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International Association for the Protection of Intellectual Property
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AIPPI Bureau

New Bureau of AIPPI

(Laurent Thibon, Secretary General)
On 17 September 2014, the Executive Committee of AIPPI elected a new Bureau of AIPPI.

AIPPI 2014 Toronto Congress

AIPPI 2014 Toronto

(Felipe Claro, President of AIPPI)
The recent AIPPI Congress in Toronto, from 14 to 17 September, 2014, attracted more than 1600 attendees and resulted in a wonderful gathering where attendees not only shared professional work and participated in IP debate, but also shared a friendly and attractive environment. This Annual Congress will also be remembered for its brilliant organization.

AIPPI Toronto thanks you

(Philip C. Mendes da Costa, Chair Organizing Committee)
On behalf of the Toronto Organizing Committee, AIPPI Canada as well as AIPPI, I would like to thank all of the participants and accompanying people who attended this year's Congress. We have appreciated all of the positive comments we have received. It was a pleasure to have been able to act as host this year. See you in Rio!

Resolutions adopted in Toronto

(Sarah Matheson, Reporter General of AIPPI)
The delegates at the 2014 Congress in Toronto last month adopted five Resolutions on various questions of intellectual property law. Each resolution provides important guidance for further harmonisation of relevant laws. The first question, Q238, looked at patent protection for second medical use and other second indication claims. The second question, Q239, examined the basic mark requirement under the Madrid System. The third question, Q240, concerned exhaustion issues in copyright law. The fourth question, Q241, analysed the effect of insolvency on IP licences. Besides the Resolutions emerging from those regular working questions, AIPPI also adopted a Resolution on prior user rights, following on from the Resolution adopted at the Forum/ExCo meeting in Helsinki in 2013 on the grace period for patents.

The texts of the adopted Resolutions are available on our website and here. A summary of the Resolutions can be found here.

The Resolutions will now be disseminated by the Bureau and the National and Regional Groups to all relevant authorities and bodies so that they may make use of them.

Workshops: Presentations are now available online

(Sarah Matheson, Reporter General of AIPPI)
The Toronto Congress offered 13 workshops covering a wide variety of topical issues in intellectual property, including patenting of computer implemented inventions; use of survey evidence in trademark cases, cross-border infringement of IP rights; and copyright aspects of embedding, framing and hyperlinking. Further highlights included a workshop on 3D printing, complete with a live demonstration; and a mock international arbitration featuring a design dispute argued by experienced plaintiff and defendant teams, and judged by an expert panel of arbitrators. A welcome late addition to the workshop programme was made possible by the recent US Supreme Court decision in the Aereo case, hailed as a victory for broadcasters.

Continuing to build on the success of "Pharma Day", one stream of four workshops was devoted to current issues in the pharmaceutical industry, including biosimilars, patent term extensions and SPCs, and patent linkage. Topically, in light of the Apotex v Sanofi-Aventis appeal currently before the Supreme Court of Canada (in which AIPPI has been granted leave to intervene) the fourth Pharma workshop considered the requirements for disclosure of utility/industrial applicability and the ramifications for patent validity. A description of the Toronto Congress workshops, speakers and their presentations are available here.

Standing Committee Reports and Presentations are available online

(Sarah Matheson, Reporter General of AIPPI)
The annual reports of AIPPI's Special Committees (now to be called "Standing Committees") received by the Reporter General prior to the Toronto Congress were made available to all ExCo participants, and are now available online here. A number of Standing Committees also delivered presentations on their work during the year which are available here.

Of particular note are two substantive additional reports, prepared by the Standing Committee on Standards and Patents and the Standing Committee on IP & Green Technology, respectively. Each contains detailed findings and recommendations. As such, they provide a basis for further consideration with the objective of reaching resolutions in support of international harmonisation of laws and best practices in their respective areas. Those reports can be found here.

AIPPI Congress News of Toronto 2014

(AIPPI General Secretariat)

• Monday 15 September 2014

• Tuesday 16 September 2014

• Wednesday 17 September 2014

Membership Committee report

(AIPPI General Secretariat)
Please see the Membership Committee Annual Report for AIPPI Congress 2014.

Communications Committee report

(AIPPI General Secretariat)
Please see the Communications Committee Annual Report for AIPPI Congress 2014.

Your opinion is important to us

(AIPPI General Secretariat)
Give us your feedback on the latest AIPPI Congress 2014

Forthcoming Events

October 2014: AIPPI booth at AIPLA Annual Meeting, Washington, 23-25 October 2014

(AIPPI General Secretariat)
AIPPI will be at the AIPLA annual meeting. Come and visit us at booth no.40 in the Exhibition hall to gather information and gadgets of Rio de Janeiro, Brazil and Milan, Italy (Host cities of the AIPPI events in 2015 and 2016).

November 2014: FICPI 15th Open Forum, Barcelona, 5-8 November 2014

(FICPI)
The FICPI 15th Open Forum in Barcelona will take place on 5-8 November 2014. More information is available at www.ficpi.org.

November 2014: Indo-European conference on ICT related patents at EPO in Munich on 7 November 2014

(EPO)
The European Patent Office (EPO) and the Department of Electronics & Information Technology (DEITY) together with the Ministry of Communication & Information Technology from the Government of India, will jointly organise a high-level " Indo-European conference on ICT-related patents" at the EPO in Munich on 7th November 2014.

The programme foresees participation by senior Indian government representatives, the heads of EPO and the Indian Patent Office as well as many prominent experts from India and Europe. Please refer to www.epo.org/learning-events/events/conferences/indo-european.html for further details.

November 2014: APAA 63rd Council Meeting, Penang, Malaysia, 8-11 November 2014
(APAA)
APAA 63rd Council Meeting, Penang, Malaysia, 8-11 November 2014 view details

November 2014: The CEIPI (Center for International Intellectual Property Studies) is celebrating its 50th Anniversary, 27-28 November 2014
(CEIPI)
The CEIPI (Center for International Intellectual Property Studies) is celebrating its 50th Anniversary. At this occasion, the CEIPI organizes an international conference on the theme “Perspectives for the Intellectual Property System in a Globalized World”. Please click here to see the flyer. This event will be held on November 27th and 28th 2014 at the Council of Europe (Strasbourg, France). Please click here more information.

November 2014: ASIPI XVIII Work Sessions and Administrative Council and 50th Anniversary, Mexico City, Mexico, 30 November 2014 - 03 December 2014
(ASIPI)
ASIPI XVIII Work Sessions and Administrative Council and 50th Anniversary, Mexico City, Mexico, 30 November 2014 - 03 December 2014

December 2014: IP Summit 2014, Brussels, 4-5 December 2014
(Premier Cercle)
AIPPI is supporting the IP Summit 2014, which will be held in Brussels on Thursday 4th and Friday 5th December 2014. AIPPI members will be granted a 33% discount on the registration fee. More information here.

December 2014: When Trademarks Overlap with Other IP Rights. Grand Munich in Munich, 8-9 December 2014
(INTA)
The International Trademark Association’s (INTA) When Trademarks Overlap with Other IP Rights conference will take place at the Hotel Westin Grand Munich in Munich, Germany on 8 - 9 December 2014. The lack of harmonization in legislative policy and judicial thinking has led to a patchwork of protection. Some badges of origin seem to be protected several times over while others risk missing protection entirely. How do trademark owners strike the right balance? This conference promises to tackle the emerging issues in the area of trademark and other intersecting rights. For more information on program, speakers, panel discussions and registration, please visit INTA website at: www.inta.org/2014tmoverlap.

Articles and notes

Australia: A dichotomy in legal outcomes makes for rocky roads ahead
(Tania Obranovich and Chris Vindurampulle, Watermark Intellectual Asset Management, Melbourne, Australia)
The patentability of isolated genes remains a contentious issue. The recent emergence of a significantly different standard for patent eligibility in the US relative to Australia, and most other jurisdictions, creates commercial uncertainty. This has the potential to undermine investment and innovation in the biotechnological and pharmaceutical sectors.

Colombia: Trademark registration highway in Colombia
(Margarita Castellanos, CASTELLANOS & CO., Bogotá, Colombia)
The national trademark office of Colombia is trying to become one of the fastest offices to prosecute trademark applications in the world. In order to achieve this goal, it issued resolution No. 48348 of August 10, 2014, by which it will be possible to grant trademark registrations in less than six months.

European Union: No restrictive interpretation of grounds for exclusion three-dimensional trademarks
(Tobias Cohen Jehoram, De Brauw Blackstone Westbroek, Amsterdam, The Netherlands)
The ECJ has handed down its decision in the *Hauck vs Stokke* case, in which the Court considers that the grounds for exclusion of three-dimensional trademarks should not be interpreted restrictively. Obtaining a valid three-dimensional trademark registration in the EU may now prove even more difficult than before.

Italy: The Court of Milan in Sanofi v. Teva “repeats” the CJEU judgment in Actavis

(Elena Martini, Elena Martini, Milan, Italy)
The Court of Milan decided the case filed by Sanofi against Teva for alleged infringement of SPC ‘653, covering the Sanofi CoAproval medicine. The decision found SPC ‘653 invalid, conforming to the judgment of the CJEU in *Actavis.*

Japan: Re-introduction of post-grant patent opposition in Japan

(Hirohito Katsunuma, Kyowa Patent and Law Office, Tokyo, Tokyo)
Amendments to Japanese IP laws adopted on May 14th, 2014 have re-introduced a post-grant patent opposition system, after its abolition in 2003.

Russia: Substantial amendments to the Russian IP law are now in force

(Irina Ozolina, Sojuzpatent, Moscow, Russia)
Substantial amendments to the Russian IP law have been adopted recently. Among the crucial changes, patenting of industrial designs comes closer to the European procedure, utility models are subject to substantive examination, and failure to meet the sufficient disclosure requirement is a ground for patent invalidation.

UK: The Regretful Patentee: Re-emergence of File Wrapper Estoppel in the UK

(Ralph Cox and Simon Spink, Fasken Martineau LLP, London,UK)
Since the 2004 judgment of Lord Hoffmann in Kirin-Amgen v Hoescht Marion Roussel it has been widely assumed that there is no file wrapper estoppel in the UK and no doctrine of equivalents either. Both these assumptions are thrown into doubt by the Patent Court’s May 2014 decision in Actavis v Eli Lilly.

U.S.A.: Alice Neither a Wonderland Nor a Wasteland - Yet

(Kelly G. Hyndman, Sughrue Mion, PLLC, Washington, DC, USA)
Relying at least in part on the U.S. Supreme Court’s *Alice* decision, the Court of Appeals for the Federal Circuit (CAFC) has recently decided two appeals that held various patent claims invalid for lack of statutory subject matter.

National Groups

China: The 2014 AIPPI China Youth IP Seminar, August 1-2, 2014

((Richard) Yi Li, Secretary General of Chinese Group of AIPPI)
The Chinese Group of AIPPI held its 2014 annual seminar in Beijing on August 1-2, entitled “2014 AIPPI China Youth IP Seminar”. It is the first time the Group has organized a seminar to present and discuss hot IP issues in English.

AIPPI Bureau

The composition of the Bureau 2014-2016 of AIPPI is as follows

Mr. Felipe CLARO, President

Felipe CLARO is a Lawyer, Partner and Head of the IP Practice Group at Claro & Cia, Santiago, Chile.

He served as Vice President of AIPPI from 2012 to 2014, in the Membership Committee from 2010 to 2012, as Vice President and Treasurer of AIPPI Chilean Group, and as Secretary of the Bureau Advisory Committee (Statutes Committee).

Mr. Hao MA, Vice President

Hao MA is a Patent Attorney, President of CCPIT Patent and Trademark Law Office, Beijing, China.

He served as Vice President of AIPPI Chinese Group from 2010 to 2014, in the Bureau Advisory Committee (Role and Structure of the Bureau, Council of Presidents and Executive Committee of AIPPI) from 2012 to 2014, and in the Working Committee of Q183 (Employers' rights to intellectual property).

Mr. Laurent THIBON, Secretary General

Laurent THIBON is a European Patent and Trademark Attorney, Managing Partner of Cabinet Beaumont, Grenoble, France.

He served as Deputy Secretary General of AIPPI from 2010 to 2014, as Vice President of AIPPI French Group from 2008 to 2010, as Secretary of the IT and Internet Standing Committee from 2008 to 2010, and in the Organizing Committee of the AIPPI 2010 Paris Congress.

**Ms. Sarah MATHESON,
Reporter General**

Sarah MATHESON is a Lawyer and Trade Marks Attorney, Partner at Allens, Melbourne, Australia.

She served as Deputy Reporter General of AIPPI from 2010 to 2014, as Assistant to the Reporter General from 2009 to 2010, in the AIPPI Australian Group as Treasurer from 2004 to 2008 and as Vice President from 2008 to 2009, as Secretary of the TRIPS Standing Committee, and as Chair of the Working Committees Q191 (Relationship between trademarks and geographical indic tions) and Q202 (Impact of public health issues on exclusive patent rights).

**Mr. Gérard MYON,
Treasurer General**

Gérard MYON is a European Patent Attorney, Partner at LAVOIX, Lyon, France.

He served in the Finance Advisory Committee as member from 2006 to 2010 and as Chair from 2010 to 2014, as Secretary of the Working Committee Q167 (Current standards for prior art disclosure in assessing novelty and inventive step requirements), and in the Organizing Committee of the AIPPI 2010 Paris Congress.

**Ms. Olga SIRAKOVA,
Deputy Secretary General**

Olga SIRAKOVA is Attorney at Law, European Patent and Trademark Attorney, Partner at Interius, Sofia, Bulgaria.

She served in the Nominating Committee as member from 2006 to 2010 and as Chair from 2010 to 2014, and as Secretary and President of the AIPPI Bulgarian Group.

**Mr. John OSHA,
Deputy Reporter General**

John OSHA is a U.S. Attorney at Law and U.S. Patent Attorney, Managing Partner of Osha Liang LLP, USA.

He has served as Deputy Reporter General since 2013, served as Assistant to the Reporter General from 2010 to 2013, in the PCT Standing Committee, and as co-Chair of the Working Committee Q209 (Selection Inventions: the Inventive Step Requirement, other Patentability Criteria and Scope of Protection).

**Ms. Anne Marie VERSCHUUR,
Deputy Reporter General**

Anne Marie VERSCHUUR is a Lawyer, Partner at NautaDu-tilh N.V., Amsterdam, The Netherlands.

She served as Assistant to the Reporter General from 2013 to 2014, as Secretary of the Trademark Standing Committee from 2011 to 2013, and as Secretary of the Working Committee Q214 (Protection against the dilution of a trademark).

**Ms. Rafaella ARISTA,
Congress Representative**

Rafaella ARISTA is a Lawyer, Partner at Studio Legale Improda, Rome, Italy.

She served as member of the Communications Committee from 2008 to 2011. She is a member of the Executive Committee of AIPPI Italian Group and is in the Organizing Committee of the AIPPI 2016 Milano Congress.

The Enlarged Bureau further includes three Assistants to the Secretary General:

Ms. Karen ABRAHAM

Karen ABRAHAM is a Lawyer, Trade Mark and Patent Attorney, Partner at Shearn Delamore and Co, Kuala Lumpur, Maylasia.

She has served as Assistant to the Secretary General since 2010, served as President of the AIPPI Malaysian Group from 2004 to 2010, and in the Bureau Advisory Committee (Statutes Committee) .

Mr. Luiz Henrique do AMARAL

Luiz Henrique do AMARAL is a Lawyer, Partner at Dannemann Siemsen Bigler & Ipanema Moreira, Rio de Janeiro, Brazil.

He served as President of the AIPPI Brazilian Group from 2009 to 2013 and as President of ABPI from 2009 to 2014. He is the Chair of the Organizing Committee of AIPPI 2015 Rio Congress.

Mr. Marek LAZEWSKI

Marek LAZEWSKI is a European Patent Attorney, Managing Partner of Lazewski Depo and Partners, Warsaw, Poland.

He served as board member and Secretary of the AIPPI Polish Group.

and three Assistants to the Reporter General:

Mr. Yusuke INUI

Yusuke INUI is a Patent Attorney at Hogan Lovells, Tokyo, Japan.

He served in the Patents Standing Committee.

Mr. Ari LAAKKONEN

Ari LAAKKONEN is a Lawyer, Partner at Powell Gilbert, London, UK.

He has served as a Member of the Council of the AIPPI UK Group since 2003 and participated in many AIPPI Working Questions as the UK lead or co-lead.

Mr. Ralph NACK

Ralph NACK is a Lawyer, Partner at Noerr LLP, Munich, Germany.

He served as Chairman of the Patents Standing Committee and is a Board Member of the AIPPI German Group.

AIPPI 2014 Toronto

(Felipe Claro, President of AIPPI)

(Article by Felipe Claro, President of AIPPI)

The AIPPI Congress took place in Canada's biggest city, Toronto, from 14 to 17 September, 2014, in the well-equipped Toronto Metro Convention Center. More than 1600 attendees gave life to a wonderful reunion, which benefited from the presence of members of the Supreme Court and the Intellectual Property Institute of Canada, Judges, the President of the European Patent Office (EPO), the Vice-President of The Office for Harmonization in the Internal Market (OHIM), as well as other Canadian and international authorities.

The Organizing Committee did a fantastic job in supervising and attending to every last detail and producing a Congress to be remembered. Special thanks to Philip C. Mendes da Costa, Chair of the Organizing Committee, and Bruce Morgan, President of the Canadian National Group and Congress Representative, as well as to everyone who helped in making us feel at home.

Several sister associations had the opportunity to share their views and coordinate their activities in a face to face meeting. Also, representatives of industry had the opportunity to attend specially organized lunches and dinner with the heads of different Trademark and Patent Offices from around the world.

Many workshops and panels explored the problems affecting diverse IP areas, like the pharmaceutical industry, the implications of 3D printing, attorney-client privilege issues, software patenting, internet copyright issues and international arbitration. Other subjects studied during the Congress included the AEREO case, green technologies and The Hague's system for the protection of industrial designs. Hard debate and work within a friendly environment proved to be a rewarding exercise for the attendees.

The AIPPI Executive Committee adopted various resolutions, mainly about the second medical use, the basic mark requirement in the Madrid System, exhaustion issues in copyright law, licensing and insolvency and prior user rights.

As proposed by the AIPPI Bureau and with the help of the Bureau Advisory Committee on the Role and Structure of the Bureau, Council of Presidents and Executive Committee of AIPPI, the Executive Committee and the General Assembly agreed to modify the Association's Statutes and Regulations, with the goal of developing a more responsive, dynamic and modern association.

A significant number of the Bureau members retired from office this year, since many officers had reached their maximum term. AIPPI is most grateful to those outgoing Bureau members, who have made an extraordinary contribution to the Association. The current Bureau composition can be seen on the AIPPI web site.

The Council of Presidents announced new Award of Merit holders: Bo Davidsson (Sweden), Marja-Leena Mansala (Finland), Peter Pawloy (Austria), Markku Simmelvuo (Finland), Regina Quek (Singapore) and Carlo Ubertazzi (Italy) - with AIPPI's thanks to all of you.

The social agenda was full of nice surprises. The Opening Ceremony and Welcoming Reception was held at Roy Thompson Hall, home of the Toronto Symphony Orchestra, and during the Closing Dinner, acrobats indulged the audience with a performance to the rhythm of the song Alegria.

Some more enthusiastic attendees visited Niagara Falls, and they were delighted by the sightseeing. It was not a coincidence that the Congress took place near the great Niagara Falls, which are a symbol for the powerful and continuing changes taking place in AIPPI.

Articles and notes

Australia: A dichotomy in legal outcomes makes for rocky roads ahead

(Article by Tania Obranovich and Chris Vindurampulle, Watermark Intellectual Asset Management, Melbourne, Australia)

The controversial issue of "gene patenting" has hit the headlines, yet again, following the recent Federal Court of Australia Full Court ('FFCA) decision in D'Arcy v Myriad Genetics Inc [2014] FCAFC 115. This decision upholds an earlier Federal Court finding that isolated gene molecules are patentable in Australia. These cases specifically relate to the BRCA patents which claim both breast cancer diagnostic methods and the BRCA gene molecules.

The FFCA decision contrasts that of the US Supreme Court ("USSC") in the parallel US Myriad litigation, where claims to the isolated BRCA gene molecules were invalidated on the ground that isolated DNA is a product of nature and therefore not patent eligible.

While the USSC decision cannot be appealed any further, an application for leave to appeal the FFCA decision to the High Court of Australia has been filed, although not yet decided.

Australia Got it Right

The FFCA decision clarified that the isolation of DNA is more than just a mere discovery. Specifically, the Court found the BRCA gene molecules were not the same as their naturally occurring counterparts, there being both structural and significant functional differences which result from isolation. Notably, the Court distinguished its reasoning from that of the USSC for reasons including that the USSC had focussed on the nature of the information contained in the gene while the FFCA focussed only on the nature of the physical molecule itself.

On balance, the FFCA issued a persuasive and clearly reasoned decision. Unsurprisingly, opponents to gene patenting have largely condemned the decision arguing, amongst other things, that the BRCA diagnostic test could become inaccessible and research could be stopped. Thus, there still remains a serious disconnect between the public's understanding of the issue of patentability and the decisions of the courts. For example, if isolated genes were found not to be patent eligible, this would have no impact on the existence of patent rights over a diagnostic test, which is separately patentable.

This situation therefore highlights the importance of the safeguards which are enshrined in legislation. For example, the Australian Patents Act 1990 ("the Act") contains Crown use and compulsory licensing provisions that provide a technology-neutral safety net which could be used to deal with abusive monopolistic behaviour in respect of patented technologies. Still further the Act also provides an experimental use exemption which exempts from infringement work done for experimental purposes relating to the subject matter of an invention. Accordingly, the FFCA decision does not impact on future access to the BRCA diagnostic test nor future research and development into improved or new tests.

It is pertinent to note that the FFCA decision has not changed the law in Australia but merely confirmed it. Within the context of this existing legal framework, to date there has never been a healthcare crisis in Australia due to an inability to access patented diagnostics or therapeutics.

Impact of the Dichotomy

The USPTO has issued examiner guidelines which dramatically extend the application of the USSC decision to the exclusion of all "naturally occurring products" from patent eligibility. These guidelines make it nearly impossible for innovators to obtain a commercially relevant scope of protection. This contrasts the situation in Australia, and most other jurisdictions, which allow the patenting of isolated natural products, albeit within a legal framework that provides safeguards against abusive monopolistic behaviour.

Until the USPTO alters its guidelines, or the US legislature clarifies the law, companies seeking a commercial path for biotechnological and pharmaceutical inventions will have to carefully consider the strategic options available to them to navigate around this issue. More broadly, this situation raises serious questions about the extent to which investment and innovation in these sectors may be undermined.

Colombia: Trademark registration highway in Colombia

(Article by Margarita Castellanos, CASTELLANOS & CO., Bogotá, Colombia)

The national trademark office of Colombia (Superintendence of Industry and Commerce) has created a mechanism that enables a trademark to be granted in less than six months.

This was not possible in the past, as the right of priority granted under the Paris Convention meant that an applicant claiming a priority of six months could prevent the registration of a trademark filed in Colombia within these six priority months.

If a trademark registration had been granted in less than six months, the priority claim would not have the desired effect, that is, to prevent the registration of a similar trademark filed within the priority term.

In order to solve this problem, the Superintendence of Industry and Commerce issued resolution No. 48348 of August 10, 2014, by which an applicant wishing to take advantage of "the trademark prosecution highway" may express its desire to obtain a decision in less than six months.

The national trademark office will issue this expedited registration under the condition that, if a priority claim would be affected by the granted registration, the registration will no longer be enforceable.

The applicant may request expedited registration at the time the application is filed, or later by a separate request.

With this mechanism, the national trademark office of Colombia aims at reducing the time taken to obtain registration to an average of four months.

European Union: No restrictive interpretation of grounds for exclusion three-dimensional trademarks

(Article by Tobias Cohen Jehoram[1], De Brauw Blackstone Westbroek, Amsterdam, The Netherlands)

The case

The case concerned a dispute regarding the famous Tripp Trapp chair and whether the three-dimensional representation of that chair can be a valid trademark. The Supreme Court of the Netherlands found that an interpretation of two exclusions relating to three-dimensional trademarks was needed and referred questions to the ECJ. These questions relate to the grounds for exclusion laid down in article 3(1)(e)(i) and (iii) of the EU trademark directive: signs which consist exclusively of a shape that results from the nature of the goods, and of a shape that gives a substantial value to the goods.

The ECJ first considered that the rationale behind these grounds for exclusion is to prevent the exclusive and permanent right which a trademark confers from serving to extend indefinitely the life of other rights which the EU legislature has sought to make subject to limited periods.

With regard to the "nature of the goods" exclusion, the question was whether this ground refers to shapes that are indispensable to the function of the goods, or whether it can also relate to the presence of one or more substantial functional characteristics of goods. The ECJ considered that, if this exclusion only covered the first group, this would not allow the objective of the ground for exclusion to be fully achieved. It would make it difficult for other companies to give their goods a shape that would be suited to the intended use of the product since consumers will look for those essential characteristics in the products of competitors. This is a clear deviation of the OHIM guidelines on the subject, which are more restrictive. In fact no 3D marks have been refused on this ground.

With regard to the concept of "substantial value", the question was whether this ground is to be interpreted as meaning that it may only apply to a sign where the ornamental value is the only substantial value or whether it may also apply to shapes where other characteristics (also) give substantial value to the goods. The ECJ pointed out that the latter should be the case, since the first option could grant a trademark proprietor a monopoly on the essential characteristics of such products, which would not allow the objective of that ground for refusal to be fully achieved.

Finally, the ECJ considered that both grounds cannot be combined. Any of the exclusions should apply fully to the sign or order to be refused or invalidated. This consideration is relevant to the case, as the court of appeal had ruled that the Tripp Trapp shape only partially resulted from the nature of the goods, but nonetheless gave a substantial value to the goods.

Interesting to note is that in the latest proposed drafts for the new EU trademark directive, the grounds for exclusion are, in accordance with the Hauck vs Stokke ruling, broadened. In the proposed text for these grounds for refusal, the term "or another characteristic" is added. This is all the more interesting when taking into consideration that the Max Planck Institute proposed to delete the "substantial value" ground altogether[2], instead of broadening its application. The Institute considered that a shape that attracts consumers by its aesthetic appeal, but later develops a higher degree of distinctiveness and is mainly appreciated for that reason, stands in the way of the "fair competition" rationale that the ECJ applies in the Hauck vs Stokke ruling.
References

[2] Professor Cohen Jehoram acted for Stokke in this matter and is also a member of AIPPI's Standing Committee on Trademarks.
[2] Study on the Overall Functioning of the European Trade Mark system, Max Planck institute, 2011, p. 74

Italy: The Court of Milan in Sanofi v. Teva "repeats" the CJEU judgment in Actavis

(Article by Elena Martini, Martini Manna Avvocati, Milan, Italy)

By judgment No. 9855/14 published on 1 August, Business Chamber "A" of the Court of Milan has decided the case filed by Sanofi against Teva for alleged infringement of supplementary protection certificate no. UB99P653 ("SPC '653"), owned by Sanofi for its CoAproval medicine (irbesartan + hydrochlorothiazide) and allegedly infringed by the relevant generic drug from Teva. The decision — departing from earlier judgments of the same Chamber — found SPC '653 invalid, openly conforming to the judgment of the Court of Justice of the European Union ("CJEU") in the identical case between Sanofi and Actavis (C-443/12).

The key issue in the dispute was the validity of SPC '653: according to the defendant, it was invalid both because the relevant basic patent EP 454511 (EP' 511) did not claim the combination of *irbesartan* and *hydrochlorothiazide* and because SPC '653 had been granted after Sanofi had already obtained an SPC for its medicine Aproval, containing, as its single active ingredient, irbesartan (i.e. the subject matter of EP '511). According to Teva, such circumstances did not fulfil the conditions for a valid SPC to be granted, as laid down in Article 3(a) and (c) of Regulation No. 469/2009: "*A certificate shall be granted if, in the Member State in which the application referred to in Article 7 is submitted and at the date of that application: (a) the product (alias "the active ingredient or combination of active ingredients of a medicinal product", according to the definition of "product" in Article 1 of the Regulation) is protected by a basic patent in force; (b) a valid authorisation to place the product on the market as a medicinal product has been granted in accordance with Directive 2001/83/EC or Directive 2001/82/EC, as appropriate; (c) the product has not already been the subject of a certificate; (d) the authorisation referred to in point (b) is the first authorisation to place the product on the market as a medicinal product.*"

Sanofi argued that SPC '653 should instead be considered valid since EP' 511 covered not only the "product" consisting of the active ingredient irbesartan but also - in Claim 20 - a "product" containing the combination of *irbesartan* with a "diuretic", for which a person skilled in the art would have selected hydrochlorothiazide (which satisfied the condition of art. 3(a)); in addition, its medicine consisting of the combination of irbesartan and hydrochlorothiazide was a "product" that was different from its medicine made of irbesartan only, and it could therefore be protected independently by an SPC pursuant to Art. 3(c).

The Milan Business Chamber initially accepted Sanofi's view, prohibiting the marketing of Teva's generic drug as a precautionary measure because of the infringement of SPC '653. However, in the decision under review, the judges changed the course in part, expressly for the need to comply with the decision of the CJEU in the Actavis case (C-443/12), which concerned the same patent and SPC (allegedly infringed in that case by the corresponding generic drug from Actavis).

Specifically, the Milanese judges confirmed what they had stated in the precautionary proceedings on the existence of the condition of Art. 3(a), finding support in another decision of the CJEU (C-493/12, Eli Lilly), "*given that Claim 20, which literally indicates the association of irbesartan with a diuretic, could be considered to include the possible combination of irbesartan + hydrochlorothyiazide, since the latter is one of the diuretics commonly used as an antihypertensive and is easily identifiable by a person skilled in the art*".

The Milanese judges, however, reversed the course with regards to the requirement of Art. 3(c), pointing out that, according to the decision of the CJEU in the Actavis case, "it cannot be accepted that the holder of a basic patent in force may obtain a new SPC, potentially for a longer period of protection, each time they place on the market in a Member State a medicinal product containing, on the one hand, the principle active ingredient, protected as such by the holder's basic patent and constituting, according to the statements of the referring court, the core inventive advance of that patent, and, on the other, another active ingredient which is not protected as such by that patent" (paragraph 30). In this sense, according to the Milanese Specialised Business Chamber (in line with the CJEU findings), hydrochlorothiazide is not "as such protected by the patent", because "*the concept of "product protected by basic patent" does not include the combinations of the inventive active ingredient with other known ingredients that—even if, as in this case, are claimed in dependent claims enjoying the inventiveness of the principle claim they depend upon—represent forms of mere single administration of medicines already commonly prescribed together for their known synergistic effects (which is the case of antihypertensives and diuretics), which do not preclude any technical problem or general contraindication, and therefore did not require any inventive activity*".

The Court of Milan therefore rejected Sanofi's claims and declared the invalidity of SPC '653 as requested by way of counterclaim by Teva, and ordered Sanofi to pay the costs of the proceedings and of the Court Experts.

Japan: Re-introduction of post-grant patent opposition in Japan

(Article by Hirohito Katsunuma, Kyowa Patent and Law Office, Tokyo, Japan)

A brief description of the key features of the Japanese post-grant patent opposition system is as follows.

1. Opposition Filing Procedures

A. Opponent
Any person can file an opposition to the Patent Office with respect to the grant of a patent (Art. 113).

B.Period
The opposition must be filed within six months after the publication of the patent gazette.

C.Subject of opposition
The opponent can oppose a patent granted as set forth in the claims. The opponent can oppose each claim.

D. Grounds
The grounds for opposition are limited to public-interest reasons. Formality deficiencies, such as a violation of the requirement of unity of invention, are not grounds for opposition.

E.Formality
The opponent must submit a written opposition to the Commissioner of the Patent Office stating the opponent's name, domicile/residence, the identification of the opposed patent and the relief sought in the opposition and the grounds therefor. (Art. 115 Para. 1)

F. Procedures after a filing of an opposition
The trial examiner-in-chief must send a copy of the written opposition to the patentee when an opposition is filed (Art. 115 Para. 3).

G. Fees
The opponent must pay JPY 16,500 plus JPY 2,400 per claim opposed.

2. Examination for the opposition

A.Conduct of the opposition examination A board of three or five trial examiners conducts the opposition examination on the basis of the documents filed (Art. 118 Para. 1). The opposition examination does not include any oral hearing.

B. Notification of reasons for revocation and submission of a written argument When the trial examiners intend to render a revocation decision, the trial examiner-in-chief notifies the patentee of the reasons for revocation and gives the patentee an opportunity to submit a statement of his argument and/or a demand for correction, designating an adequate time limit (Art. 120quinquies Para. 1).

C.Demand for correction

i. Subject for correction
The patentee can demand a correction of the description, patent claim(s) or drawing(s) (Art. 120quinquies Para. 2). When the opposition was made against each claim, the demand for correction must be made for each claim (Art. 120quinquies Para. 3).

ii. Scope of correction The correction must not introduce new matter, nor enlarge/change the scope of patent claim(s). The corrected claim(s) should be patentable independently at the time of filing of the patent application.

iii. Examination of the correction The trial examiners examine the demand for correction. If the correction complies with the requirement, the trial examiner-in-chief sends notification of the reasons for revocation and the demand for correction to the opponent, and gives the opponent an opportunity to submit a written opinion, designating an adequate period of time.

If the correction fails to comply with the requirement, the trial examiner-in-chief rejects the correction, and gives the patentee an opportunity to submit a written opinion and/or an amendment to the correction, designating an adequate period (Art. 120quinquies Para. 6).

D. Withdrawal of the opposition
The opposition may not be withdrawn after the issue of the notification of reasons for revocation (Art. 120quater Para. 1).

3. Decision on opposition

A. Decision Where the grounds of opposition succeed, the trial examiners must revoke the patent (Art. 114 Para. 2). If not, the trial examiners will maintain the patent (Art. 114 Para. 4).

B. Decision being final and conclusive, and the effect of the decision An appeal against a decision to revoke the patent may be made to the Intellectual Property High Court within 30 days from the date of transmittal of the written opposition decision (Art. 178 Para. 1, 3).

There can be no appeal from a decision to maintain the patent (Art. 114 Para. 5). The opponent can file a d emand for an invalidation trial if he/she has an objection.

Russia: Substantial amendments to the Russian IP law are now in force

(Article by Irina Ozolina, Sojuzpatent, Moscow, Russia)

After six years of working with codified Civil Code, IP professionals are looking forward to new amendments to IP law in Russia. These amendments are part of significant reform of civil and commercial law, announced in 2012, aimed at making the legislation more responsive to the needs of commerce. At the same time the amendments will correct and improve difficulties with the prior legislation noticed and criticized by IP professionals in 2008, immediately after the Civil Code came into force. Most of the amendments came into force on October 1, 2014, although the changes in patent duration will take effect from January 1, 2015.

What is the most important to know?

1. The burden to prove patentability at the prosecution stage has increased. The obligation for a patentee to sufficiently disclose an invention so that an average specialist could implement the invention is no longer buried in administrative regulations, but one of the basic requirements for an invention, along with the requirements to be novel, inventive and industrially applicable. Failure to meet this requirement may lead to patent invalidation in the future, since this ground for invalidation is now expressly mentioned in the law.

It should be also noted that, whilst the practice previously regarded second use patents as method patents, the amended rules describing infringement of second use patents now hint the contrary: a product may be considered to infringe a second use patent if the product is destined for use in the patented way. Though highly criticized by some IP professionals, this rule was still introduced into the law.

2.A utility model patent is now subject to substantive examination. Previously a utility model patent could be obtained for a device, although no search or examination of novelty was provided by the patent office. The patentee or a third person could file a request for a prior art search, but the lack of novelty was not a ground for refusal. Now, with the amendments to the law, a utility model is subject to full examination during prosecution.

Additionally, an absolute worldwide novelty requirement has been introduced and is a significant change to the previous practice that considered printed publications worldwide but only prior use within Russia.

The duration of utility model patents will remain ten years but for utility model patents filed after January 1, 2015 it will no longer be possible to extend this validity for a further three years.

The Russian patent system does not include an opposition procedure - only invalidation after grant during the term of the patent protection – but some features of an opposition procedure exist in practice such as the possibility to amend a patent during invalidation. The patent can be amended or transformed into a utility model during an invalidation procedure, if it meets requirements for patentability of a utility model, and the term for utility model has not expired (10 years after filing date).

3. Prosecution of industrial designs is now similar to the practice in Europe. The scope of the design protection after grant was previously defined by a written list of essential features that needed all to be

present in the product alleged to be infringing. With the new law this written list is no longer required. The essential features are to be defined by reference to the images and this may lead to some uncertainty in the limits of protection and unpredictability of examination during prosecution. Hopefully it will also lead to a more effective protection of rights for industrial design owners. A lot more attention will be paid to the description of a design, which is to be provided along with the images to establish a filing date. Also the general impression conveyed to an informed consumer will now be considered in assessing possible design infringement.

The way of calculating the duration of an industrial design has also changed: now it is granted for five years and can be extended four times for five years more, so that maximum term still remains 25 years.

An industrial design continues to be protected by a patent, so all the remedies against infringers that patentees have may be used by owners of designs as well.

UK: The Regretful Patentee: Re-emergence of File Wrapper Estoppel in the UK

(Article by Ralph Cox and Simon Spink, Fasken Martineau LLP, London, UK)

Since the 2004 judgment of Lord Hoffmann in Kirin-Amgen v Hoescht Marion Roussel[1] it has been widely assumed that there is no file wrapper estoppel in the UK and no doctrine of equivalents either. Both these assumptions are thrown into doubt by the Patent Court's May 2014 decision in Actavis v Eli Lilly[2].

Use of the File Wrapper

In Kirin-Amgen, Lord Hoffmann said that there were good reasons why the German and English courts discouraged, if not actually prohibited, the use of patent office files in aid of the construction of patents. The reasons included that the meaning of a patent does not change depending on whether a party has access to the office file or not and anyway the file may reflect no more than a patentee's desire to get the patent granted quickly without further argument with the examiner.

Taking the hint, parties and the courts made little use of file wrappers in subsequent cases with the Court of Appeal observing in Eli Lilly v Human Genome Sciences[3] that it was not confident it was legitimate to do so even though the UK courts had yet to decide the matter conclusively.

Doctrine of Equivalents

While Lord Hoffmann considered that Article 69 of the European Patent Convention firmly shut the door on any doctrine which extended protection outside the claims, he acknowledged that equivalence could be an important part of the background that would affect the skilled person's understanding of a claim. This was consistent with the Article 2 of the Protocol on the Interpretation of Article 69, which states that in construing a claim due account should be taken of "any element which is equivalent to an element specified in the claims". However, he doubted the usefulness of the Improver Questions[4] in reaching a purposive construction saying that there was only one compulsory question: what would a person skilled in the art have understood the patentee to have used the language of the claim to mean? Following this decision, the Improver Questions have been seldom used in UK patent actions.

The Actavis v Eli Lilly Decision

In his judgment, Mr Justice Arnold carefully reviewed the case law on both use of file wrappers and the doctrine of equivalence. On the latter, he identified three main classes of case in which patentees resort to arguments on equivalence, namely where:

i. the patent has been poorly drafted (as in the Improver case);

ii. technology has moved on significantly since the patent was filed (as in Kirin-Amgen); and

iii. the patentee regrets a decision taken during the course of prosecution.

The *Actavis* case was a clear example of the third category. Eli Lilly had attempted to broaden its claims in prosecution, failed and accepted the narrower claims. It clearly now wished it had broader claims in order to catch Actavis on infringement but there was "no reason why the law should be sympathetic to the patentee", which not only had the benefit of professional advice but also the opportunity to appeal against the examiner's decision. Further, effectively overturning examiners through a decision on claim construction would undermine their important role. Against this background, Mr Justice Arnold made use of the prosecution history as one of several reasons why Eli Lilly's broad construction should be rejected.

He also used the Improver Questions, partly because it was not in dispute that the alleged infringement was not within the primary, literal meaning of the claim.

Conclusion

Mr Justice Arnold observed that the US has a doctrine of equivalence and a doctrine of file wrapper estoppel to counterbalance it. While following prior case law, the UK had neither, file wrapper estoppel is now back albeit only in the case of the regretful patentee. Even then, as Arnold J warned, the courts should be cautious using the prosecution history only when it is short, simple and shows clearly why the claims are in their granted form and not broader.

As regards equivalence, using the Improver Questions having held that there is plainly no literal infringement comes very close to Lord Hoffmann's description of the US approach in Kirin-Amgen as being "to adhere to literalism in construing the claims and evolve a doctrine which supplements the claims by extending protection to equivalents". Even if not explicitly recognised as a doctrine of equivalence, the decision may therefore lead to a resurrection of the Improver Questions by patentees in arguing just that.

References

1. [2005] RPC 9
2. [2014] EWHC 1511 (Pat)
3. [2013] RPC 22
4. These, in brief, ask whether a variant has a material effect on the way the invention works, whether this was obvious and whether strict compliance with the primary meaning of the claim is nonetheless essential.

U.S.A.: Alice Neither a Wonderland Nor a Wasteland - Yet

(Article by Kelly G. Hyndman, Sughrue Mion, PLLC, Washington, DC, USA)

The decision of the United States Supreme Court in *Alice Corporation PTY. LTD. v. CLS Bank Int'l et Al*, 573 U.S. ____ (2014), decided now a full three months ago, has had an impact in two recent precedential decisions of the Court of Appeals for the Federal Circuit (CAFC). In brief, Alice stands for the propositions that: (1) a claim drawn to an abstract idea is patent-ineligible unless it contains additional features that ensure the claim does not monopolize the abstract idea; (2) the relevant analysis is whether the claims do more than instruct the practitioner to implement the abstract idea; and (3) the analysis framework to apply is to first determine whether a claim is directed to an abstract idea and, if so, to ask whether the claim elements transform the nature of the claim to a patent-eligible application of the abstract idea.

Digitech Image Technologies, LLC v. Electronics for Imaging, Inc., 758 F.3d 1344 (Fed. Cir. 2014) invalidated the patentee's claims under 35 U.S.C. §101, the U.S. statute that defines patentable subject matter. This statute defines four broad classes of statutory subject matter including apparatus, article of manufacture, chemical composition, and process. In Digitech the Court noted that, even when claims fall within one of these four broad categories, the claims "may nevertheless be ineligible" for a patent "if they encompass laws of nature, physical phenomena, or abstract ideas." In this context, however, the Court cited Alice as merely a reaffirmance of the point that "fundamental concepts, by themselves, are ineligible abstract ideas", and for the proposition that a claim may be patent eligible "if it includes additional inventive features such that the claim scope does not solely capture the abstract idea."

The Court brought Alice to bear against only the patentee's method claims. The sole independent method claim basically recited:

A method of generating a device profile..., said method comprising:

generating first data for describing...;

generating second data for describing...; and

combining said first and second data into the device profile.

The CAFC concluded that the method was "so abstract and sweeping as to cover any and all uses of a device profile" and thus invalid. Alice actually played only a minor role in the analysis, being mentioned only in connection with a few of the patent's claims.

In contrast, Alice was central to the invalidation of all of patentee's asserted claims in *buySAFE Inc.* v. Google Inc., ___ F.3d ___ (Fed. Cir. 2014), decided on September 3, 2014. Here, the claims were drawn to guaranteeing a party's performance of an online transaction. The asserted claim 1 basically recited:

A method, comprising:

receiving, by at least one computer application program running on a computer..., a request...;

processing, by at least one computer application program running on the... computer, the request by underwriting...,

wherein the computer... offers, via a computer network, the transaction performance guaranty service...

The CAFC here found that the asserted claims "do not push or even test the boundaries of the Supreme Court precedents under section 101." The Court here found the recited computer functionality too generic to transform the abstract idea into patent-eligible subject matter.

Practitioners in the United States anxiously await some decision by the CAFC that helps clarify when a patent claim is *directed* to an abstract idea as opposed to merely being related to an abstract idea, as well as guidance as to the level of specificity required in the recitation of computer technology to escape classification as merely generic. *Digitech* and *buySAFE*, unfortunately, do not yet answer those questions.

National Groups

China: The 2014 AIPPI China Youth IP Seminar, August 1-2, 2014

(Article by Richard/ Yi Li, Secretary General of Chinese Group of AIPPI)

The Chinese Group of AIPPI held its 2014 annual seminar in Beijing on August 1-2, entitled "2014 AIPPI China Youth IP Seminar". It is the first time the Group has organized a seminar to present and discuss hot IP issues conducted in English, the official language for most of international IP conferences, although the participants that attended were all members of the Chinese Group.

The seminar had 10 sessions with 10 moderators and 30 speakers, and was divided into two half days. There were two concurrent workshops on the first day, August 1st, the workshops dealt with design patent protection on Graphical User Interfaces (GUIs), second medical use, invention and utility model patent practice, software related and business method patents, and case studies. The workshop on the second day, August 2nd,, focused on more popular topics, such as trademarks, copyright, licensing and patent litigation.

Hao Ma and Perry Yang, two vice-presidents of the Chinese Group spoke highly of the organizational efforts of the Group Secretariat, and acknowledged the contribution of the moderators and speakers to the success of the seminar as well as the active participation of all that attended.

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