



**e-News**

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International Association for the Protection of Intellectual Property  
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### [John Bochnovic joins AIPPI as Executive Director](#)

[AIPPI is pleased to announce the appointment of Mr. John Bochnovic as Executive Director.](#)

Starting September 1, 2015, Mr. Bochnovic will join the General Secretariat at AIPPI's Zurich headquarters (read more).



### [AIPPI World Congress — Rio 2015](#)

[AIPPI 2015 World Congress in Rio: preparation on track!](#)

(Luiz Henrique do Amaral, Chair Organizing Committee)

**Already 1171 participants from 78 countries registered for the World Congress in Rio.** Now that registration for AIPPI World Congress in Rio is open, the final preparations are under way. The sessions will be both entertaining and cutting edge. The social Programme during the Congress will allow participants to see and experience the Brazilian culture. The opening ceremony will be followed by a lush reception designed to induce networking by the participants. The cultural evening at Copacabana Palace will entertain participants with samba and a real carnival ball and will feature typical Brazilian food and drinks. The gala dinner at the Jockey Club will have a Brazilian style menu, along with a horse race for AIPPI. The Congress will be a unique chance to experience Rio with professional networking and substantive IP discussions and content. Come and join!

### [Sponsorship opportunity at the Rio Congress](#)

(Rio 2015 Organizing Committee)

Sponsors in Rio will have unique opportunities to promote their activities with improved marketing strategies. The intention is to introduce new ways to display the sponsor's brands with high visibility, including banners on AIPPI's web site and screens throughout the Congress rooms. Also, new networking mechanisms will ensure that the sponsors at the Rio World Congress will have more opportunities to be closer to the participants, such as, for instance, during the opening ceremony reception in the exhibition hall.

During the AIPPI World Congress, the Brazilian Intellectual Property Association (ABPI) Annual Congress will take place, which is regularly attended by around 1000 participants from 20 countries in the Americas. As such, sponsors will have access to a significantly increased audience, especially in the region, at no extra cost.

The above measures provide a tremendous opportunity to sponsors, and we now invite you to review the sponsorship opportunities in the sponsorship brochure [here](#).

### [AIPPI Congress News](#)

(AIPPI General Secretariat and Managing IP)

AIPPI is pleased, once again, to be working with Managing IP to publish The **AIPPI Congress News** - the dedicated daily newspaper for the 45th World IP Congress being held in Rio de Janeiro, Brazil, October 10-14, 2015.

## AIPPI Bureau

### AIPPI and OHIM signed a Memorandum of Understanding on May 12, 2015

(Laurent Thibon, Secretary General of AIPPI)

A delegation of AIPPI visited OHIM on May 12 of this year. This visit provided the occasion to formalize mutual cooperation between OHIM and AIPPI. The AIPPI delegation was composed of Laurent Thibon, Secretary General, Olga Sirakova, Deputy Secretary General, Anne Marie Verschuur, Deputy Reporter General, Eléonore Gaspar, chair of the Standing Committee on Trademarks, and Ruth Almaraz, Secretary of the Standing Committee on Designs.

The meeting started with the signing of a Memorandum of Understanding between OHIM and AIPPI. The document was signed by the President of OHIM, Mr. Antonio Campinos, and the Secretary General of AIPPI, Laurent Thibon.

AIPPI obtained the status of observer before the European Parliament and European Commission at the end of 2013, and took part in the OHIM observatory in 2014. At the beginning of this year, AIPPI was granted the status of observer at the Administrative Board and Budget Committee of OHIM. Throughout this period, AIPPI's Standing Committees have been continuously involved, and deserve thanks for their ongoing work. AIPPI, represented by its President, Felipe Claro and by Eléonore Gaspar, also participated, as an observer, to the ABBC meeting that took place in Alicante from June 8 to June 10.

This Memorandum of Understanding reflects AIPPI's increased activities and cooperation with OHIM. During the meeting in Alicante, AIPPI was encouraged by OHIM to increase its involvement in OHIM bodies and users' forums.



## AIPPI Committees

### Compromise texts on the revision of the European Trade Mark System

(Eléonore Gaspar, Chair of Standing Committee on Trademarks)

On June 10, 2015, the COREPER approved a compromise agreement on the reform of the European Trade mark system.

## Forthcoming Events

### July 2015: Roving Seminar on WIPO Services and Initiatives, July 8, 2015, Stuttgart, Germany

(WIPO)

Additional information, such as the seminar's program and registration, can be found in the flyer and on the WIPO site at: [http://www.wipo.int/meetings/en/details.jsp?meeting\\_id=37243](http://www.wipo.int/meetings/en/details.jsp?meeting_id=37243)

### July 2015: Unitary Patent & Unified Patent Court 2015: The Last Miles, July 16, 2015, Munich, Germany

(Premier Cercle)

More information here

### September 2015: AIPPI Baltic Conference 2015 on-line registration now open!

(Urmas Kauler, President of the Estonian Group of AIPPI)

The Estonian Group of AIPPI announces that on-line registration is now open for the AIPPI Baltic Conference 2015 on Intellectual Property, which will be held from 2 to 5 September 2015 in Tallinn, Estonia.

[November 2015: ASIPI XIX Congress of the Inter-american Association of Intellectual Property, November 29 to December 2, 2015 Cartagena de Indias, Colombia](#)

(ASIPI)

[View details.](#)

[Articles and notes](#)

[China: Court guidance on insufficiency of disclosure of the description](#)

(Qing Ge and Guanyang Yao, Liu, Shen & Associates, Beijing, China)

In *Shanghai Zhizhen v. the Patent Re-examination Board and Apple*, the Beijing High Court reversed the PRB's decision upholding the validity of a patent that was allegedly infringed by Apple's Siri. The High Court held the patent was invalid for insufficiency of disclosure of its description.

[Ecuador: Decree 522](#)

(Maria Cecilia Romoleroux and Ian Wall, Corral Rosales Carmigniani Pérez, Quito, Ecuador)

On January 15, 2015, Presidential Decree No. 522 was enacted to amend the *Regulations for the Application of the Law on Import, Commercialization and Sale of Generic Medicines for Human Use*. The amendment alters the practice relating to patented medicines after patent expiry.

[France: Tilting at Moulin Rouge and other windmills](#)

(Tougane Loumeau, Gide Loyrette Nouel, Paris, France)

The owners of the famous Moulin Rouge cabaret and related brands lose their fight against an unlicensed vendor of gifts and souvenirs featuring the Moulin Rouge image and name.

[Japan: The Japan Patent Office \(JPO\) and the United States Patent and Trademark Office \(USPTO\) launch a Bilateral Collaboration Search](#)

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

The Japan Patent Office (JPO) and the USPTO will start a Bilateral Collaboration Search Pilot program on August 1, 2015. This is a step toward collaborative examination of patent applications. Meanwhile, the Patent Law Treaty (PLT) aims to standardize filing procedures. A bill to amend the patent law to prepare for joining the PLT was introduced in the Japanese Parliament.

[UK: UK Court of Appeal clarifies scope of "Swiss form" second medical use claims](#)

(Nicola Dagg and Mark Ridgway, Allen & Overy, London, UK)

Developing new uses for known medicines is a good avenue for research. Second medical use claims protect investment in such new uses and, in a judgment delivered on May 28, 2015, the English Court of Appeal has given much-needed guidance as to how such claims should be interpreted (*Warner-Lambert v Actavis*).

[U.S.A.: The Federal Circuit clarifies the \*Katz\* exception to the general rule requiring disclosure of algorithms for means-plus-function software claims](#)

(Kristin M. Whidby, Fried, Frank, Harris, Shriver & Jacobson LLP, Washington, D.C. U.S.A.)

The CAFC's recent *EON Corp.* decision explains that a patent specification must disclose an algorithm any time a computer-implemented means-plus-function claim requires more than simply "receiving," "storing," or "processing" data. The complexity of the required programming is irrelevant.

[National Groups](#)

[China: Second Joint Seminar of AIPPI China and AIPLA](#)

(Yi Li (Richard), Secretary General of AIPPI China, Beijing, China)

AIPPI China hosted the second joint seminar in Beijing with AIPLA on May 25, 2015 with more than 50 participants from the two associations. The program featured two presentations from each group introducing the latest development in law and practice in China and the US.

[Italy: About three hundred participants attended the two-day Conference on IP and FOOD \(Trademark Day\), which took place in Milan on May 20-21, 2015](#)

(Raffaella Arista, Congress Representative of AIPPI)

About three hundred participants attended the two day Conference on IP and FOOD, **Trademark Day**, organized during EXPO 2015 by the Italian Group of AIPPI and by the Institute of Registered Italian IP Attorneys. Related IP and Food events will take place in Milan on 22 June 2015 (**Design Day**) and 22 September 2015 (**Patent Day**) - <http://ipfood.aippi.it/>.

[Spain: 50 anniversary book of the Spanish AIPPI](#)

(AIPPI Spanish National Group)

The Spanish National Group of AIPPI has recently edited a book as part of the activities celebrating its 50th anniversary in 2014. The high caliber of the work is due to the contribution of 44 authors, not only practitioners who are members of the AIPPI Spanish National Group but also reputed magistrates in IP litigation and university professors. The book, which is entitled “Estudios sobre Propiedad Industrial e Intelectual”, is over 1,000 pages in length and deals with a wide variety of current IP issues. Given the scope of the book, it which will surely become a corner stone for IP scholars in our country and an important reference book.

Additionally, the book was presented at an event hosted by the Spanish Patents and Trademarks Office on the 22nd of April 2015, co-presided by the General Manager of the Office, Ms. Patricia García-Escudero, and our President, Mr. David Pellisé. It is worth mentioning that the honorific members of the Spanish Board, Mr. Alberto Elizaburu, Mr. Alberto Bercovitz and Mr. Luis Alfonso Durán spoke at the event about the origins of the Spanish AIPPI.

To purchase copies, please contact [info@aippi.es](mailto:info@aippi.es)

[JOHN BOCHNOVIC JOINS AIPPI AS EXECUTIVE DIRECTOR](#)

[AIPPI is pleased to announce the appointment of Mr. John Bochnovic as Executive Director.](#)

AIPPI is pleased to announce the appointment of Mr. John Bochnovic as Executive Director.

Starting September 1, 2015, Mr. Bochnovic will join the General Secretariat at AIPPI’s Zurich headquarters.

Mr. Bochnovic has had a distinguished career spanning 35 years in the practice of IP law in Canada, including extensive management experience. He also has a deep understanding of the international IP scene, including by reason of his long involvement with AIPPI and having served as its Vice President and then the President over the period 2010 - 2014.

President Felipe Claro said “With his deep knowledge of IP, proven leadership and experience with IP and governmental organizations, John Bochnovic will effectively assist the Bureau and Staff in its various tasks and duties to improve the services offered to the members and to expand AIPPI’s goals and activities.”

In accepting the appointment, Mr. Bochnovic said “I feel honoured and privileged to serve AIPPI. I am very much looking forward to joining the General Secretariat in Zurich and helping to enhance the capacity of AIPPI to support its members in influencing the positive development of IP laws.”

It has been a long held aspiration to appoint an Executive Director. In September 2013, the Bureau established a procedure for a Selection Committee comprising five Bureau members and Julian Crump, Secretary General of FICPI.

After promoting the position internationally, many applications of high calibre were received from around the world. The Selection Committee shortlisted a number of applications for interview. As Executive Director, Mr. Bochnovic will report to the Bureau and work closely with the General Secretariat staff. He will have a highly visible role in coordinating the activities and work of AIPPI’s 9000 members and in maintaining and developing AIPPI’s relationships with governmental and non-governmental organizations.

[AIPPI World Congress — Rio 2015](#)  
[AIPPI Congress News](#)  
(AIPPI General Secretariat and Managing IP)

AIPPI is pleased, once again, to be working with Managing IP to publish The AIPPI Congress News - the dedicated daily newspaper for the 45th World IP Congress being held in Rio de Janeiro, Brazil, October 10-14, 2015.

The AIPPI Congress News combines the journalistic skills of Managing IP's editorial team with the official AIPPI event information to deliver a daily newspaper that the influential international audience of attendees will both need and enjoy reading.

The AIPPI Congress News will be distributed to attendees throughout the conference area on the three full days of the Congress.

The AIPPI Congress News will be the official daily source of information and offers unparalleled access to the more than 2,000 expected attendees at this year's World Congress— the largest meeting of general IP attorneys in the world.

Limited advertising opportunities and sponsored roundtable features are available, enabling your firm to communicate with this influential audience through the most cost-effective, high exposure, media channel at the World IP Congress.

For information about advertising in the AIPPI Congress News please contact the business manager for your region listed below.

Space is strictly limited so don't delay!

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We look forward to seeing you in Rio!

[AIPPI Committees](#)  
[Compromise texts on the revision of the European Trade Mark System](#)  
(Article by Eléonore Gaspar, Chair of Standing Committee on Trademarks)

After two years of inter-institutional discussions, during Trilogue which was held on April 21, 2015, the Commission, the Council and the European Parliament reached a provisional political agreement on the trade mark reform package which concerns two legal instruments, i.e., the 1989 Directive (now codified as 2008/95/EC) approximating the laws of the member states relating to trade marks and the 1994 Regulation (now codified 207/2009/EC) on the Community Trade Mark.

On June 10, 2015, the Council's Permanent Representatives Committee (COREPER) approved a compromise agreement on the reform of the European Trade mark system.

After endorsement of the compromise agreement by the Committee on Legal Affairs of the European Parliament, the legal texts will return to the Council for political agreement, followed by the usual legal-linguistic revision before the formal adoption of the Council's position at first reading.

Afterwards, the texts will be put to a vote in second reading at a plenary session of the European Parliament, which is expected to take place by the end of 2015. If this happens, publication in the Official Journal should occur in early 2016.

The Standing Committee on Trademarks will further analyze the texts and continue monitoring the legislation process.

Letter from the Council of the European Union dated June 8, 2015

[http://www.consilium.europa.eu/register/en/content/out/?&typ=ENTRY&i=ADV&DOC\\_ID=ST-9547-2015-INIT](http://www.consilium.europa.eu/register/en/content/out/?&typ=ENTRY&i=ADV&DOC_ID=ST-9547-2015-INIT)

Proposal for a Regulation of the European Parliament and of the Council amending Council Regulation [EC] No 207/2009 on the Community Trade Mark

[http://www.consilium.europa.eu/register/en/content/out/?&typ=ENTRY&i=ADV&DOC\\_ID=ST-9547-2015-ADD-1](http://www.consilium.europa.eu/register/en/content/out/?&typ=ENTRY&i=ADV&DOC_ID=ST-9547-2015-ADD-1)

Proposal for a Directive of the European Parliament and of the Council to approximate the laws of the Member states relating trade marks

[http://www.consilium.europa.eu/register/en/content/out/?&typ=ENTRY&i=ADV&DOC\\_ID=ST-9547-2015-ADD-2](http://www.consilium.europa.eu/register/en/content/out/?&typ=ENTRY&i=ADV&DOC_ID=ST-9547-2015-ADD-2)

#### Articles and notes

[China: Court guidance on insufficiency of disclosure of the description](#)

(Article by Qing Ge and Guanyang Yao, Liu, Shen & Associates, Beijing, China)

#### Case Brief

*Shanghai Zhizhen Company v. the PRB with Apple, Inc.*, as the third party (in Chinese).

Shanghai Zhizhen Company v. Apple, Inc., a patent infringement lawsuit, has gained considerable attention. The patent at issue, Chinese patent ZL200410053749.9 (the Patent), claimed a chatting-robot system that was allegedly infringed by Apple's "Siri" voice recognition software.

In a judgment issued on April 21, 2015, the Beijing High Court reversed the decision of the Patent Re-examination Board (the PRB) and a lower court that upheld the validity of the Patent. The Beijing High Court held that the Patent is invalid on the ground of insufficiency of disclosure of the description.

Bound by the judgment of the Beijing High Court, the PRB shall soon issue a decision declaring the Patent to be invalid, and the patent infringement lawsuit will then be dismissed. It has been reported that the Patentee is considering applying for a retrial, hoping that the Supreme Court would come to a different conclusion than the Beijing High Court.

The key issue was whether the technical solution associated with the "game server" and "gaming function" was sufficiently and clearly described in the Patent to allow the person skilled in the art to carry it out.

At the administrative stage, the PRB held that the disclosure was sufficient, as the Patent depicts in Fig 1 that the user can be connected to the "game server" through the robot server and the Patent mentions in the description that the robot system can carry out games. The PRB held that the remaining gap relating to "how" the gaming function is enabled could be filled by the person skilled in the art on the basis of the disclosed content about the querying system or the chatting system in the description.

In the judicial review stage, the court of first instance, the Beijing First Intermediate Court, upheld the PRB's decision, but did so on the basis that the gaming function is a supplementary function developed on the basis of the chatting function, so that those skilled in the art could figure out, based on the common knowledge in the art, that the chatting robot system analyzes the user's language so as to obtain and send the compiled instructions to the game server when carrying out the game.

However, the appellant court, the Beijing High Court, reversed the lower Court's decision based on the following considerations:

1. according to the claims, the gaming function was not supplementary, but rather an indispensable part of the invention and, therefore, the corresponding description is essential;
2. according to the examination history, the patentee admitted that the feature associated with "game server" or "gaming function" is the inventive point of the patent over the prior art, so that the issue about enablement becomes indispensable;
3. with respect to "how" the game server is connected into the system and "how" the "gaming function" is enabled and carried out, the Patent gives no direct answers or embodiments; furthermore, there is no factual basis from which to conclude that those elements are deducible from the disclosure or on the basis of the general knowledge by those skilled in the art without creative work.

Hence, the appellant court held that the Patent is invalid on the ground of insufficiency of disclosure of the description.

#### Commentary

This case provides helpful guidance on the assessment of the sufficiency of disclosure of the description. Based on this decision, the criterion is whether the Patent includes a direct and sufficient disclosure of the invention so that the disclosure per se enables those skilled in the art to carry it out. The sufficiency of disclosure is of vital importance especially when the feature at issue is the point of invention. In that situation, the arguments that the sufficiency can be supported on the basis that the necessary information is "deducible from the existing disclosure by those skilled in the art" or that it is something that those skilled in the art are "able to figure out on the basis of the general knowledge" would seem to inherently conflict with the fact that the associated feature is the inventive point over the prior art.

#### [Decree 522](#)

(Article by Maria Cecilia Romoleroux and Ian Wall, Corral Rosales Carmigniani Pérez, Quito, Ecuador)

On January 15, 2015, Presidential Decree No. 522 was enacted to amend the Regulations for the Application of the Law on Import, Commercialization and Sale of Generic Medicines for Human Use. By this amendment, the following wording was added to the Regulations:

*Once the patented invention has lapsed, medicines shall be mandatorily registered and sold as generics, and the label shall primarily contain the International Common Denomination (ICD) and the reference to "Generic Medicine", above the name of the manufacturer.*

*Once the patent has lapsed reference medicines shall be registered as such and shall be sold as generics. Reference medicines are understood to be those which had originally obtained a patent that has afterwards lapsed.*

*It is prohibited for generic medicines to be sold exclusively with a certain brand.*

Also, a Transitory Provision has been added whereby manufacturers are granted a one-year term, which lapses on January 14, 2016, to comply with the new provisions.

The enacted regulations are in the main confusing. However, based on our interpretation and some information unofficially obtained from government officers, it appears that the new regulations would apply as follows:



1. The new rules will only apply to products for which a patent had been granted in Ecuador and has lapsed. Based on the principle of territoriality of the law, it would not be possible to interpret the rule as applying to products for which a patent was obtained in any other country and which has lapsed.

2. If a relevant patent has lapsed in Ecuador, the corresponding product shall be treated as generic. However, we do not believe that this would be automatic, since generic products must also be registered and the new law refers specifically to registration. Thus we understand that the onus will fall on the proprietor to re-register the product and since the new law provides that registration as a generic will be mandatory following the expiration of the patent, there will presumably be penalties for not doing so. There are no rules in place as to how such re-registration would take place, in particular whether it would involve converting the product into a generic or by obtaining a new registration. However, current branding rules for generic products are similar to what is being introduced by the new rules, as discussed at point 3, below. It is worth mentioning that by making the reference product a generic, it will be simpler to gain approval for other generic / biosimilar products.

3. The product may bear a brand (trademark) but according to the rules the label must primarily feature the ICD and “Medicamento Genérico”. The new rules do not contain any specifics as to the meaning of “primarily”, but we understand that “Medicamento Genérico” must be in red capital letters (Pantone Red 032) and that both this and the ICD must each be of a size at least 20% larger than that of the name/trademark as applied to the product.

As a result of these new rules, manufacturers of patented medicines will face new restrictions on how they can use their trademarks upon patent expiry. They will still be able to use their trademarks on product labels, but such use will have to be of less prominence than the generic name of the drug and the words “Medicamento Genérico”. They will also have the further burden of having to re-register the product.

#### [Tilting at Moulin Rouge and other windmills](#)

(Article by Tougane Loumeau, Gide Loyrette Nouel, Paris, France)

#### Bal du Moulin Rouge v. Editions du Tertre

The French company Bal du Moulin Rouge runs the famous Parisian cabaret Moulin Rouge. It holds licensing rights on various Moulin Rouge trademarks owned by its Belgian parent company Moulin Rouge. Some of these marks cover stationary, office supplies and glassware in classes 16 and 21.

The Moulin Rouge companies had sued Editions du Tertre, a company running a souvenir and small gift business, by reason of the latter’s having marketed pencil cases, mouse pads and coasters featuring the name Moulin Rouge in association with pictures of the Moulin Rouge, through a large distribution network including department stores and the paris-gifts.com website. The action was based on trademark and trade name infringement as well as passing-off.

Both the Paris Court of First Instance and Court of Appeal dismissed the action. The Moulin Rouge companies’ appeal before the Supreme Court was also rejected by a judgment issued on 31 March 2015 (French Supreme Court, Commercial Chamber, 31 March 2015, No.13-21300)

The trademark infringement action was rejected on the ground that Editions du Tertre did not use the name Moulin Rouge in an isolated manner in order to designate their products but rather in association with pictures of the Moulin Rouge, with the aim of identifying the cabaret which is a feature of Paris’ tourism heritage and which cannot be separated from the building itself. According to the judges, such use is made for descriptive purposes and not to guarantee the origin of the goods at issue. It cannot, therefore, be regarded as use as a trademark, which is a criterion of trademark infringement.

The appellants put forward the argument that the Moulin Rouge building was actually not separable from the business carried out inside that building, with the consequence that the use by Editions du Tertre of the name Moulin Rouge should be regarded as designating that business. However, this argument was also dismissed by the Supreme Court.

The trade name infringement and passing-off actions were also rejected. It was found that the common business of Editions du Tertre was to sell products reproducing the pictures and names of Paris' most famous monuments and that, as far as Moulin Rouge is concerned, Editions du Tertre uses the pictures and name at issue without referring to the Moulin Rouge companies' commercial activity or without causing them any abnormal property disturbance.

[The Japan Patent Office \(JPO\) and the United States Patent and Trademark Office \(USPTO\) launch a Bilateral Collaboration Search](#)  
(Article by Hirohito Katsunuma, Kyowa Patent and Law Office, Tokyo, Japan)

The Japan Patent Office (JPO) and the United States Patent and Trademark Office (USPTO) agreed to launch a Bilateral Collaboration Search Pilot (CSP) program on August 1, 2015. In the CSP program, the JPO and the USPTO will share search results and views about patentability, and provide the examiner's search results to the applicant within six months from the request to use the CSP program. After providing the search results, the substantial examination will be carried out by each office taking into account the views about patentability from the counterpart office.

Applicants who wish to acquire patents in Japan (JP) and the United States of America (US) using the CSP program must file a request for using the CSP program. The first office, either JPO or USPTO, will carry out a search and send the search results to the second office together with its views regarding patentability. The second office will then carry out a search and give its search results back to the first office together with its views on patentability. After the combined search results are given to the applicant, the substantial examination will start in each office independently.

As the examiners' combined search results will be given to the applicant and the views about the patentability will be exchanged between the JPO and the USPTO in advance, the same or similar examination results are more likely in both jurisdictions and the grant of patents can be expected at almost the same time. This will benefit applicants who want to start doing business in Japan and the US at the same time.

As the issuance of the combined search results will be done within six months, the present average time period of ten months from the request of examination to the first Office Action will be further accelerated. Furthermore, as a group of related patent applications can be searched under the CSP program at the same time, the applicants can form patent folios both in Japan and US at the same time in a relatively short time period.

The coordination of searches and examination and the potential for simultaneous grant of patents achieved by the CSP program will better enable applicants to launch new products in Japan and US.

The CSP program is a step toward collaborative examination. Meanwhile, the Patent Law Treaty (PLT) aims to standardize filing procedures. A consistent standardized procedure through filing to examination is desirable. However, several bars for Japan to join the PLT have to be lifted. A bill to amend Japan's patent law to prepare for joining the PLT has been introduced into the Japanese Parliament.

Under the bill to amend the Japanese patent law, if the translation of a foreign language application (JP Amended Patent Law Art. 36bis) is not submitted within a specified time period, the Commissioner of JPO will inform the applicant of the deficiency (JP Amended Patent Law Art. 36bis (3)). The applicant can then furnish the translation within a set time period (JP Amended Patent Law Art. 36bis(4)). The applicant can also furnish the translation even after the expiry of the time period provided if there is a justifiable reason for the failure to furnish the translation within the specified time (JP Amended Patent Law Art. 36bis(6)).

Changes to the requirements for obtaining a filing date have also been introduced (JP Amended Patent Law Art. 38bis). These requirements include an indication of a desire to obtain a patent, the name and the domicile or residence of the applicant and the specification (JP Amended Patent Law Art. 38bis (1)(i)(ii) (iii)). The filing of a Written Supplement will also be allowed (JP Amended Patent Law Art. 38bis (2)-(6)).

[UK Court of Appeal clarifies scope of "Swiss form" second medical use claims](#)  
(Article by Nicola Dagg and Mark Ridgway, Allen & Overy, London, UK)

Warner-Lambert v Actavis [2015] EWCA 556

Developing new uses for known medicines is a good avenue for research, all would agree. Second medical use claims protect investment in such new uses and, in a judgment delivered on May 28, 2015, the English Court of Appeal has given much-needed guidance as to how such claims should be interpreted (*Warner-Lambert v Actavis*).

### **The Swiss form**

The "Swiss form" of a second medical use claim was developed by the Enlarged Board of Appeal of the EPO (G5/83 EISA) and is in the form — "use of substance X for the preparation of a medicament (or pharmaceutical composition) for treating indication Y". It was the only form in which second medical use claims could be made prior to EPC 2000, so many patents in this form still exist. The wording is recognised as a fudge to avoid the "twin perils" of lack of novelty (because the substance is not new) and lack of patentability (because methods of treatment of the human body are not patentable). Although ostensibly a process claim, the technical contribution made by such patents does not lie in the process of preparation or manufacture but in the new use of substance X.

### **The Court of Appeal's decision**

This case related to Warner-Lambert (Pfizer's) Lyrica® (pregabalin) product. Although the compound was no longer protected, Warner-Lambert's second medical use patent (in the Swiss form) related to the use of pregabalin to treat pain. When considering direct infringement in interim injunction proceedings in the High Court, Arnold J took the view that, to infringe such a claim, the person manufacturing/preparing must "subjectively intend" the medicament to be used for the patented indication. However, in the Court of Appeal, Lord Justice Floyd (giving the lead judgment) rejected this construction. He described the subject matter of the claim as "making pregabalin for patients to whom it will be intentionally administered for treating pain". He concluded that it was sufficient for infringement if the person manufacturing/preparing knew (including constructive knowledge) or could reasonably foresee the ultimate intentional use for pain. The manufacturer did not need a specific intention or desire itself. Floyd LJ commented that, on this construction, "it is plain that Warner-Lambert have an arguable case of infringement". Infringement will now be considered at the trial at the end of June 2015.

On indirect infringement under Section 60(2) of the English Patents Act, the Court of Appeal also allowed Warner-Lambert's appeal against the striking out of such claim. The Court did, however, decline Warner-Lambert's application for interim relief. The Court of Appeal also noted in its judgment that, in the event of infringement, "it does not follow that unqualified relief will follow as of right", leaving room for further development of the law in this area.

### **Comment**

The Court of Appeal's finding that reasonable foreseeability was a sufficient basis for a finding of infringement is of great practical importance to holders of second medical use patents. The nature of the relief that is likely to be granted when infringement is found is however yet to be determined. This may well be a matter for consideration at or after the forthcoming trial.

[The Federal Circuit clarifies the Katz exception to the general rule requiring disclosure of algorithms for means-plus-function software claims](#)

(Article by Kristin M. Whidby, Fried, Frank, Harris, Shriver & Jacobson LLP, Washington, D.C. U.S.A.)

*EON Corp. IP Holdings LLC v. AT&T Mobility LLC*, Case No. 2014-1392 (Fed. Cir. May 6, 2015).

EON brought suit, alleging infringement of a patent directed to software that operates together with a television to interconnect various interactive features of the television. *EON Corp.*, slip op. at 4. The asserted claims contained eight disputed means-plus-function terms. One such term, for example, was “means controlled by replaceable software means operable with said operation control system for... reconfiguring the operating modes by adding or changing features and introducing new menus.” *Id.* at 5. After a series of hearings, the district court found that all eight means-plus-function terms were indefinite because no corresponding algorithm was disclosed in the specification. On appeal, the CAFC affirmed.

The CAFC began its analysis with the well-established rule “that the corresponding structure for a function performed by a software algorithm is the algorithm itself.” *Id.* at 7. The court previously defined an “algorithm” as a fixed step-by-step procedure for accomplishing a given result. *See Typhoon Touch Techs., Inc. v. Dell, Inc.*, 659 F.3d 1376, 1385 (Fed. Cir. 2011). Thus, in general, a specification must disclose more than just a general-purpose computer or microprocessor whenever means-plus-functioning claiming is used for computer-implemented inventions. *EON Corp.*, slip op. at 7.

There is one exception to this rule: “a standard microprocessor can serve as sufficient structure for ‘functions [that] can be achieved by any general purpose computer without special programming.’” *Id.* at 8 (quoting *In re Katz Interactive Call Processing Patent Litig.*, 639 F.3d 1303, 1316 (Fed. Cir. 2011)). EON argued the phrase “special programming” implies that a certain level of complexity is required before an algorithm must be disclosed in the specification, and, consequently, an algorithm need not be disclosed if a person skilled in the art could easily implement the software function. The CAFC rejected EON’s argument on two grounds.

First, the court held that the phrase “special programming” refers to **any** programming required so that the microprocessor can perform the claimed functions, regardless of complexity. *Id.* at 11. Thus, the Katz exception is very narrow and is limited to mean-plus-function claims that cover only those general functions that are “coextensive” with a microprocessor itself (such as “receiving,” “storing,” or “processing” data). *Id.* at 9. “All other computer-implemented functions require disclosure of an algorithm.” *Id.* at 11.

Second, the CAFC reiterated “a person of ordinary skill in the art plays no role whatsoever in determining whether an algorithm must be disclosed as structure for a functional claim element.” *Id.* at 12. Instead, the perspective of a person of ordinary skill in the art only becomes relevant when the question is whether a disclosed algorithm is adequate. *Id.* at 13.

Applying this guidance to the present case, the court held that the *Katz* exception was inapplicable to EON’s patent. The eight disputed means-plus-function terms required “more than merely plugging in a general purpose computer.” *Id.* at 9 (quoting *Ergo Licensing, LLC v. CareFusion*, 673 F.3d 1361, 1365 (Fed. Cir. 2012)). That is, the claim terms required “special programming” that would convert a general-purpose computer into a special purpose computer capable of performing the claimed functions. The lack of disclosure of an algorithm in the specification was therefore fatal, even if, as EON contended, a person of ordinary skill in the art was capable of devising some means to carry out the recited functions.

In sum, the *Katz* exception is extremely narrow and will not save patents that fail to disclose algorithms corresponding to mean-plus-function software claims in any but the most limited circumstances.

## National Groups

### Second Joint Seminar of AIPPI China and AIPLA

(Article by Yi Li (Richard), Secretary General of AIPPI China, Beijing, China)

Encouraged by the positive feedback from the first joint seminar between AIPPI China and AIPLA in 2014, AIPPI China hosted the second joint seminar with more than 50 participants and speakers from the two associations in Beijing on May 25, 2015. The event was held in conjunction with the 2015 AIPLA trip to China and was followed by a reception co-sponsored by AIPPI China and Mayer Brown.

Perry Yang, Vice President and Richard Li, Secretary General of AIPPI China together with Sharon Israel, President of AIPLA and Phil Swain, Chair of AIPPI US welcomed the attendees and speakers. The seminar began with two presentations from AIPLA explaining “How U.S. Patent Infringement Litigation is Changing” by Patrick J. Conye of Finnegan Henderson, and “Post Grant Review: The First Two and Half Year’s Experience” by Salvadore Anastasi of Barley Snyder, and continued with two presentations from AIPPI China, with Carissa Li from China Patent Agent (H.K) Ltd. introducing “Draft on the Fourth Amendment to the Patent Law”, and Chris Shao from NTD Patent & Trademark Agency Ltd. updating the audience on the “Draft Regulations on Service Invention”.

The participants were particularly impressed by statistics showing some trends after the AIA Post-Grant Proceedings, and a case study regarding an inventor’s reward that was tried in Shanghai Intermediate People’s Court and Shanghai High People’s Court. The case involved a former employee of 3M China who sued 3M IP and 3M China asking for compensation of 4.4 million RMB, but finally granted 200’000 RMB.

It could not have been more appropriate that the seminar was closed by a short speech of AIPPI’s Vice President Hao Ma. He highlighted the communication and exchange between AIPPI China and AIPLA, which help to deepen mutual understanding and respect and strengthen both of the systems, and to encourage more future activities between the two associations that reflect the ideas of AIPPI.



### About three hundred participants attended the two-day Conference on IP and FOOD (Trademark Day), which took place in Milan on May 20-21, 2015

(Article by Raffaella Arista, Congress Representative of AIPPI)

Fenty (Rihanna) v Arcadia Brands [2014] EWCA Civ 3

The Conference was the first of three events organized during EXPO 2015 by the Italian Group of AIPPI and by the “*Ordine dei Consulenti in Proprietà Industriale*” (Institute of Registered Italian IP Attorneys). It provided a broad analysis of IP rights connected to the protection of the food market and nutrition.

The whole event received the patronage of EXPO 2015, MISE (Ministero dello Sviluppo Economico), MIPAAF (*Ministero delle Politiche Agricole, Alimentari e Forestali*), Lombardia Region and the Municipality of Milan.

International speakers, from Universities, Public Authorities, the food industry, the Italian Bar and the world of trademark consultancy, gave lectures on requirements to obtain a protected PDO (Protected Designation of Origin) /PGI (Protected Geographical Indication) or a collective trademark and suggested the best strategy for choosing the right instrument to develop business. Detailed lectures were also provided on protection of consumers and public health, on remedies against infringement and on the minimum requirements needed to obtain a contract permitting the exploitation of these rights.

Speakers not only discussed the work they have carried out in Italy and the EU, but also in other territories such as China.

The participants were given insight into the worldwide successful experiences of several Italian consortia that received PDO/IGP protection: Balsamic Vinegar of Modena, Piadina Romagnola, Franciacorta wine and Chianti wine. Representatives from these Italian “symbols” explained the main steps of the strict examination they had to pass to obtain the protection and discussed some relevant infringement cases which ended with positive reactions from the competent administrative and judicial Authorities.

The journey into the world of IP and FOOD will continue with **Design Day**, “value and protection of food design and packaging”, and **Patent Day**, “innovation for feeding the planet”, that will respectively take place in Milan on June 22, 2015 and on September 22, 2015.

The “Days” are free of charge and a simultaneous translation from Italian to English and vice versa will be provided.

Please see the online registration and download the programme - <http://ipfood.aippi.it/>.

The Italian Group of AIPPI is waiting for you in Milan!

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AIPPI's (International Association for the Protection of Intellectual Property).  
AIPPI is concerned with all types of intellectual property rights (including patents, trademarks, and copyrights).

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