million</td>
<td>582,650</td>
<td>Agriculture, transportation, services, manufacturing, construction, telecommunications, tourism, retail.</td>
</tr>
<tr>
<td>Angola</td>
<td>4.1%</td>
<td>31 billion</td>
<td>2 million</td>
<td>809,353</td>
<td>Petroleum, diamonds, iron ore, phosphates, sapphires, bauxite, uranium, and gold, cement, basic metal products, fish processing, food processing, brewing, tobacco products, sugar, textiles.</td>
</tr>
<tr>
<td>Tanzania</td>
<td>4.0%</td>
<td>57 billion</td>
<td>47 million</td>
<td>945,050</td>
<td>Agriculture processing (sugar, beer, cigarettes, sisal), mining (diamonds, gold, and iron), salt, soda ash, cement, oil, gold mining, textile, fertiliser.</td>
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<td>Foodstuffs, beverages, wood products, oil refining, gold mining, textiles, fertilizer, building materials, electricity.</td>
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Sources: IMF, UN, CIA (2023)
A brief introduction to the Eurasian patent and its advantages

The “Single Window” principle is, of course, the main advantage: it is possible to file a single application in Russia with the assistance of one Eurasian Patent Attorney in order to cover the countries of the entire region.

Secondly, the Eurasian procedure is very flexible: a Eurasian patent is valid once granted in all Member States; however, it is possible to maintain the patent only in countries of business interest to the Applicant.

Some offices of EAPO Member States are unable to employ a large staff of examiners in highly specialized fields. For example, the EAPO and the Kyrgyz patent signed an Agreement on cooperation in the field of information search and examination of patent applications in October 2023. Pursuant to this Agreement, the EAPO will conduct patent searches and prepare international search reports in the fields of technology defined by the parties. Such cooperation is a step towards the formation of a common Eurasian information and examination space.

The EAPO employs the best and most professional examiners from all Member States to ensure the highest quality of the examination and international searches. The EAPO has been functioning as an International Searching Authority since June 1, 2022, which confirms the quality of work.

The EAPO is constantly working on the improvement of examination quality and the implementation of best practices.

Summary of additions to patent procedures

The main innovations introduced to EAPO procedures relate to:

- Providing digital 3D models with the Eurasian applications documents;
- Changes to the deadlines for filing objections and appeals;
- Optimization of procedures for receiving patents for inventions and industrial designs.

Such cooperation is a step towards the formation of a common Eurasian information and examination space.

We are glad to provide more information on each innovation below. If you have any questions or inquiries on IP matters in EAPO, Russia, Armenia, and other Eurasian countries, Patent and Trademark Attorneys of Vakhnina and Partners will be pleased to assist you.

3D models

It is now possible to include 3D models of the claimed objects in a Eurasian patent application. The innova-
tion concerns both inventions and industrial designs. This innovation is considered the most significant change to the Patent Instruction. Applicants now have the option to file digital 3D models in relation to Eurasian applications for inventions and Eurasian applications for industrial designs.

The use of 3D models in relation to inventions and industrial designs is an important step for modern digital technologies in patent practice. This innovation will allow the applicants to use the advantages of 3D visualization for additional explanation of the essence of claimed inventions and further visual presentation of the appearance of products.

The decision to begin accepting 3D models of the claimed objects by the EAPO for Eurasian patents for inventions or industrial design filings was made at the 42nd meeting of the Administrative Council of the EAPO in September 2022.

The President of the EAPO, Dr. Grigory Ivliev, has commented on the innovation: “This innovation will greatly simplify the process of filing a Eurasian application and obtaining a Eurasian patent for the applicants. Applicants will have more opportunities to demonstrate the claimed objects, and this will facilitate the process of examination and preparation of a decision for the EAPO examiners. Consequently, the time of prosecution of a patent will be reduced which will result in speeding up market entry. This is specifically important in relation to industrial designs, appearance of products. This innovation becomes even more called for since the demand for granting of a Eurasian patent for industrial designs active in the territory of EAPO member states has doubled in a year.”

Increase of the time limits for filing of appeals and objections

The time limits for filing an objection against granting of a Eurasian patent for an invention in accordance with rule 53(10) of the Patent Instruction and an appeal against invalidation of a Eurasian patent for an industrial design in accordance with rule 126(10) of the Patent Instruction are extended.

The deadline for filing such objections will be nine months from the date of publication of information on granting of a Eurasian patent for an invention or a Eurasian patent for an industrial design, respectively.

Amendments to the grant procedure of a Eurasian patent

The additions and clarifications made to Part I, “Inventions”, of the Patent Instruction relate to the procedures for receiving a Eurasian invention patent and are intended to optimize the entire prosecution process.

The changes to the procedure of grant now allow introduction amendments in the claims until the notification of grant allowance is issued and forwarded to the applicant.

Industrial Designs

The additions made to Part II, “Industrial Designs”, of the Patent Instruction expand the list of checks carried out in relation to the claimed industrial design at the substantive examination stage. The changes expand the methods to exclude elements of the appearance of the product for which the applicant does not claim legal protection.

In addition, there is now no need for the applicant to provide a paper copy of the previous application if such application is available to the EAPO through the WIPO Digital Access Service for Patent Documents (WIPO DAS).

Patent and Trademark Attorneys of Vakhnina and Partners will be pleased to assist you and your clients, if you have any questions or inquiries on IP matters. Our specialists in Moscow (Russia, ip@vakhnina.com) and Yerevan (Armenia, office@vakhnina.am) offices are ready to provide more information on your request.
Navigating the pathways of patent applications can be daunting. While novelty and inventive step of a patent usually dominate the spotlight, there is a lurking detail that often slips through the cracks but can make or break your application: “going beyond the scope of the original disclosure.”

This article will analyze the matter of “going beyond the scope of the original disclosure” from various perspectives, including the legislative intent and the timing of amendments. We will also illustrate the practice determination standards with actual cases to offer you a reliable guide to champion future patent prosecution and invalidation procedures.

The patent system seeks a balance between patentees and the public, aiming to encourage innovation and provide inventors with their due monopoly, but never at the cost of public interest. While the Patent Law of the People’s Republic of China (hereinafter referred to as Patent Law) does permit amendments, it wraps them in strict constraints. This is the legislative intent behind the legal provisions on the restriction of amendments.

The patent system operates on a quid pro quo principle: “protection in return for disclosure.” If applicants were allowed to include content not disclosed before the application date, or the priority date, if any, it would enable protection for subject matters without disclosure on the legitimate date, which would unfairly tip the scales against the public interest. Therefore, according to Article 33 of the Patent Law and Paragraph 1 of Article 43 of the Rules for the Implementation of the Patent Law of the People’s Republic of China (hereinafter referred to as Implementation Rules), applicants may amend their patent application documents, provided that amendments to the invention and utility model patent application documents do not go beyond the scope of disclosure in the original description and claims.

The Guidelines for Patent Examination further clarify this by detailing two acceptable amendment categories: one is the content disclosed in the words of the original description and claims, and the other is content that can be directly and unambiguously determined based on the content disclosed in the terms of the original description and claims, as well as the drawings attached to the description. During both the substantive examination and the reexamination of patent applications and the examination of the invalidation process, “going beyond the scope of the original disclosure” is one of the first objects of examination and forms the basis for determining the text to be examined, holding a position of vital importance.

Multiple amendments are permitted during the patent prosecution and invalidation procedures to allow applicants or patentees to refine their applications or patent documents. These amendments can be made voluntarily, where applicants anticipate and address

Exploring the pitfalls of patent amendments

Whether making voluntary or reactive changes, the golden rule remains: never go beyond the original scope.

Celinna Wang, Bing Han, Qin Su, and Xiaohui Chu of China Pat delve into the scope of original disclosures to provide guidance on best practices for patent amendments in China.
potential issues, or in response, where amendments respond to official notifications. Regardless of the approach, certain key timings and contexts guide them.

Article 28 and Article 41 of the Patent Cooperation Treaty (PCT):
Amendment timing: upon entering the national phase in China under the PCT.

Amendment type: amendments can be made to the claims, descriptions, and drawings.

Rule 52(1) of the Implementation Rules:
Amendment timing: when requesting substantive examination or within three months of receiving the relevant notification from the China National Intellectual Property Administration (CNIPA).

Amendment type: amendments can be made to the claims, descriptions, and drawings.

Rule 53(1) of the Implementation Rules:
Amendment timing: when submitting a divisional application.

Amendment type: amendments can be made to the claims, descriptions, and drawings.

Rule 54(1) of the Implementation Rules:
Amendment timing: during the invalidation process.

Amendment type: amendments can be made solely to the claims.

Whether making voluntary or reactive changes, the golden rule remains: never go beyond the original scope. In the following sections, we will use specific cases as examples to analyse the criteria for grasping the legal provisions related to this rule in actual practice.

Case 1: patent amendments and their implications
This case involves a method for detecting fluid injection, e.g., hydraulic and diesel fuel injection in patients, with the primary objective being to facilitate the timely identification of potentially harmful fluids injected into the human body and prevent treatment delays.

Claim 1 of the patent:
A method for detecting fluid injection in a patient, the method including the steps of:
- providing a fluid storage tank;
- providing fluid for use in machinery and added fluid to the fluid storage tank;
- providing a fluorescent dye and adding the fluorescent dye to the fluid such that the fluid fluorescent in the presence of blue light or ultraviolet light ultraviolet light; and
- possible fluid injection occurring in a patient.

The examiner objected to this claim on the grounds that the “method for detecting fluid injection in patients” is applied to living human or animal bodies, including ex vivo samples, and directly infers whether fluid flow, amendments based on examination returns, a well-formed argument might do the trick.

Case 2: merging embodiments in divisional patents
In Article 25, Paragraph 1, Item 3 of the Patent Law, rendering it ineligible for patent protection.

In response to the Office Action, the applicant strategically revised the claim. They removed the term “patient” and coined it a “method for detecting a hydraulic fluid at a potential fluid injection location.” They also limited the scope of the fluorescent dye, specifying it for patient injection, passing the way for the patient’s grant.

During the submission procedure, representing the petitioner, we emphasized that removing the term “patient” from the subject matter of Claim 1 expanded its protective scope. Additionally, since the original Claim 1 did not specify that the fluorescent dye was “suitable for injection into patients,” such an amendment does not comply with Article 33 of the Patent Law.

On the flip side, the CNIPA maintained that although the designation for “patients” had been deleted from the subject matter in the claim, the amendment was constrained by adding “a fluorescent dye suitable for injection into patients” to the claim. Thus, considering the totality of the technical features defined in Claim 1, the CNIPA concluded that the amendment did not extend beyond the original scope of the claim.

We then filed an appeal before the Beijing Intellectual Property Court, and a disagreement arose between the CNIPA and the court over the application’s amendments.

The Beijing Intellectual Property Court weighed in, contending that by omitting “patient,” the method’s applicability broadened, even with the amendment specifying the fluorescent dye suitable for injection into patients. We argued that the limitation pertains to the characteristics of the fluorescent dye itself, not to the entities into which it is to be injected. This specification of the dye for injection into patients restricts its properties rather than its application, allowing for its potential use in contexts other than human patients. Ultimately, the first-instance judge ruled in our favor.

This case exemplifies the complexity of patent amendments, where applicants make revisions in response to an examiner’s objection, a reactive measure that may lead to further scrutiny. It highlights that even if amendments are accepted and the grant is patented, challenges can still arise in the invalidation phase, as evidenced by this case where the substantive examination accepted the changes. Subsequent patent invalidation cases concerning embodiments in the description were combined into a new independent claim. The first embodiment involves adding a time for the priority of cell reselection, which expires when the time does; the fourth pertains to reselection to a CSG cell with extended coverage. The divisional application passed the examination and was allowed.

When we representing the invalidation petitioner against this patent, we looked through the history documents, it became evident that the two embodiments address different technical aspects within cell reselection. The consolidated claim within the granted patent makes this clear: cell reselection priority is utilized to execute reselection to the hybrid CSG cell, provided that the timer has not yet expired and the hybrid CSG cell indicator includes the specific ID corresponding to the hybrid CSG cell.

During the invalidation proceedings, the CNIPA inferred that the steps following the condition where the timer has not yet expired were, as mentioned in the description, pertaining solely to the cell reselection priority and do not encompass the coverage-extension CSG cell. Additionally, the claims depict a clear sequence of operations not present in the original parent application documents. Consequently, CNIPA sided with our viewpoint.

The takeaway:
Through the above two cases, we can discern that, during both the substantive examination and the re-examination of patent applications and the examination of the invalidation process, of patents in China, the examination standard for “going beyond the scope of the original disclosures” is quite strict, with a high demand for the criteria of “directly and unambiguously determinable.” When amending application documents, especially the claims, it is essential not only to consider the technical meaning of each technical feature before and after the amendment but also to comprehensively assess the impact of the modification to the entire embodiment. Any amendments that result in a new embodiment may not expect a warm reception.

At its core, the documentation of the original text is crucial. It is challenging to contemplate every possible mode of the amendment during the initial drafting, deploying embodiments as outreach as possible is still advisable to support subsequent possible amendments to the greatest extent.
The BRICS group is an alliance that emerges from five of the world’s leading emerging economies: Brazil, Russia, India, China, and South Africa. Founded in 2006, its main goal is to promote economic and political cooperation among its members and challenge the dominance of Western economies in global financial institutions.

The history of the BRICS dates back to the first decade of the 21st century when these countries began to collaborate on economic and political issues. Its geopolitical impact has been considerable, accounting for more than 45% of the world’s population and a significant percentage of global GDP.

At present, the BRICS group – originally Brazil, Russia, India, China, and South Africa – is going through a prominent political moment. At the recent summit in South Africa, the group formalized its invitation to six new members: Argentina, Saudi Arabia, Egypt, the United Arab Emirates, Ethiopia, and Iran.

The relevance of the BRICS in the global economy is undeniable. It accounts for 24% of global GDP, 16% of exports, and 15% of global imports of goods and services.

In addition, the five member countries of the bloc represent 30% of Argentina’s export destinations. Expanding the bloc from five to 11 members will create a group of impressive economic size.

An 11-member BRICS would take the bloc’s share of the world’s population from 41% to 46% in 2024, its share of global GDP measured in US dollars adjusted by purchasing power parity (PPP) from 33% to 38%, and its share of global goods exports from 20% to 23%. By contrast, the G7—comprising the US, Canada, France, Germany, Italy, Japan, and the UK—would still account for just 10% of the world’s population, 25% of global GDP measured in PPP-adjusted US dollars and 25% of global goods exports.

Argentina’s entry into the BRICS group of emerging economies was announced by President Alberto Fernández on August 24, 2023. This decision marks a milestone in Argentina’s foreign policy and opens a new scenario in which the country will be the protagonist of a common destiny in a bloc of great relevance.

The most important data to understand the importance of this bloc can be assumed from the following topics:

- It is a geopolitical and financial reference.
- It currently represents 24% of global GDP.
- It accounts for 16% of world exports and 15% of global imports of goods and services.
- The five countries that currently make up the BRICS account for 30% of Argentina’s exports.
- According to the FAO (Food and Agriculture Organization of the United Nations), the BRICS are the countries that are poised to lead the eradication of world hunger and poverty by 2030.

Santiago R. O’Connor, Managing Partner at O’Conor & Power, introduces the invitation for six new members to join the BRICS nations including his own, Argentina, and discusses the potential benefits of joining the bloc from an IP perspective.

Argentina, BRICS, and IP: present status

Santiago R. O’Connor

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Santiago R. O’Connor, Managing Partner at O’Conor & Power, introduces the invitation for six new members to join the BRICS nations including his own, Argentina, and discusses the potential benefits of joining the bloc from an IP perspective.
In view of the above, it is important to analyze the main aspects of IP protection in each of the BRICS countries in order to determine how the protection of industrial and intellectual property matters shall be taken care of, particularly to effectively protect the intangible assets of foreign investors in this new bloc.

In connection with IP international treaties, and focusing on Argentina, it is advisable to review which international agreements are in force in each of these countries, and which are not, in order to assess best practices for protecting trademarks, patents, copyrights, industrial designs in a globalized world, and commerce, as not all of the countries are aligned (see table, right).

Argentina has an old and enhancing history in the ratification and effective use of international treaties, such as the Paris Convention, TRIPS, and the Berne Convention, and a large tradition in the handling of anti-counterfeiting policies through the federal courts, as well as the respect of notorious and famous trademarks.

However, there is a long debt in the process of ratification of one of the most important treaties, the Patent Cooperation Treaty (PCT) which has already been ratified by many Latin American countries, such as Brazil, Mexico, Chile, Colombia, Barbados, Costa Rica, Cuba, Dominican Republic, Ecuador, Guatemala, Honduras, Nicaragua, Panama, and El Salvador.

Thus, it is urgent that the next government that shall take power in Argentina after the presidential election that shall take place next November 2023, moves forward in the approval through Congress of the PCT.

The access by the Argentine to the PCT shall give the country an important legal instrument not only for foreign investors to protect their patents in a more expected and swift manner, but also for Argentine entrepreneurs and developers to expand their creations worldwide.

Argentina, specifically, has several laws that have ratified the above-listed international treaties, are the following: Berne Convention (Law N° 25.140), Treaty of Marrakesh (Law N° 17.209), Treaty of Nairobi (Law N° 27.061), Treaty of Paris (Law N° 14.186), American International Convention on Literary and Artistic Property (Law N° 13.985), Rome Convention (Law N° 15.051), and WIPO Performances and Phonograms Treaty (Law N° 25.140).

The invitation for Argentina to join the BRICS is the start of a large and complicated process, and time and political developments shall determine if the same shall be a wise move in the IP scenario of Argentina in a fast-changing and challenging world.

Javier Milei is as from December 10, 2023 the new President in Argentina.

On December 22, 2023 the Argentine Government decided not to enter the BRICS according to the following letter:

Mr. President,

I am pleased to write to you regarding the invitation to the Argentine Republic to join the BRICS Group decided at the Johannesburg Summit last August.

As you are aware, the foreign policy approach of the government over which I have presided for over 4 years differs in many respects from that of the previous government. In this sense, some decisions taken by the previous administration will be reviewed.

Among them is the creation of a specialized unit for the country’s active participation in BRICS, as indicated by former President Alberto Fernández in his letter of September 4.

In this regard, I would like to inform you that in this instance it is not considered appropriate for the Argentine Republic to join the BRICS as a full member as of January 1, 2024.

Notwithstanding this, I would like to stress my Government’s commitment to intensifying bilateral ties with your country, in particular increasing trade and investment flows.

As I look forward to meeting with you, I take this opportunity to reiterate to you the assurances of my highest consideration.

Santiago R. O’Connor is Managing Partner at O’Connor Power in Buenos Aires, Argentina. With 40 years of experience in IP practice, he is an active member of INTA, ASPI, ECTA, MARQUES, PTMG, and other local and international IP associations.

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Managing IPR in the UAE

East meets West: managing intellectual property rights in the United Arab Emirates

Yasir Masood and Bassel El Turk of Rouse provide a guide for IP owners to consider when doing business in the United Arab Emirates. From pre-market research to mechanisms for enforcement, they look at the basics of protecting trademarks and other IP in this new member of BRICS.

Located east of Europe and west of Asia, the UAE has long served as a global hub of trade and commerce. With its accession to BRICS, the country is leveraging its ability to straddle not only between regions but also between different economic paradigms. It’s a strategic balancing of the country’s interests amid evolving geopolitical dynamics.

Rouse has been present in the United Arab Emirates since 1997. Known for our substantial footprint across Asia – particularly in China – we’re also a bridge between worlds for our IP-owning clients. The UAE’s accession to BRICS has all the potential to increase the flow of goods and services into the country, which makes IP protection even more important. We’ve put together this guide to help IP owners understand the local landscape.

As with any market, an IP owner entering the UAE for the first time should conduct a comprehensive assessment of IP in their domain of business. This is done in order to identify any conflicting trademarks that could pose challenges to the registration or use of an intended mark. The exercise essentially involves conducting official searches in the local trademark office database. Due diligence is intricate and time-consuming in the UAE, so having a local partner is essential.

Business owners first need to differentiate between what they choose as a trademark (i.e., the company name that will distinguish their business from other businesses) and what they choose as a trade name (i.e., the name, logo, or sign that will distinguish their products or services from their competitors’ products or services). Although trade names and trademarks have separate functions – as set out above – they may still be confused in consumers’ minds. Business owners therefore need to be careful and strategically aligned when choosing both names.

Searching trade name databases in the United Arab Emirates is challenging as the country has more than 40 different commercial registers. These are scattered across the seven Emirates mainland commercial registers and more than 40 UAE Free Zones. A trademark search is a somewhat easier exercise, as there is a single centralized trademark register for all the Emirates and Free Zones. But determining whether there is a risk of a trademark infringing on a trade name opens up the aforementioned complexity again, as the various trade name databases need to be consulted.

A major hotel chain wanted to enter the UAE market in the early 2000s. As soon as the chain had secured a trademark registration and had started operating, it was served with a warning letter from a local hotel company if it had had an earlier trademark registration. The foreign company then had to litigate for over a year to show earlier rights through the online use of the trademark and the online radio being accessible in the UAE. The court subsequently ordered the cancellation of the local company’s trademark application and ordered the local channel to change its name. The procedure would have been shorter and cheaper for the foreign company if it had had an earlier trademark registration.

With its accession to BRICS, the country is leveraging its ability to straddle not only between regions but also between different economic paradigms.

Registering IP and forming local partnerships

The UAE’s trademark application process has become more straightforward for many international applicants since the country joined the Madrid Protocol in late 2022. Applicants from Madrid Protocol member states can extend their basic home-registration IP rights to the UAE without needing a local agent. This is unless the application is challenged, refused, or an opposition is raised.

A foreign applicant filing a trademark directly in the UAE must appoint a local trademark agent in the country. This is done by granting a notarized power of attorney and legalizing the document at the UAE consulate in the applicant’s home country. The document is then locally super-legalized by the UAE’s Ministry of Foreign Affairs.

Rouse recommends swift registration of your IP rights once you have decided to enter the UAE. This is particularly important for trademarks, as even though the country adheres to the first-to-use principle – whereby the first user is presumed to be the rightful owner – registration is strong evidence of first use and is easier to enforce.

For example, a major international media company that operates online radio broadcasts did not register its radio mark in the UAE (where radio is widely listened to). A local company launched a radio channel under an identical trademark and filed for that mark in the UAE. The foreign company then had to litigate for over a year to show earlier rights through the online use of the trademark and the online radio being accessible in the UAE. The court subsequently ordered the cancellation of the local company’s trademark application and ordered the local channel to change its name. The procedure would have been shorter and cheaper for the foreign company if it had had an earlier trademark registration.

It should be noted that trademark registration office fees are relatively high in the UAE. The costs are compounded by the fact that a separate application is required for each class of goods or services. The law in fact already allows for multi-class applications, but this practice is not yet being implemented. We expect it will be soon. Rouse recommends that our clients register only those of their trademarks that require protection in the UAE. Registering multiple variants is expensive, time-consuming, and typically unnecessary. We do however recommend registering marks in both Latin and Arabic letters. This strengthens the protection of the Arabic transliteration of the mark and helps to thwart third parties from securing slightly different variations.

The UAE does not require proof of trademark use upon registration. However, any mark that has not been used for a period of five consecutive years after its registration will be vulnerable to cancellation. A party interested in pursuing such a cancellation action needs to do so with the Ministry of Economy, as cancellation is not automatic. The owner of the trademark for which cancellation is being sought should produce thorough documentation of the mark’s use during the five-year period. Records of imports, sales figures, and any advertising campaigns help to substantiate use.
In one particular case, the trademark application of a large multinational was rejected on the basis of an earlier registration that was deemed confusingly similar to the multinational’s mark. Investigations showed that the owner of the earlier trademark had never used it in the five years since registration. On this basis, the multinational then filed a request with the Ministry of Economy to cancel the earlier trademark and register its own.

As indicated earlier, it’s common practice in the UAE for foreign businesses to collaborate with local partners rather than establish their own independent entities. While this partnership approach offers several advantages, it can pose challenges when it comes to managing IP. It’s imperative for an IP owner to register IP rights in their own name, even when engaging a UAE partner. Relying on a local agent, importer or distributor can jeopardize IP assets in cases where the partnership disintegrates. Though recovery is possible, it’s often costly and legal proceedings are protracted.

In one example, the local distributor of a well-known manufacturer of electronics registered the principal’s trademark in its own name. After the cancellation of the distribution agreement, the principal struggled to engage with a new distributor as they did not have the distribution agreement, the principal struggled to successfully recover its trademark rights. The length of litigation had a negative commercial impact on the principal, as it was unable to enter a productive commercial relationship in the interim.

Trademark owners also have the option of filing civil lawsuits against infringers. This approach enables enforcement presented in the civil case to also be submitted in the criminal court. Proceedings are lengthy and costly though, so Rouse recommends businesses only to resort to this approach when the infringement is complex or the litigation is strategic.

For example, Rouse has assisted several clients in enforcing three-dimensional trademarks. These are unconventional marks represented by the three-dimensional shape of the product, or a part thereof. Given the complexity and strategic importance of some of these trademarks, Rouse has on occasion taken such cases to the courts to enforce rights.

While legal proceedings are an option, Rouse often recommends administrative actions as a fast and effective way to counter infringements. Several of the Emirates enable trademarks to be registered for monitoring and also accept complaints against infringers. Subsequent investigations may lead to actions for removing the counterfeit goods from the market.

In light of the UAE’s strategic location and its new role within the BRICS partnership, we anticipate increased attention to safeguarding IP in the country. Detecting and enforcing three-dimensional trademarks, trademarks, and counterfeiting is not without its challenges. But through prudent local partnerships and smart registration decisions, businesses can thrive at these crossroads of global commerce.

“Searching trade name databases in the United Arab Emirates is challenging as the country has more than 40 different commercial registers”

Résumés
Yasir Masood is an Intellectual Property Manager at Rouse’s office in the United Arab Emirates. He has been advising clients across the MENA region since 2016. Yasir’s areas of expertise include IP audits, trademark filing strategies, enforcement measures, and drafting of IP clauses in contracts. He is well-versed in laws and procedures in the UAE, GCC, Europe, and the US, and regularly holds presentations and authors articles on IP protection.

Bassel El Turk is a Principal and Managing Partner of Rouse’s Middle East & Africa business based in the United Arab Emirates. He works on a range of IP matters in our Dubai office, with a particular focus on enforcement and complex IP litigation in the Middle East and North Africa.

Bassel manages the IP portfolios for a number of multinational entities across the Middle East and North Africa as well as regional entities worldwide. He also advises on potential legal and cultural risks associated with Arabic language marketing and advertising across the MENA region.

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BRICS | 2024
Managing IPR in the UAE
Impact of Egypt joining BRICS on developing intellectual property protection systems

Nermien Al-Ali, Group Head at NAL LAW Group, expresses how the recent development that will lead to Egypt joining BRICS will bolster IP development in the country by providing a strong and effective structure for protection to thrive.

The field of intellectual property in Egypt is witnessing a metamorphosis on many levels, starting with the launch of the National Strategy of Intellectual Property this year and continuing with the planned BRICS membership in 2024. The rapid and vast changes caused a tsunami in the field, sweeping away the old structure of multiple offices and approaches to intellectual property, and giving rise to a new unified system. The National Strategy of Intellectual Property highlighted the importance of intellectual property for the first time as a public/private national concern. Intellectual property rights are now recognized as a catalyst for a strong economy, and an enabler to Egypt in achieving the United Nations’ sustainable development goals (SDGs). This brought to the political forefront the necessity of developing a state-of-the-art system for the protection and enforcement of intellectual property rights, and passing of laws consolidating all the separate IP agencies into a single agency reporting directly to the Prime Minister.

Of course, in developed economies the importance of intellectual property as a socio-economic enabler was never questioned. But when it came to developing economies, it took many initiatives on the part of the United Nations and other global organizations like the World IP Organization, to raise awareness on how a strong system of intellectual property rights would give the developing economies a fighting chance and help them achieve the UN SDGs. In addition, joining BRICS in the near future would have a great impact on the Egyptian economy as a whole and on Egypt’s intellectual property landscape. This is because BRICS countries are known for their economic prowess and innovation, and collaboration among them and Egypt would lead to developments in intellectual property regulations, trade agreements, and protection systems. Overall, joining BRICS would harness Egypt’s ability to achieve sustainable industrialization and infrastructure reform, which began with President El-Sisi coming to power in 2013.

Egypt has invested heavily in recent times in a number of sectors that are closely related to the United National SDGs and intellectual property rights. Most notably is SDG 9 - Industry, Innovation, and Infrastructure. Intellectual property rights, such as patents and copyrights, encourage these sectors and protect them. Egypt has made strides in developing the state-of-the-art system for the protection and enforcement of intellectual property rights, and passing of laws consolidating all the separate IP agencies into a single agency reporting directly to the Prime Minister.

One public front is the importance of intellectual property as a socio-economic enabler. The Egyptian government has launched many initiatives and programs to foster innovation and support inventors and patentees. The latest was the Ministry of Higher Education and Scientific Research 5P Initiative encouraging patentees to commercialize their patented inventions. The Initiative recently supported the commercial manufacture of a locally-made electric car, ventilators, and plastic grain silo. The initiative also partnered with the Ministry of Agriculture in its work to develop new plant varieties of hybrid rice strains.

Another crucial SDG is SDG 4 - Quality of Education. It is no secret that a strong intellectual property system – mainly copyrights - helps in disseminating research materials and resources, thereby supporting scientific and literary writing, as well as creation of databases and libraries improving both the quality of education and knowledge acquisition. The fact that Egypt is notorious for piracy especially in relation to books and movies, hindered development in the publishing and entertainment sectors. In 2013, Egypt launched a program to improve its rank of 95/132 in the Global Knowledge Index, and by so doing encouraged intellectual property creation and protection. In 2021, the Ministry of Education was set to create the Egyptian Knowledge Bank to be accessible to all free of cost. Simultaneously, the Ministry of Communications and Information Industry joined forces with the United Nations Development Program to fund IT training and educational programs to 1120 underprivileged schools. Though Egypt’s Global Knowledge Index (GKI) score of 52.3 is above the world average of 42.4, Egypt ranked 95 out of 154 countries as a result of its extremely low Intellectual property licensing receipts, and R&D expenditure. Again, highlighting the crucial role of intellectual property generation and protection system in overcoming many of the economic setbacks.

On another public front, SDG 3 - Good Health and Well-Being the Protection for Intellectual Property Rights becomes a matter of life or death. If no effective protection was provided to new inventions in this sector particularly in the pharmaceuticals sector, this would be a policy failure. Effective patent protection to scientific methods, new uses of medicinal drugs, and derivative inventions. Though Egypt has made strides in developing the field of intellectual property, Egypt still faces many challenges in migrating to the new system effectively, and achieving operational efficiency. Despite the allocation of resources and personnel to development of the unified intellectual property system, public officials of the old system have no expertise in organizational restructuring and how to utilize overlaps and similarities of intellectual property types in creating a winning model. While a good model and strategy are vital for setting the direction and goals of the agency, execution and operational plans are essential to bridge the gap between vision and reality. Egypt needs technical assistance and support in developing its unified IP system, beyond the WIPO models, reports and statistics. This is where joining BRICS would help Egypt in its implementation of the Right system of intellectual property protection. The magnitude of the impact that would result from joining BRICS on intellectual property will depend on the policies and goals of BRICS members regarding intellectual property, and the level of cooperation afforded to new members.

BRICS countries represent 46% of the world’s population and over a third of global GDP.
• International Cooperation Department - studies foreign development trends of intellectual property, international liaison, and exchange activities on IP-related work.

The CNIPA also developed standards of intellectual property examination, protection, evaluation, and infringement which helped in reducing the number of disputes going to court, and supported the Chinese judiciary in faster resolution of disputes. China and other BRICS countries with their leading IP positions would benefit Egypt and other BRICS countries in their IP journey, through the IP BRICS Cooperation Program.

Egypt, as a new member, would be part of the "IP BRICS" - a cooperation program developed by the BRICS Intellectual Property Offices launched in Geneva in 2012. The final IP Roadmap of IP BRICS was adopted by BRICS Heads of Intellectual Property Offices Meeting in Johannesburg in May 2013, and focused on eight cooperation streams, including:

• Training of Intellectual Property Office Staff and Examiners;
• National IP Strategy and Promotion of Public Awareness of IP;
• Information Services on IP;
• IP/Patent Processes and Procedures;
• IP Strategies for SMEs;
• Collaboration in International Forums;
• Trademarks;
• Industrial designs.

The first stream of training for IP offices staff and examiners exchange would be very beneficial to Egypt in its implementation of the National IP Strategy and setting up the IP Agency departments and systems. Egypt can adopt BRICS countries’ best practices and benefit from their experience in developing its unified IP system. As BRICS nations have witnessed significant economic expansion in recent years, learning from their IP practices can potentially contribute to economic development in Egypt. In addition, aligning with BRICS countries’ IP Systems would enable and enhance the implementation of international standards and agreements, such as those governed by the WIPO.

In fact, the IP BRICS Cooperation program has proven very effective in helping the members face new challenges related to the field of intellectual property like the protection of works and inventions assisted by artificial intelligence and other matters. The 14th BRICS Heads of IP Meeting held on 15 September 2022, updated the cooperation guidelines and programs and approved the Final AI Study Report on Examination rules. The Meeting also, for the first time, shared real-life examples of how IP supported attaining a number of the United Nations’ SDGs with WIPO. A very useful guide and roadmap for all BRICS members, old and new.

In addition, the 15th BRICS Heads of IP Offices Meeting held recently on 17 October 2023 witnessed many new proposals focusing on “IP and Youth by CIIPC-South Africa, the use of artificial intelligence (AI) in the examination of Patents and Trademarks by INPI-Brazil, preparation of guidelines on IP system in BRICS countries for entrepreneurs by ROSPATENT-Russia; the initiative of GCPDTM-India in the preparation of a booklet titled Unleashing the Potential of a Decade; IP Multilateral Collaboration: proposals by CNIPA-China on Work Plan to Strengthen the Dissemination of the Outcomes of the IP BRICS Cooperation; and update of the Operational Guidelines and inclusion of ICT and Digital Transformation Workshop in the IP BRICS Cooperation” Most notably and in relation to the subject of this article, the meeting concluded by noting the decision to invite the six countries to become full members of BRICS – including Egypt - and hence join the IP BRICS Cooperation Program.

In summary, Egypt’s dedicated focus on intellectual property, as demonstrated by the National Strategy of IP and the consolidation of efforts, initiatives, and agencies under a single agency tasked with policy and legal reform, promises to bring about robust development in the intellectual property protection systems. This will be further solidified by Egypt joining BRICS, and consequently the IP BRICS Cooperation Program. By actively participating in the IP BRICS Cooperation Program and leveraging the expertise of BRICS members, particularly China, Egypt can ensure that it is moving in the right direction to build a world-class effective and efficient IP protection system.

Résumés

Nermien Al-Ali, Head of NAL LAW Group, and expert Intellectual Property Trainer at NAL LAW Academy, was recognized in 2019 by Legal500 as the best IP Lawyer in Egypt. Graduated from Sydney University, Australia, and obtained a master’s in Intellectual Property from Franklin Pierce Law Center, USA in 2000. She was a Research Professor at the Law Center (2001-2003), teaching IP Management and authoring the Comprehensive Intellectual Capital Model, published in New York in 2001. She returned to Egypt to head the IP practice of two major law firms until founding NAL LAW in 2012. She is the IP Counsel of Apple, Merck, and Egyptian Banks Company among others.

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Endnotes


Endnotes


Most Effective IP & Customs Enforcement Actions

Patents | Trademarks | Industrial Designs | Copyright | Plant Varieties | IP Litigation | Criminal Enforcement Measures

Trusted IP Counsel of:
APPLE INC., BOEHRINGER INGELHEIM, DAMAS, EGYPT FOODS GROUP, MERCK INC., PEPSICO, SKECHERS

Egypt joining BRICS
The protection of trade secrets in Brazil falls within the scope of unfair competition, meaning that companies, when entering a dispute resulting from a leakage or trade secret misuse, usually sustain their arguments on the disloyal practices that unbalance business transaction in favor of a competitor that misappropriates relevant confidential information.

The law dealing with trade secrets in business transaction can be found essentially in Items XI and XII of Article 195 of the Industrial Property Law (IP Law), which state that the crime of unfair competition is committed by whoever (i) discloses, exploits, or uses, without authorization, knowledge, information, or confidential data usable in industry, trade, or service, excluding those that are public knowledge or evident to a technical expert in the field, to which access was gained through a contractual or employment relationship, even after the termination of the contract (XII) and gained through a contractual or employment relationship to a technical expert in the field, to which access was excluded; (ii) discloses, exploits, or uses, with authorization, the protected information, which state that the crime of unfair competition is essentially found in Items XI and XII of Article 195 of the Industrial Property Law (IP Law), and (iii) discloses, exploits, or uses, with authorization, the protected information that is confidential, thereby preventing its use, sale, assignment, or exportation, and prohibiting its use, sale, assignment, or exportation, and prohibiting its use, sale, assignment, or exportation.

The rules to prevent leakage and publication of trade secrets were followed by the general ruling of the Brazilian courts that secure losses and damages recovery as well as the grant of ex parte preliminary injunction. Notwithstanding the legal developments, in the last 12 years, there have been court decisions that are shaping up trade secrets, thereby demanding additional steps for the adequate protection when there is an employment or a service rendering relationship. Such additional requirements and steps will be dealt with in this article.

Information in business transactions in Brazil: a secret but a trade secret

According to the Brazilian scholar’s development, information is to be protected under the trade secret rules must meet objective legal requirements, the first of which is the ability to bring a competitive advantage to the business owner. This requirement makes it clear that the IP Law is not interested in professional or ethical secrets, normally valued in professional associations. The interest in question is specifically in “trade secret” that being innovative information that impacts a company in trade and competition. The trade secret must be included in the comprehensive concept of business, which encompasses administration and management techniques, sales methods, customer listings, among other systems and methodologies that organize companies. In this same line, there are techniques that influence industrial production and agricultural activities, such as technical knowledge that can increase production or reduce its related costs.

The second requirement lies in the novelty of the developed technique or information since the competitive business secret must not be anticipated by identical or existing information. It cannot be disclosed to the public or have been used previously. Like in patents, novelty is absolutely necessary and therefore the protected information must be new and totally unknown to the public. The third requirement is actuality, which arises from the impossibility of competitors having access to this knowledge and using this confidential information in their activities. From this perspective, the obvious characteristic of “trade secret” stands out, namely the need for information to be kept confidential so that it does not become known to the public. The fourth requirement is that the competitive business secret must not be anticipated by identical or existing information. It cannot be disclosed to the public or have been used previously. Like in patents, novelty is absolutely necessary and therefore the protected information must be new and totally unknown to the public.

Provided that such information:

(a) Is secret, in the sense that it is not generally known or readily accessible to persons in circles that normally deal with the type of information

The Brazilian courts have been shaping up legal protection for when the access to trade secrets occurs through a contractual relationship

...
that establish psychological and material barriers to
dential obligations and other precautionary measures
tion of fines on the ones that fail to comply with confi-
tment for third parties.
line its formative elements and requirements, which
zilian doctrine and jurisprudence were relevant to out-
tive and technologies can be classified as confidential, in order
not all information, knowledge and
hrough a contractual relationship. Accordingly, an
 unfair practice, which is a tort and a criminal offense),
confidential information and knowledge is com-
trade secret protection
-ri’s emphasis).

When a confidentiality agreement is re-
strictive nature (the trade secret is protected against
frivolous or a criminal offense). The Brazilian courts have been shaping up legal pro-
tection for when the access to trade secrets occurs through
across a contractual relationship. Accordingly, an
NDA (non-disclosure agreement) or a set of rules to maintain
on period. These have been addressed specific-
ly at the Superior Court of Justice (STJ) in the case RR
5906G012015.2012.8.26.4020. Reporting Justice Deladois Miran-
da carvalho. This case is relevant to the understanding of the
application of the IP Law. These sections list specific business con-
ditional agreement. This case is relevant to providing support on intellectual property matters and fiscal law. José Carlos Vaz
is an Attorney-at-law specialized in intellectual property matters. His activities are focused on the protection and enforcement of patents, trademarks and trade secrets. Eduardo has been participating in Confid-
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sions issued by the BTO to handling confidentiality obligations. Eduardo holds a law degree for PUC-Rio and is currently undertaking postgraduate studies in Business Management at the renowned FGV (Fundação Getulio Vargas).

José Carlos Vaz e Dias, Senior Partner
José Carlos Vaz e Dias is an attorney-at-law and has specialized in patent and trademark matters and foreign investment law since 1993. His activities are fo-
cused on providing legal support and consultancy to foreign companies wishing to invest in Brazil, especially in the field of technology and in support of trademark protection and litigation. One of his areas of expertise is participation in the
negotiation and drafting of franchising, distribution and licensing agreements and joint-venture and other commercial agreements that aim to exploit intellectual property rights in the Brazilian territory. Most recently, José Carlos Vaz e Dias has been working extensively on matters related to Brazil’s Innovation Law and the particularities of obtaining fiscal benefits and local government funding under this Law. He has coordinated several research and development agreements in-
volving Brazilian research centres and national and foreign companies, while also providing support on intellectual property matters and fiscal law. José Carlos Vaz e Dias holds both a master’s (LLM) and a PhD in law from the University of Kent in Carthy, United Kingdom.

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Von Seidels