

**RECENT IP
UPDATES**

ARGENTINA:

Increase of official fees

The Argentinian Patent Office has recently increased their schedule of official fees.

Some of the new fees will be applicable on August 1st, others on October 1st. The increase exceeds 30% in many cases (from 80 to 105, the filing of a trademark, from 204 to 286 the filing of a patent and from 169 to 239 the request of patent examination) and a new official fee has been introduced to request an accelerated patent prosecution.

BRAZIL:

New Precedent for Prosecution Timeline - Possibility to request acceleration of prosecution through the civil courts - Potential prospective - exceptional - measures to reduce back-log.

The Brazilian Patent and Trademark Office, which has been long since notorious for its decade long backlog of workloads in patent granting, has staked a landmark decision to award a preliminary injunction to a pharmaceutical company. The Court of Appeals considers that there may be cases in which future damages may not be enough to prevent irreparable damage and has allowed an interim injunction based on a patent application. This may set the precedent for other cases to be reviewed and processed on a more expeditious basis.

Also, a Court has recently issued a resolution requesting the Patent Office to examine a patent application which had remained more than 10 years without having been examined. The Court indicated that also the Patent Office is subject to the constitutional principle of reasonable duration of administrative processes. This is an avenue available to patent applicants which, although not exempt of costs, may help circumventing the tremendous back-log at the Brazilian Patent Office. Finally, it has been long since the country has been exploring measures to reduce the considerable back-log in the examination of patents. Rumor has it that the Government may present shortly a plan to reduce substantially this back-log by, presumably, set forth a simplified process by which unopposed applications filed before 2014, which are not being examined, could be granted. Apparently, pharmaceutical applications would not be suitable to this enjoy this simplified process. Presumably, again, the system would have an opt-out clause and third parties would have the possibility to file oppositions. We will follow up this closely, as it would not be exempt of problems, even though the final goal is something long expected in the sector.

**CAYMAN
ISLANDS:**

New Design and Trademark Laws enter into force.

The Design Rights Registration Law and the Trademark Law enter into force on August 1st, 2016. The Design Rights Law will provide for existing registered UK and EU design rights to be registered in, and extended to, the Cayman Islands.

The Trademarks Law will set forth the establishment of a TM Registry in the Cayman Islands for the registration of local trademarks, which will follow the Nice classification. It will no longer be possible to extend UK, EU or international trade mark registrations to the Cayman Islands.

CHINA:

Guidelines on counterfeiting - development of PPH programs - New Rules on TRAB procedures.

In March, the State Council of China issued a guideline on counterfeiting and IPR infringements demanding better market supervision system and improvements to the law, regulations and standards with appropriate information technology utilized in supervision. A group of IPR protection centers will be established to fast-track cases involving IPR infringement, according to the head of the State Intellectual Property Office (SIPO).

Additionally, the SIPO has announced that it will develop its PPH programs. Among other things, the PPH requirements on some contents in the PCT International Work Products will be eased and a new PPH pilot program between China and Egypt will be launched. Finally, the new Rules on TRAB Hearings in Trademark Review Cases issued by the China State Administration for Industry & Commerce recently came into effect. They will include the possibility to request a hearing, where cross-examination will be available, in a procedure which was, up until now, strictly written. However, the TRAB will have sole discretion to allow or reject such petition. It is too soon to evaluate how these measures will affect the trademark practice but they are expected to facilitate and increase the analysis in the prosecution of trademark applications.

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**EUROPEAN
UNION:**

New Phases for EU Trade Mark Regulation and confirmation of the new online content portability regime.

Many amendments made to the EU Trademark Regulation, made on 3/23/16 will begin to come into effect in the next months, specifically four significant reforms on 1 October 2017.

- Removal of graphical representation requirements - In theory this will facilitate the ease of registration for nontraditional trademarks with the EUIPO. Instead of being solely graphical, marks can be presented in whatever form is deemed relevant by the competent authorities in enabling the public recognition of the subject matter in question.

- A new EU certification mark will be introduced in October, which will allow for the certifying institutions to apply for EU-wide marks, submitting regulations governing their use.
- From October 1st, applicants seeking priority must submit their claims at the time of filing, instead of being afforded the 2 month post-filing timeframe.
- Disclaimers will no longer be able to disclaim elements of a trademark in order to overcome objections to its issuance. On 8 June 2017, the Council of the European Union adopted the new regulation on cross-border content portability. This will allow for previously signed agreements for the viewing or dissemination of movies, series, music, games or sports will be allowed to continue without incurring any additional costs to the user. This is aimed at improving the EU's digital economy and providing equal content consumption rights to all consumers, regardless of their native state within the union. However, this regulation will only apply to paid online content (providers of free services will continue to have discretion as to whether to make their services portable or not).

INDIA:

Revised guidelines for Computer related Inventions.

The Indian Patent Office issued, with immediate effect, another revised Guidelines on Examination of Computer Related Invention in order to provide a much needed clarity in the examination of these inventions. Amongst the major changes, we can highlight those related to (i) the test used for examining CRIs and (ii) the basis required in the specification to support CRIs.

In relation to the (i) issue, the guidelines set out a more flexible, three-step test requiring examiners to properly construe the claim and identify the actual contribution, if the contribution lies only in mathematical method, business method or algorithm, deny the claim and, if the contribution lies in the field of computer program, check whether it is claimed in conjunction with a novel hardware and proceed to other steps to determine patentability with respect to the invention. In relation to the (ii), the guidelines indicate that the description must define the interaction between hardware features and the computer program and, similarly, any functional claim language must be described with reference to structure.

IRAQ:

Revocation of formalities for TM registrations.

The Trademark Office in Iraq has reworked their formalities for TM registrations in class 5(A), where they now require only a soft copy of the home registration certificate to be submitted in support of trademark applications upon filing, whereas the original copy legalized up to the Iraqi Consulate can be submitted within six month-time from the date of filing, without incurring additional fees.

Under the previous requirements, applicants were required to provide the following information when filing a trademark application in class 5: Scientific name of the product, trade name of the producer, pharmaceutical formula of the product, name of manufacturing company if not the applicant, and name of local distributor, if any. All of the above have been dropped and now are substitutable by way of submitting a home registration certificate legalized up to the Iraqi Consulate.

ISRAEL:

New directives related to licensing of funded technology and new guidelines related to prosecution of patents

The Israel Innovation Authority (the IIA) has published new directives which allow the licensing of IIA-funded technology outside of Israel. The IIA was set up in January 2017 to replace the Office of the Chief Scientist of the Israeli Ministry of Economics and to administer government grants, extended to Israeli companies under the Law for the Encouragement of Research and Development in Industry, launched in 1984. [read more](#)

Previously, the existing law only allowed complete transfer of ownership to foreign entities rather than licensing. This will allow Israeli companies to partially monetize their intellectual

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property, while still being eligible for further grants to further develop the same technological platform for other applications. All such transactions (licensing and sale) are subject to the prior approval of the IIA' s research committee and trigger repayment of the grants plus penalties calculated on the basis of various formulas. Whereas previously, payments to the IIA were due in one lump sum upon the transfer of ownership in the technology, the new directives allow for repayment pro rata to installments received from the licensee. Also, the Israeli Patent Office recently announced some new guidelines relating, among others, to Uniformity of Invention, medical use claims, green applications and extensions of term to respond to office actions.

JORDAN:

Accession to PCT

The accession procedures of Jordan to the Patent Cooperation Treaty (PCT) with the Secretary General of WIPO have been completed and took effect on 9 June 2017, making Jordan the 152nd member.

Any PCT applications filed on or after the effective date will include the designation of Jordan; likewise, it will be possible to file international patent applications through the Jordanian Patent Office.

KUWAIT:

Completion of formal examination of patents.

The Kuwaiti Patent Office recently announced that, in collaboration with the Gulf Cooperation Council Patent Office, they have completed all outstanding formal examinations for patents. It is anticipated that the KPO will communicate this news directly to the agents of records and advise on the next steps that are, at the moment, still unclear.

According to regulations, an applicant will have a non-extendable 3 months from the date of notification, for the amendment of any formal defects. The announcement comes with the anticipation that the KPO will soon be starting with a clean slate and beginning operation within the PCT.

NEW ZEALAND:

Joins the Global Patent Prosecution Highway.

The Intellectual Property Office of New Zealand has recently joined the Global Patent Prosecution Highway (GPPH). It offers patent applicants in New Zealand with the possibility to accelerate their applications which meet the requirements set forth in this agreement (for example, when at least one claim of a patent is accepted by one of the participating national patent offices).

It is worth to mention that, should an applicant request to accelerate the examination in New Zealand, the corresponding claims cannot be broader in scope than those of the earlier examined foreign application.

PERU:

New formal provisions for trademark registration - Implementation of Peruvian Electronic Gazette.

New articles have been drafted in the registration of TM's in Peru. These have a number of defining features which have come into effect as of June 2017. Article 2 states that if a power of attorney has already been registered in public registries, it can also be enforced before the INDECOPI. In addition to this, any information which may be lacking at the time of filing, such as representation of the mark, the express description of products and / or services or the proof of payment of the fee will result in no formal date of entrance being assigned.

Article 13 of the regulation marks an interesting difference between the consequences of submitting a withdrawal of the claim and the withdrawal of a proceeding. In this way, the withdrawal of the procedure generates that the resolutions issued during the procedure of the procedure are rendered ineffective. On the other hand, the withdrawal of the claim means that the resolution has the same effects as a resolution declaring the claim denied or unfounded. Additionally, the Peruvian Electronic Gazette has been implemented, where applications will be published. Applicants/representatives will have to monitor the content of the Electronic Gazette and it will be presumed that every person is aware of the content of such publications. Errors in the electronic publication shall be requested to be amended within the term to file opposition (30 working days). Also, This publication decreases the cost of the publication and facilitates the access to the information regarding the administrative proceedings of registration.

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**SOUTH
KOREA:**

Extension of Grace period for design applications - Proof of priority eased - new venue to request revocation of patents.

Several amendments to the Design Protection Act were published on March 21 2017. The amendments will come into effect on September 22 2017. Among others, the grace period is extended from six months to one year and, in order to proof priority, other documents such as the World Intellectual Property Office's Digital Access Service will be valid.

Also, as of March 1, 2017, a patent may be revoked in Korea through a new patent cancellation system which aims at being a more cost-effective alternative to challenge third party patents.

SPAIN:

Protective letters: The Spanish "Toro" is or is not a Badtoro

The implementation of the new Patents Act in April of 2017, has allowed for the submission of protective letters, which will be accepted by all courts handling patent cases. Protective letters are to be effective for three months.

This three-month term is one of the differences between the Patents Act and the Unified Patent Court's Rules of Procedure, as the latter establishes that a protective letter is effective for six months, which is extendable for another six months if the party that filed the protective letter requests such an extension (Rule 207.9). The Spanish Supreme Court issued a resolution a few months ago indicating that the denominative trademark "Toro" is valid and do not incur in any of the absolute prohibitions of the EU Trademark Regulations, even though bulls (toros) may be seen as an icon of Spain. The social use that may be done of a particular image of a "toro" does not render the term generic. However, that denominative trademark "Toro" cannot result in the cancellation of the trademark application "Badtoro", as the addition of the English word "Bad" creates a neologism which does not imply a risk of confusion of the consumers in the market. However, this fight is still not over as the EU Court has to resolve an appeal against the EUIPO decision not to grant the mix trademark "BadToro". According to the Supreme Court, there is no risk of contradiction between the two procedures since the appeal before the EUIPO relates to a mix sign, not a denominative one, which also takes into account the Osborne's mix trademark, which consists in the drawing of a bull, and which enjoys a wide-spread notoriety.

TAIWAN:

New Trade Secrets Amendments - New process to evaluate inventiveness - Acceptance to defer substantive examination - Grace period provisions amended.

The Taiwanese Intellectual Property Organization has recently published a new draft regarding their Trade Secrets Act. According to the Draft, any intentional use of misappropriated trade secrets outside of Taiwan will be pursued only on receipt of a formal complaint.

Committing trade secret misappropriation beyond the Taiwan is a crime being publicly prosecuted under the current law. However, as the practice demonstrates, evidence collection and fact finding in the course of investigation of trade secret infringement case can be both difficult and time-consuming. It becomes even harder when the stolen secret is to be used abroad. Going forward, if a victim is able to withdraw the complaint against offenders who cooperate with the investigation, it may also provide an incentive for some suspects to reveal the truth and thus facilitates and advances the course of the criminal investigation. Other implications in this new draft will include the ability of unrecognized foreign entities to file a complaint, the discretionary limitation of disclosure of trade secrets during the course of trial discovery and reciprocal treatment of Foreign Trade Secrets for countries or institutions that enter into a relevant bilateral treaty or agreement with the Taiwanese governing body and/or organization/institution. The TIPO has also brought into effect, starting July 1st, a new process in evaluating the inventiveness of an application, indicating that if an expert, in view of the prior art, would have arrived at the claimed invention through logical analysis, inference or routine work and experimentation, the claimed invention is obvious and can be easily accomplished. Also, the TIPO has revised its guidelines in relation to post-grant patent amendments, aiming at providing clearer rules for determining whether a post-grant amendment substantially enlarges or alters the scope of the claims as issued.

THAILAND:

Amendments to combat online infringement.

Thailand has made recent additions to its IP law in order to combat online infringement. This will come into place via two major sections.

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The first being the Copyright Act, which governs the culpability of ISP's and removes their burden, in addition to allowing for injunctions to be filed which force removal of content from the marketplace. The second consequence of the recent act is in reference to computer crime. Under the previous CCA, it was difficult to define the person or entity which was infringing on IP law with regard to dissemination of pirated or illegally obtained content. Under the new law, a plaintiff (with the approval of a digital economic minister), has the right to file an injunction for cessation of operation of the given site or online entity if any such material is found to be distributed.

TURKEY:

New IP Law to replace former Decrees

Industrial Property in Turkey have undergone an overhaul and transitioned from being governed by Decree Laws to Constitutional Law. The recently enacted IP Law underlines the developing IP market in Turkey as a result of growing economic conditions and the scope of EU integration as constant additional clauses were unable to keep up with the changing conditions. The new IP Law has five main sections (Trademark Protection, Geographical Signs and Traditional Product Names, Design Rights, Patent Rights and Common Procedures for the establishment and Operation of the Turkish Trademark and Patent Office). A few of the many changes that will be implemented are the following: a three year protection is conferred to unregistered designs as long as the other party was aware of the unregistered design and acted in bad faith and the removal of the non-substantive patent examination which was available before, by which the invention was provided with 7 years protection.