In-house counsel share top litigation concerns and selection criteria

A t yesterday’s session on “In-House Perspectives on IP Enforcement”, a panel shared with a packed room their concerns and tips on the increasingly complex landscape of IP litigation and the criteria they value most when selecting outside counsel for litigation.

In an era of increasing cross-border litigation, in-house counsel either dread or view it as an opportunity. How outside counsel can help them navigate these snare makes a huge difference in whether they get chosen and retained for cases.

Elke Simon, head of patents at German pharmaceutical company Boehringer Ingelheim, told the audience that it is important to prepare for litigation as early as possible.

“For our company, we’ve had different parties chasing us in different countries for compound patents that were about to expire,” said Ms. Simon. “This has meant having to deal with a lot of parties in a lot of countries.”

She recalled that a change in South Korean law in 2011 resulted in more than 40 parties chasing the company on one patent.

“We needed to have oversight of the different parties’ arguments in all the countries,” said Ms. Simon.

In the past, exchange of information and know-how was much less efficient compared to today. This translates into the need to be consistent when facing different parties.

“When we remain consistent, it actually fires back on the parties and creates an opportunity for us,” Ms. Simon said.

Sharing experiences from the car industry, Beatrice Levy-Moulin, IP director at Valeo in Paris, said that while the original equipment component of the business is more focused on specific countries such as Germany, the US and China, the component focusing on the business-to-consumer market is much more diffuse and involves more cross-border litigation.

“Today, with the connected car industry and the dependence on SEPs, it is becoming more difficult to convince management of the need to make different decisions in different countries,” said Ms. Levy-Moulin.

“Sometimes it is better to have something global, but this is difficult.”

For Mark Snyder, head of global litigation and the dependance on SEPs, and licensing have created the uncertainty of whether courts in one jurisdiction can decide rights globally or whether jurisdiction-by-jurisdiction litigation is needed, dragging companies into cross-border disputes. In some countries, with concerns over licensing rights and the creeping in of antitrust law in IP cases, matters are only getting more complicated.

Shifting to counsel selection criteria, Ms. Simon said it is “absolutely the technical expertise that is key in the pharma industry”.

As the sector involves a lot of cross-border work, the ideal counsel must be a team player and able to cooperate with people across multiple countries.

“What is not important is whether the firm is ultra-famous or has a great brand,” said Ms. Simon. “When I work with a great team and they go to a different law firm, I would go with the team.”

In addition to technical expertise, factors she values are business acumen, transparency and honesty.

“For Ms. Levy-Moulin, knowledge of the business is what makes the difference.”

“Quality is linked to expertise and the cherry on the cake is the price,” she said, adding that she focuses on the connection and relationship with the firm, level of transparency, and whether people are fluid and easy to communicate with.

Court room experience is key for Mr. Snyder.

“If you don’t have the experience, we won’t be looking at your firm, but what is critically important to us is the experience in the technology,” he said. “We build a lot of investment into our outside counsel and we train them on everything from licensing to SEPs and FRAND to make sure there is consistency among counsel.”

For large disputes, such as the ones with Apple which involved more than 150 litigation cases globally, the capacity of counsel may be outstripped, so there is a need to find a deep enough bench in major litigation. However, there may be a conflict with adversaries in the same space, so often there isn’t a lot of room for selection.

When two worlds collide: museum copyright in the digital age

S hould photos taken on a smartphone of a museum collection be considered artwork that is protected under copyright law? Does it matter if the photo was taken quickly or if someone had put in a considerable amount of time and thought?

These were the questions raised at yesterday’s session on “The Art of IP: Museums and Architecture”. Panelists offered perspectives on the protection of photos of artwork in the public domain under copyright law in the EU, the UK and the US. There remain differences in the originality requirements, right of panorama and resale right of artists, and the specifics of protection often clash with the public interest.

Thomas Koch, presiding judge at Germany’s Federal Court of Justice, highlighted a German case in which a museum published photos of one of its collections that had an expired copyright. These pictures were subsequently loaded onto Wikipedia and the artist of the collection sued for copyright infringement. Under the Berne Convention and European Directive 2016/116, Article 1(1), copyright protection can be afforded for the life of the author plus 70 years after his death.

Continued on page 4
Iancu: ‘We must drive real change’

In an interview with Rani Mehta, director of the USPTO Andrei Iancu reflects on patent legislation, AI, marijuana and diversity in IP

“applauded members of Congress, particularly Senators Tillis and Coons, for taking on this issue,” says Andrei Iancu, referring to the work on possible legislation to amend Section 101 of the U.S. Patent Act.

Elements of the proposed bill say that “provisions of Section 101 shall be construed in a manner that will not be used to determine patent eligibility under Section 101.”

While no bill has yet been introduced, I believe that any solution should be narrowly tailored to address the problem at hand, without raising new issues that could add new burdens to, and inject even further uncertainty into, the system,” Mr. Iancu adds.

Reflecting on the U.S. Supreme Court’s decision in Alice v. CLS Bank (2014), Mr. Iancu says the case has presented challenges for the USPTO. “In the four years after Alice was decided, Office Actions containing a 101 rejection increased on average by 5%, with increases in the artificial intelligence (AI) areas [by] 22%.”

In January 2019, the USPTO released guidelines on subject matter eligibility. Mr. Iancu says that in the six months after the release of the guidelines, Office Actions containing a 101 rejection decreased on average by 6%, with decreases in AI areas by about 21%.

USPTO and AI

According to Mr. Iancu, AI will bring benefits to the USPTO. He expects AI to reduce administrative costs and highlight the technology’s ability to search for prior art, explaining that the volume of potential prior art is expanding “exponentially.”

The USPTO has also seen AI elements included in patent applications. “We have even seen applications for inventions allegedly conceived entirely by an AI machine,” Mr. Iancu says.

As AI and other disruptive technologies continue to make waves, the USPTO strives to engage the IP community on relevant issues. For example, the USPTO recently issued a request for comments to its stakeholders, seeking feedback on a series of questions related to AI. The USPTO also operates the Patent Examiner Technical Training Program, where technology experts, including scientists and engineers, volunteer to provide technical training and expertise to patent examiners.

Marijuana: patents v. trademarks

While inventors continue to provide new technological resources such as AI, legislatures are contemplating our rights to access existing resources, most notably marijuana.

As more states continue to legalise medical and recreational marijuana in the US, questions have arisen about the role of patents and trademarks in the industry. Mr. Iancu cites a 20 to 40% year-on-year filing growth of cannabis-related patents since 2015.

“There are no special statutory requirements or restrictions applied to patents directed to marijuana. Additionally, there are no exceptions for medical use of marijuana,” Mr. Iancu says.

Although marijuana patents are treated the same as other applications, trademarks are different; because marijuana is illegal federally, federal applications for marijuana-related trademarks are currently ineligible, Mr. Iancu explains.

Still, recent legislation could be relevant for some cannabis-related products. Mr. Iancu highlights the 2018 Farm Bill, which said that “hemp” (defined as cannabis containing less than 0.3% THC) was no longer subject to regulation under the Controlled Substances Act. Because of this, certain products directed to “hemp” could be eligible for federal trademark protection, though this is not guaranteed.

“We still have to look at whether the application raises legality issues under the Food, Drug and Cosmetic Act for cannabis goods that are foods and beverages, and also at the 2018 Farm Bill for certain cannabis-related services,” Mr. Iancu says.

In May 2019, the USPTO issued guidance called “Examination of Marks for Cannabis and Cannabis-Related Goods and Services after Enactment of the 2018 Farm Bill”.

Diversity and patents

As changes in legislation and technology raise questions about how lawyers practise IP law, growing social awareness sparks questions about who is practising IP law.

Encouraging more diversity in inventors and the IP profession itself is a priority for the USPTO, according to Mr. Iancu. The USPTO hosts the Women’s Entrepreneurship Symposium, a free event that brings together industry, government and education leaders to improve the representation of women in scientific research and patenting. In February 2019, the USPTO also produced a report titled Progress and Potential: A profile of women inventors on US patents.

Additionally, the USPTO has helped support the Patent Pro Bono Program, a network of independently operated not-for-profit programmes that match volunteer patent professionals with financially under-resourced inventors and small businesses.

“There is untapped potential in the community, and the USPTO wants to do everything possible to encourage diversity in innovation, create equal opportunities for every inventor, and ensure that all voices are heard,” Mr. Iancu says. “We must advance the national dialogue around this issue and drive real change.”
European supplementary protection certificates (SPCs) and US patent term extensions (PTEs) were hot topics in yesterday afternoon’s Pharma Session 3.

James Horgan, assistant managing counsel of Merck Sharp & Dohme in the UK, told the audience he believes SPCs are an important part of incentivising second medical use research and suggested a digital SPC process could be part of the pending Unified Patent Court framework.

“A European virtual SPC system would give a degree of clarity and this would be a tremendous way to get more harmonisation. Global harmonisation is much more complicated to achieve,” said Mr. Horgan.

Scott Burwell, IP attorney and partner at Finnegan, Henderson, Farabow, Garrett & Dunner in Washington, DC, said it’s an open question how US courts will decide whether biosimilars have the same active ingredient as the original product.

“An innovator in the US might not be able to sell biosimilars in Europe,” said Mr. Burwell. “Yet, a biosimilar might be available in Europe.”

He added that IP lawyers are forced to graph the existing PTE legislation from 1984 to a law that came into effect 25 years later. Turning to Mr. Horgan, Mr. Burwell said: “I’m a little envious because there is so much activity with SPCs in Europe. One case down this morning, but nothing has happened in the US since last year!”

He was, of course, referring to the Court of Justice of the EU’s ruling yesterday morning in the Eli Lilly v Genentech case in which the court refused to rule on the question of whether an SPC can be granted to a third party owner.

“Do you enjoy an early morning run? Then join the AIPPI Running Club. Meeting at the QEII Centre at 6:30am each day of the Congress, the group will enjoy a scenic run around London.”

Richard Thurbin What are a collective of IP lawyers called? “A cornerstone” according to Sir Robin Jacob of @ucl_ibil. As IP lawyers uphold innovation, creativity and societal wellbeing.
“The waiver, including the ability to stockpile medicines for up to six months, is a rather surprising development, particularly given the fact that the EU itself brought a WTO dispute against Canada for allowing manufacturing and stockpiling.”

What are the headline differences in patent term restoration systems across the main IP jurisdictions? In the US, a patent can only be extended one time for development and regulatory review delays, regardless of whether the patent covers more than one product. Furthermore, only one patent can be extended for the same regulatory review period of a product, and the combined remaining patent term plus extended term cannot exceed 14 years. A patent claiming a combination product may be entitled to patent term extension (PTE) as long as one of the active ingredients may be entitled to patent term extension. A patent claiming a combination product plus extended term cannot exceed 14 years. and the combined remaining patent term plus extended term cannot exceed 14 years. The waiver, including the ability to stockpile medicines for up to six months, is a rather surprising development, particularly given the fact that the EU itself brought a WTO dispute against Canada for allowing manufacturing and stockpiling, albeit during the patent term. It is difficult to reconcile the manufacturing waiver with the original basis for creation of SPCs.

What will be the biggest challenge when it comes to managing the provisions of the SPC waiver? There are a few: (1) there are some ambiguities in the new amended regulation, for which we will probably only get clarity after litigation and subsequent court interpretation; (2) the staggered entry into force of the new waiver provisions means some innovator companies are going to be affected first (and will have the attendant uncertainty that comes with seeking clarity via litigation); and (3) the requirement for innovator companies to monitor and ensure the waiver is appropriately used by generics manufacturers is an extra burden to innovator companies, which is not in anyone’s interest (and indeed, is antithetical to the reasons for which SPCs were developed in the first place).

What does the future hold for patent term extensions outside the EU? China has recently introduced a bill that includes patent term extension (PTE) to allow the patent holder to recoup time lost in regulatory review. The proposed term is five years, with a 14-year cap. However, there are some ambiguities in the draft amendment that need to be further clarified. For example, the draft provision appears to include a requirement that the request for MA be submitted simultaneously in China and other countries, which is not practical and would undermine the value of the new provision. As with other provisions of Chinese patent law, the value of a new PTE provision will come down to how it is interpreted and applied in practice.

In Israel, a recent court decision clarified that PTE is available for an antibody product that targets the same antigen as a previously-approved antibody. The Israeli PTO noted that eligibility for PTEs should depend on structural differences between the antibodies (not the antigen to which they bind). Even if such structural differences are insignificant, a patent for a second antibody product may still be eligible for PTE if there are substantial differences in activity.

Manisha Desai moderated a session yesterday called “Hot and hostile: recent developments in SPCs and patent term extensions”. See page 3 for more coverage.

Continued from page 1

Manisha Desai, associate general patent counsel at UCB Biopharma in Brussels, tells Ed Conlon about the patent term extension developments she is monitoring.

However, EU member states may offer other forms of protection in additional provisions. Under the German Act on Copyright and Related Rights, copyrights shall expire 50 years after a photograph was released. The question at the heart of the case was whether it was necessary to have a creative achievement in the production of the photo. For instance, would there be a difference in the copyright protection offered if the artwork was photocopied on a copying machine or if someone had taken a quick snapshot on a smartphone? Under German law, the creative achievement would be missing if it was only a reproduction of an existing photo.

“The requirements for protection are low, but the protection itself is also low and would only protect against identical production,” said Mr. Koch.

The Federal Court of Justice rejected the view of the lower court and the claimant was successful. However, a 2019 EU directive, which will be in place in the next two years, could change the landscape. Under this Directive, if the copyright of an artwork has expired, reproduction of it will not be subject to copyright protection unless the production was original and the author’s own creation. If the work itself is a work of art, it will be protected, whereas photos of it will not be protected.

Dr. Elenora Rosati, associate professor in IP law at Stockholm University, said that museums are increasingly using digital collections to attract visitors, and asked whether protection should be given.

“The Court of Justice of the EU has taken the view that EU law requires originality and, to get copyright protection, a work should carry a personal touch of the author,” said Ms. Rosati.

For a digital museum collection, these features may include the need for skill and effort, whether there is originality, and how much investment was put in. According to Dale Nelson, partner at Donaldson & Callin in the US, no one has challenged the copyright of photos of artwork or the creativity aspect of these photos, except in the famous monkey selfie case. However, there is a pending case involving Ariana Grande, who used paparazzi photos taken of her and posted them on Instagram.

Christian Zimmerman, CEO at DACS, a UK-based non-profit visual artists’ rights management organisation, explained that under UK copyright law, photos would be protected but the new EU directive might call this into question.

In the UK he has noticed a trend for museums to allow people to take photos and post them online.

“Since the change in the copyright law in 2014, museums have been jumping on the bandwagon to let people freely take pictures and have even curated them and posted Instagram exhibitions,” he said.

They’ve been doing this to get more views and generate more publicity for exhibitions.

And technological solutions to get around the copying of photos by watermarking images and using lower resolution images so that they are less likely to be re-used are also becoming more prevalent.

What is clear, Mr. Zimmerman said, is that these actions and reactions have had an impact on what qualifies as art.
Your reliable partners for intellectual property matters in Pakistan, South East Asia, Arabian Gulf, Middle East & Africa

SINCE 1949

UNITED TRADEMARK & PATENT SERVICES

International Intellectual Property Attorneys

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

Pakistan Office
85 -The Mall Road, Lahore 54000 Pakistan  (Opposite Ferozesons books store / adjacent rado time center)
Email: UnitedTrademark@UnitedTm.com  Websites: www.utmtps.com and www.unitedip.com

Gulf, Middle East, South & East Asia and African Offices

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

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

OMAN
Suite No. 702, 7th Floor
Oman Commercial Centre, Ruwi
Tel : +968-24-787555, 704788
Fax: +968-24-794447
Email: Oman@UnitedTm.com

QATAR
Villa # 40, Al Amir Street
Al Mirgaz Area, Doha, Qatar
Tel : +974-444 3083, 444 3093
Fax : +974-744 7311
Email: Qatar@UnitedTm.com

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

SAUDI ARABIA
Behind Maktaba Al Shawwaf
30th Street-Olaya, Riyadh 11444
Tel : +966 -11- 4616157, 4655477
Fax : +966 -11- 4616156, 4622134
Email: saudiArabia@UnitedTm.com

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

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

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

YEMEN
6th Floor
Ideal Clinic Building
Hadda Street, Sana’a, Yemen.
Tel: +967 181 9642
Email: yemen@UnitedTm.com
If you fancy some downtime from the Congress, why not explore London’s many attractions, as **Sanjana Kapila** explains.

**Theatre**

The atmosphere at Shakespeare’s Globe Theatre, a replica of the theatre for which Shakespeare wrote his plays, is unique. Attending the Globe is an immersive experience, with audiences shuttled back to Shakespeare’s era. It is possible to purchase either standing or sitting tickets. During the Congress, a number of plays are being shown, including *The Merry Wives of Windsor* and *As You Like It*. A visit to the Globe is a chance to access England’s history and literary heritage. The National Theatre, which also showcases excellent productions, is located on the South Bank of the Thames, which offers lovely views of the river. If your preference is for more niche theatre, Southwark Playhouse frequently puts on interesting productions with a more intimate atmosphere.

**Art and museums**

London is full of wonderful galleries and museums including the National Gallery, the Royal Academy, the Victoria and Albert Museum, and the Natural History Museum. The National Gallery has works by Cezanne, Monet, Michelangelo and Da Vinci. By comparison, the Tate Modern is a modern art lover’s dream. It contains works by Picasso, Warhol, Dalí and Rothko.

**Eating**

As one of the most cosmopolitan cities in the world, finding a restaurant of any type is not difficult in London. Recommendations include Hoppers (Sri Lankan), Dishoom (Indian) and On the Bab (Korean), not forgetting Hawksmoor (British). If you fancy Japanese food, Eat Tokyo is authentic and sensibly priced. The Gate and Mildreds are two fantastic vegetarian restaurants, with a focus on healthier food.

**Parks**

London can seem a polluted and built up city until one realises that beneath its smoky surface lies plenty of natural beauty. The likes of Regent’s Park, Hyde Park and St James’s Park offer a verdant escape from the hustle and bustle of the city. Kew Gardens, though outside the centre of London, has a plentiful supply of exotic plants for those interested in botany. Richmond Park’s rugged landscape is also worth exploring if time allows.

**Other major sights**

Other attractions in London include Buckingham Palace, the London Eye, the Tower of London, Big Ben, the Houses of Parliament, Madame Tussauds, St Paul’s Cathedral, the Cutty Sark and the Royal Opera House.

**Bookshops**

If you are seeking a quiet day of reading, London has plenty of well-stocked bookshops. Waterstones on Gower Street is particularly well equipped as it caters for the student body of the nearby UCL. If you are searching for a rare book, you will be able to find it here. Indeed, it is possible to spend hours perusing the books at the store. Another bookshop worth visiting is the Foyles flagship store on Charing Cross Road. This has a lovely café in which you can browse any material found during your visit to the shop.

**Shops**

London offers all manner of shops, from clothing boutiques to retail chains. Oxford Street and Regent Street house some of London’s best and biggest, including major department stores like Selfridges, Harrods and John Lewis. If you are in search of boutiques, Notting Hill has a number of smaller stores, as well as French shops including Sézane.

**Days out**

London is within easy travelling distance of a number of other parts of England, including Oxford and Cambridge, home to two of the most famous universities in the world. Fast trains will ensure you reach these destinations within an hour and you can then spend the day becoming acquainted with the architectural delights of the cities and their quaint streets and colleges.
Yesterday’s Pharma Day session I began with moderator Jérémie Jourdan, partner at White & Case in Brussels and Paris, raising objections to how IP regulators characterise ‘pay for delay’. He offered an alternative title of ‘patent settlement agreement where parties settle based on different elements of litigation’.

“But I’m afraid it doesn’t have the same nice ring to it as ‘pay for delay,’ said Mr. Jourdan. Pay for delay is a controversial technique whereby pharma innovators pay generic companies to delay bringing their drug to market. This method of avoiding litigation is a red flag for regulators interested in enforcing anti-competition laws.

Mr. Jourdan argued that rather than seeing pay for delay as a means to protect an undeserved monopoly, it should be reframed. “One part of litigation is the right to settle; if there is the opportunity the company should be able to do so,” said Mr. Jourdan. “IP rights do not provide immunity from competition law. Rather, the competition law protects the consumer, and it is in the public interest to remove bad patents with pay for delay.”

Erin Dunston, shareholder at Buchanan Ingersoll & Rooney in Pittsburgh, described the origins of pay for delay as the ominous paragraph IV of the US Drug Price Competition Act. Under paragraph IV, generic companies assert to the FDA that their proposed generic product is free to enter the market either because the originator’s listed patent(s) are invalid or they are not infringed by the proposed generic product. Innovators then have 30 days to bring a case against the generic company to obtain a “30-month stay” in which the generic product cannot be approved by the FDA, and thus cannot be brought to market. Instead of litigating, some manufacturers simply decide to pay their competitor to go away.

“The stakes are very high, and it is tempting for the brand to pay the generic to stay off the market,” said Ms. Dunston. “The phrase ‘reverse settlement’ has come about when the brand pays the generic.”

The US Supreme Court ruled in 2013 in Actavis v FTC that patent protection does not override antitrust law. In that case the size of the settlement, $30 million per year to delay the rollout of a generic medication, was deemed too steep and unethical for society.

With the ruling, the courts said the size of the damages relative to the payer’s expected costs was an important criterion for establishing anti-competitive behaviour. You can pay your competitor to stay off the market, but it better not be an outrageous sum of money, it seems.

Takanori Abe, partner and founder of Abe & Partners in Osaka, humorously told the audience that Japan has no history of pay for delay because of the country’s corporate culture. “They are afraid of offending the Ministry of Health so we have zero cases in Japan,” he said.

The panel concluded the session by asking what sort of payment for damages is acceptable. “Does the size of damages matter?” asked Mr. Jourdan. “If you don’t get a benefit, why would you settle? You only settle if you get something.”
Analysing India’s unique patent law provisions

Manisha Singh and Joginder Singh of LexOrbis analyse India’s unique patent law provisions, including those relating to foreign filing licences and the working statement

In recent years, India has attracted worldwide attention with the continuous evolution of its IPR ecosystem. The overall strategy of bringing in new policies and progressive amendments clubbed with rapid implementation are some of the dominant factors responsible for this attention. Accordingly, a gradual increase has been witnessed in the number of filings of patent applications in India over the years. Be it the national IPR policy, regular amendment of rules and provisions, benefits to start-ups, evident efforts to expedite the patent examination process, or encouraging transparency at the patent office, the government is improving the IPR ecosystem to facilitate the process of doing business in India. Like any other jurisdiction, there are certain provisions in India’s patent law which are unique to India only. This article aims to familiarise readers with such unique provisions.

Foreign filing licence

One such unique provision relates to the requirement of the foreign filing licence (FFL). FFL is to be sought if at least one of the inventors is a resident of India at the time of conception of the invention and the applicant wishes to first file a patent application outside India. It is pertinent to note that the Indian Patent Law does not define ‘inventor resident in India’ and therefore, the Indian Patent Office (IPO) checks compliance with the above-mentioned requirement based on the address of the inventors. Along with a request for FFL, the applicant is expected to provide the IPO with a brief write-up on the invention describing the scope and the nature of the invention. In response to the request for FFL, the IPO has to pass its judgment on the issuance of the FFL within 21 days from the date of request. The purpose of this provision is to provide an opportunity to the IPO to ensure that the invention going outside the country does not relate to sensitive technologies, such as defence or atomic energy, which can be detrimental to national security. Alternatively, applicants can first file an application in India and wait for six weeks before filing a foreign application claiming priority from the Indian application. During this duration of six weeks, the IPO informs the applicant if they have any objection with regard to the content of the patent application. If the applicant does not receive any communication from the IPO within the aforesaid period, they are free to file corresponding applications in any foreign jurisdiction, including PCT.

National phase entry and voluntary amendments

Every year, most foreign applications enter Indian jurisdiction through the PCT route. Earlier, the Indian Patent Law did not allow any amendments to be made to the specification at the time of national phase entry. However, in 2016, the relevant provisions were amended to allow the deletion of claims at the time of filing a national phase application. The amended provisions allow the applicant to save excess claim fee (approximately US$25 per extra claim) that is otherwise to be paid for each claim exceeding 10 claims in India. For example, the applicant can consider cancelling claims directed towards a subject matter that is non-patentable in India, such as a computer program product or a method of treatment. Therefore, the applicant ends up saving the excess fee while simultaneously quickening the prosecution process by deleting non-patentable claims. Apart from the deletion of claims, any other amendments, for example, merging of two or more claims, addition of new claims, and any corrections in the claim language, are still not allowed at the time of filing the national phase application. Such amendments can be filed as paid voluntary amendments immediately after filing the national phase application. Further, while filing the voluntary amendments, applicants should bear in mind that voluntary amendments, which broaden the scope of claims or completely replace the claims-on-record or are not supported in the specification, are not allowed.

Divisional applications

The practices relating to divisional applications in India are also somewhat different compared with other major jurisdictions. In India, a divisional application can be filed either in response to an objection for lack of unity or voluntarily, but only before the grant of its parent application. Further, there is no procedure prescribed in law for the IPO to issue a prior “notice of allowance” or “intention to grant” for an application to the applicant. Therefore, a sudden grant of a parent application blocks the opportunity for the applicant to pursue a divisional application. Accordingly, divisional application(s) should be filed at the earliest opportunity or at least while filing a response to the First Examination Report (FER) because the patent application can thereafter be directly granted if the response successfully addresses all the objections raised in the FER. In case any objection remains outstanding after the response, a notice for oral hearing is issued, which practically extends the time window to file a divisional application. Regarding the content of divisional applications, the law mandates that a divisional application is considered valid only when there are multiple inventions disclosed in the parent application and the claims of the first application and the divisional application are distinct. Otherwise, the IPO may raise an objection of double patenting at the time of examination of the divisional application.

Section 8 of the Indian Patents Act

Once an application is filed, it is necessary to ensure compliance with Section 8 of the Indian Patents Act. Section 8 read with Rule 12 of the Patent Rules imposes two requirements on applicants. The first requirement arises from Section 8(1) read with Rule 12(1), 12(1A), and 12(2) that requires applicants to inform the IPO about the details of all related applications on a voluntarily basis and also when asked by the IPO through an examination report or a hearing notice. The details to be provided to the IPO at the time of filing the Indian patent application or within six months from the filing of the Indian patent application. After that, the details can be provided within six months from the filing of a related application, if any, filed after filing in India. The details include country name, application date, application number, application status, publication date, and grant date.

The second requirement arises from Section 8(2) read with Rule 12(3) that requires the applicants to submit: (1) claims allowed and (ii) information relating to objections raised in related applications for all/major jurisdictions, only when specifically asked by the IPO through an examination report or a hearing notice. The documents under the second requirement are to be submitted within six months from the date of receipt of such request from the IPO. It is pertinent to note here that cited references are not required to be submitted to the IPO on the lines of the IDS requirement of USPTO. Rather, only the granted claims and objections raised in office actions, need to be provided to the IPO to comply with the present requirement.

Last year, IPO issued an office circular directing examiners to access the WIPO Centralised Access to Search and Examination (CASE) system and use the system to search for patent applications at other participating offices and to retrieve the documents that are made available by those offices. IPS offices, i.e. US, EP, JP, KR, and CN are the Providing Offices of WIPO CASE and therefore, the search and examination reports of the applications examined by these patent offices are accessible by the examiners at IPO. In view of the aforesaid office circular, IPO has significantly reduced issuing objections asking for the documents under Section 8(2).

Working statement

Another unique provision in the Indian Patent Law is the requirement of working statement. The Indian Patent Law mandates that the applicant must submit a working statement reflecting the extent of working of the patent every year. This is to ensure that the patent is being commercially used to the fullest extent and serving its intended purpose. If the patent is not working in India for three years from the date of grant of the patent, it opens the window for persons interested to seek compulsory licence from the patentee to work the invention. Therefore, in order to avoid any undesirable consequences, it is recommended that the applicants diligently comply with this provision. However, the applicants usually find it difficult to furnish required information for multiple reasons, such as confidentiality of data involved and complexity in determining the exact extent of working of the invention. Recently, the Delhi High Court while disposing a writ petition directed the government to effectuate necessary amendments to the Patent Rules to regulate the working statement requirement in India. In compliance with the directions of the Hon’ble Court, the government has proposed to simplify the format of working statement to some extent. Considering that the consultation with stakeholders is still ongoing, it would be fair to expect that the final format of the working statement will further be simplified with the intent of ensuring convenience to patent owners in times to come.

India has a TRIPS compliant, equitable, robust, and dynamic IPR regime. As this regime goes through changes to meet the demands of a new age, the importance of constructive participation of stakeholders should be acknowledged to achieve the objective of harmonious synchronisation of local IP laws with ever-changing needs. Considering the persistent efforts of stakeholders that have been witnessed in recent years, it is reasonable to expect an improvement in the IPR regime in a way that promotes innovation and creativity not only in terms of IP awareness and creation, but also in terms of commercialisation and enforcement.

Manisha Singh

Manisha Singh is a co-founder and partner at LexOrbis. Manisha is a distinguished lawyer with over 21 years of experience. She handles dispute resolution for a wide range of clients. As an IP attorney, she has the unique distinction of practising IP at both the prosecution and enforcement level. Manisha is also known for her skill at formulating and implementing strategic IP programmes that sync with business policies of large, medium and small entities. Her rich experience in all aspects of this area is reflected in her prolific academic and professional contributions. She is a member of many significant forums and professional bodies in India and abroad and has been routinely invited to author articles and commentaries on contemporary policies and issues by national and international publications. Manisha is ranked among the leading lawyers in IP and dispute resolution by leading law journals and publications.

Joginder Singh

Joginder Singh is a partner at LexOrbis, managing the engineering patent practice. He holds a graduate degree in computer science and diplomas in related subjects. He is a registered Indian patent agent with about 12 years of experience in providing end to end patent services including search and analytics, drafting, prosecution, and litigation support. He works with national and international clients to build their patent portfolios. He is a regular speaker at various conferences and has published a number of articles on patent-related subjects.
Everyone in AIPPI is tilted slightly to the left, jokes Marek Lazewski, incoming secretary general. Rather than being an insult, it means the left side of the brain – associated with analytical and logical thinking – tends to dominate those in the association.

However, he says, he would like there to be a better balance by focusing on soft skill development. As part of this process, activating younger members is an important challenge, Lazewski adds. On Saturday, there was a session on soft skills training for young members, and Lazewski says it’s important to focus on effective communication. The London Congress has a record-breaking number of young attendees. “We’re going to have great future leaders,” he adds.

Another challenge is boosting efficiency, says Lazewski, who admits that AIPPI has historically had an overly complex structure. While there is a lot of expertise tied up in the association, complexity makes it hard to be efficient.

But Mr. Lazewski says there have been lots of structural changes in the past few years and an increased focus on streamlining operations. There is also the 2017-2020 Strategic Plan, where there are numerous objectives such as moving “quickly to formulate and communicate positions by contributing its user association perspective to external consultations, undertaking studies and preparing position papers”.

For the past nine months, an AIPPI Bureau taskforce has been looking at the operational tasks needed to complete what AIPPI set out in the plan. “It’s challenging deciding what to do and not to do; you cannot do all and be everything to everyone,” he says.

AIPPI is seeking the right balance between volunteer and professional support, he adds. Historically, the association has been run mostly by volunteers; Mr. Lazewski himself is a partner at the Polish law firm LDS Lazewski Depo & Partners.

He believes AIPPI is making positive strides in achieving the balance, highlighting the hire of Arno Hold as executive director in August 2018. In an interview for last year’s Congress News, Mr. Hold said his responsibilities include coordinating closely with various AIPPI bodies to implement strategy and policy decisions, and further developing AIPPI’s relations with external partners in the IP world.

Lazewski says that “every little step we take” helps to push the association forward. For example, an IT and website taskforce is trying to improve member services and communication tools, he adds, remarking that “it’s amazing how we fall back on emails; very quickly you have 50 versions of the same document”.

“It’s the little things like that,” he says. “If we can improve, we can leverage our substantive competence distributed in the membership of this great association.”

“If we can improve, we can leverage our substantive competence distributed in the membership of this great association.”
In yesterday’s session “Describe Your Best Defence: Trade Mark Infringement or Not?”, in-house and private practice lawyers shared case studies and strategies for brand owners when they are faced with parties, including director competitors, that claim fair use as a defence.

In China, Ying Mu, partner at Global Law Office, said that Articles 59.1 and 59.2 of the PRC Trademark Law stipulate the circumstances for descriptive fair use in China. Parties do not have the right to prohibit others from using the generic name, graphics or models of a commodity.

A recent case in China involved Dreamworks’ Kung Fu Panda movie trademark and a Chinese company that had registered a mark using the Chinese translation of Kung Fu Panda and claimed fair use. The Supreme People’s Court outlined the decisive elements in deciding whether there is descriptive and fair use. These decisive elements include whether the use is in good faith, when the trademark was first used and whether the mark is used in a prominent way. Although the intention of a user plays a role, it is hard to define and often poses a challenge for brand owners.

According to Maria Scungio, partner at Robinson+Cole in New York, under the Lanham Act, Section 33 (b)(4), fair use is identified as a defence. Factors that the court considers include whether products have been competing with each other, how pervasive the products are and how long they have been in the market.

Ms. Scungio said that because US statutes are complemented by commercial behaviour in the market, factors that are important to consider are proof of use and the context of use in the past and future, to show consistency.

“You need to look at the continuum relative to the company itself and the market,” said Ms. Scungio.

She added that US trademark laws blend in unfair competition in the statutes and make it challenging to draw the line between unfair competition and passing off.

The likelihood of confusion is another factor that brand owners have to consider in descriptive use cases.

Kathy Atkinson, legal director of Kettle Foods in the UK, shared the example of when the company was involved in trademark infringement proceedings in the Netherlands. The case centered on the use of the words ‘Kettle Cooked’ by Intersnack as a cooking method description of potato chips. The court ruled in favour of Intersnack and said that Dutch consumers would understand ‘Kettle Cooked’ to be a description of the cooking method and that the average consumer would have a sufficient grasp of English to understand the words to mean cooked in a kettle.

Kettle Foods only had 2% of the total market share and its reputation was not sufficient to entitle it to enhanced protection as a famous trademark. However, with trademark laws being territorial, the company has had success and settled cases in other parts of Europe, including Italy, Spain and Belgium.

Ms. Atkinson added that in establishing generic use, having evidence is key.

“Actual confusion is like gold, so bringing the evidence forward will always help you; if not, argue for the likelihood of confusion, but sometimes, it would just be on an academic argument rather than actual evidence,” said Atkinson.

As a final tip for brand owners, Ms. Atkinson said: “Jump on anything you see and don’t let it take hold. Take action in every case and never rest.”
A look into London’s IP archive

The Tube map and colour film point to London’s rich IP history, as Managing IP finds out

Protecting the London Underground

Transport for London, which manages the Underground network, has more than 100 trademarks. It also has copyright protection for the instantly recognisable London Underground map – designed by Harry Beck in 1931. As far as trademarks go, the name of each line is protected, as is the ‘roundel’ underground logo which you will have undoubtedly seen on your travels, and various other underground-related items you might encounter such as ‘Oyster’, the name of the travel pass, and ‘Tube’ – the underground’s affectionate nickname. Even the distinctive phrase ‘Mind the Gap’ has trademark protection. If you want to hear one of the original usages of that phrase, recorded in the late 1960s and with a quintessentially Queen’s English accent, Embankment station on the Northern Line is the place to visit. Most others have since opted for an updated recording of “Please mind the gap between the train and the platform” (but this is not trademarked).

A central book of copyright

London was the centre of one of the first centralised copyright enforcement systems in the world. The Stationer’s Company, a guild of media workers established in 1403 that is now based near St Paul’s Cathedral, was given a royal charter in 1557 that gave it the right to search for and seize illicit or pirated works. All new titles were entered into the ‘entry book of copies’ (also known as the Stationer’s Register), and that act ensured that no other members could copy and publish those works. In 1562, the guild was given the power to require all lawfully printed books to be entered onto its register, and that document became the written record to which copyright disputes could be referred. The Stationer’s powers gradually diminished after the Copyright Act of 1709, but compulsory registration only ended in 1923.

Bringing film to colour

In 1906, London-born George Albert Smith patented a technique called kinemacolor using only red and green pigments to bring films to colour. At the time of his invention, movies were shown only in black and white, and his technique led to full technicolour films years later. Smith developed films for the Natural Colour Kinemacolor Company from a cinema in Wardour Street in London’s Soho, which quickly became the centre of London’s movie industry. This started a trend and, by 1920, Soho had 20 different film companies. Interestingly, Smith’s kinemacolor technique was targeted in a patent lawsuit in 1914 by William Friese Greene, an inventor and photographer.

Lutenists fight back

London’s Renaissance music scene was dominated by lute player-composers, particularly John Dowland (1563-1626), whose greatest hit ‘Flow my Tears’ was recently recorded by Sting. Much of their work was split between court and the theatre, particularly on the then notorious South Bank at Shakespeare’s Globe. Owing to the commercial nature of theatre and the value of popular songs to bring in crowds, lutenists had a hard time stopping their work being copied by other instrumentalists, especially the early keyboard (spinets/virginals) players. The lutenists’ solution was to use a notation system that only they could read: tablature, with six lines showing a map of the strings on the fretboard – nonsense to any non-lute player, but still used today by modern lutenists and flamenco and rock guitarists.

Client attorney privilege resolution gets green light

A resolution seeking to extend minimum standards on Client Attorney Privilege beyond patents to other forms of IP was approved overwhelmingly during a plenary session yesterday.

Voters approved the resolution by 135 to 0, with 2 abstentions, after making minor amendments to the text.

Andri Hess, chair of the Standing Committee on Client Attorney Privilege (CAP), introduced the topic by explaining that the CAP term is “not entirely clear”. He added that there are different concepts of it ([CA P], introduced the topic by explaining during a plenary session yesterday.

W hile the initial resolution only specified that CAP should apply to patents, there was some desire for other forms of IP, such as trademarks and designs, to be covered too. After some brief discussion from the floor, voters backed amended wording so that the resolution specifically mentions utility models as well. Next came voting on the requirements that IP advisers should meet to qualify for CAP. According to the draft resolution, the requirements should be made available on a public register and should not include any limitations that deny protection because the adviser is not domiciled in, or a national of, that nation. Both elements were approved unanimously, before the entire resolution was passed.

Mr. Hess, who was joined by other members of the Standing Committee on CAP, explained that the B+ delegations that proposed the resolution intend to bring it to the whole of the B+ group in October 2020.
<table>
<thead>
<tr>
<th>Time</th>
<th>Event Description</th>
<th>Location</th>
</tr>
</thead>
<tbody>
<tr>
<td>07:30 – 08:30</td>
<td>Wolters Kluwer Breakfast Session - Genuine use of trademarks</td>
<td>Abbey</td>
</tr>
<tr>
<td>09:00 – 12:30</td>
<td>Plenary Session for proposed Resolution (2): Study Question on Consumer survey evidence</td>
<td>Whittle/Fleming</td>
</tr>
<tr>
<td>09:00 – 10:30</td>
<td>Meet the IP Offices</td>
<td>Westminster</td>
</tr>
<tr>
<td>09:00 – 10:30</td>
<td>Panel Session V: BREXIT &amp; IP: an update</td>
<td>St James</td>
</tr>
<tr>
<td>10:30 – 11:00</td>
<td>Coffee break</td>
<td>Exhibition Area</td>
</tr>
<tr>
<td>11:00 – 12:30</td>
<td>Panel Session VI: Forming portfolios for FRAND licensing: who decides?</td>
<td>St James</td>
</tr>
<tr>
<td>11:00 – 12:30</td>
<td>Panel Session IX: Seize the day – customs &amp; border control</td>
<td>Westminster</td>
</tr>
<tr>
<td>12:30 – 14:00</td>
<td>Lunch 2: IP in fashion: iconic products, influencers, greenwashing and design lifecycles</td>
<td>Churchill</td>
</tr>
<tr>
<td>12:30 – 14:00</td>
<td>Networking Lunch</td>
<td>Central Hall Westminster</td>
</tr>
<tr>
<td>14:00 – 17:30</td>
<td>Plenary Session for proposed Resolution (3): Study Question on IP damages for acts other than sales</td>
<td>Whittle/Fleming</td>
</tr>
<tr>
<td>14:00 – 15:30</td>
<td>Panel Session VII: Post-grant amendments: flexibility or certainty?</td>
<td>St James</td>
</tr>
<tr>
<td>14:00 – 15:30</td>
<td>Panel Session X: Right on the money – IP &amp; finance</td>
<td>Westminster</td>
</tr>
<tr>
<td>15:30 – 16:00</td>
<td>Coffee break</td>
<td>Exhibition Area</td>
</tr>
<tr>
<td>16:00 – 17:30</td>
<td>Panel Session VIII: Patents and Artificial Intelligence: what’s next?</td>
<td>St James</td>
</tr>
<tr>
<td>16:00 – 18:00</td>
<td>In-House Meeting</td>
<td>Westminster</td>
</tr>
<tr>
<td>18:30 – 19:30</td>
<td>VIP reception</td>
<td>House of Commons</td>
</tr>
</tbody>
</table>