AIPPI

e-News

No.17

March 2011

International Association for the Protection of Intellectual Property
AIPPI General Secretariat ¦ Toedistrasse 16 ¦ P. O. Box ¦ CH-8027 Zurich
Tel. +41 44 280 58 80 ¦ Fax +41 44 280 58 85
enews@aippi.org ¦ www.aippi.org

AIPPI
e-News

No. 17
March 2011

International Association for the Protection of Intellectual Property
AIPPI General Secretariat |Toedistrasse 16 | CH-8027 Zurich
Tel. +41 44 280 58 80 | Fax +41 44 280 58 85
enews@aippi.org | www.aippi.org

AIPPI´s submissions to the Public Consultation on the possible revision of the Tobacco Products Directive 2001/37/EC

Thierry Calame, Reporter General of AIPPI

The European Commission recently launched a Public Consultation on the revision of the Tobacco Products Directive 2001/37/EC, which includes the possible policy option of future law requiring plain packaging of tobacco products. Such a plain packaging requirement, if implemented, would seek to prohibit use of all trade marks (and other IPRs) on tobacco products, other than word marks in standard size, type face and plain color. AIPPI is concerned about the proposed legislation to introduce plain packaging for tobacco products as its implementation would raise fundamental issues under trademark law. Plain packaging legislation would essentially remove most means for companies to differentiate their products from those of their competitors through product packaging. Accordingly, plain packaging would limit product differentiation and the consumer´s ability to make informed decisions to buy the product of their choice. Equally, plain packaging would unduly restrict and invalidate the pre-existing rights of trademark owners in the tobacco industry. In addition, the complexity of tobacco packaging is one important element which enables trademark owners and customs authorities to establish whether a product is genuine or counterfeit. Therefore, plain packaging would facilitate counterfeit trade. This presents the risk of an uncontrolled market for illegal products and could lead to a prevalence of cheaper counterfeited items thereby potentially undermining the intention of plain packaging legislation to reduce smoking. Finally, plain packaging legislation would be inconsistent with a number of international treaty obligations under the Paris Convention and the TRIPS agreement. Equally, plain packaging would be inconsistent with Resolution Q151 adopted by the Executive Committee of AIPPI in Sorrento, Italy, in 2000. AIPPI's concerns about plain packaging extend beyond the proposed regulations for tobacco products. AIPPI fears that the introduction of plain packaging for tobacco products could set a precedent for other consumer products and thus introduce greater restriction on trademark use at large. AIPPI has made formal submissions to the Public Consultation on the possible revision of the Tobacco Products Directive 2001/37/EC: the submission can be downloaded by clicking here.

AIPPI
e-News

No. 17
March 2011

International Association for the Protection of Intellectual Property
AIPPI General Secretariat |Toedistrasse 16 | CH-8027 Zurich
Tel. +41 44 280 58 80 | Fax +41 44 280 58 85
enews@aippi.org | www.aippi.org

Update on WIPO Activities of 2010

Laurent Thibon, Deputy Secretary General

Update on WIPO Activities of 2010

On 11 January 2011, a delegation of AIPPI attended a meeting hosted by Francis Gurry, Director General of WIPO. This delegation was composed of Stephan Freischem, Secretary General, Thierry Calame, Reporter General, Gunnar Baumgärtel, Treasurer General, Laurent Thibon, Deputy Secretary General, and Sanna Wolk, Member of the Programme Committee. Four Deputy Directors of WIPO reported on the activities of their respective sectors and outlined their expectations for 2011. The meeting ended with a lunch hosted by Francis Gurry.

A delegation of AIPPI visits WIPO

Francis Gurry welcomed the AIPPI delegation and made general comments on WIPO activities over the previous year. The number of PCT applications increased by 5% and substantially reached the level of 2008. After a 16% decrease in 2009, the number of applications under the Madrid Protocol increased by 13% in 2010. The number of applications under the Hague Agreement increased by 33% in 2010. Harmonizing tasks of WIPO did not attain the expected results in 2010. However, some positive results are expected for 2011 in the Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore and in the areas of copyright and designs (including the prospects of a treaty for the visually impaired, a treaty in broadcasting and a Design Law Treaty). In the infrastructure area, a large effort was made in 2010 to increase documentary collection for the PCT. Mr Gurry also indicated his desire for more interaction between WIPO and AIPPI.

During 2010 the names of the sectors in WIPO were updated to be more modern. For example, the Patent Sector is now the Innovation and Technology Sector. The Trademark and Design Sector is now the General Brands and Design Sector.

Mr Pooley (Deputy Director General, Innovation and Technology Sector) noted that the PCT system generated, in 2010, 73% of WIPO´s income. He reported on discussions at the PCT Working Group meeting in 2010, which looked at the quality of the PCT system including evaluation of searches made by the various ISAs. An important result of 2010 in this respect was the creation of a quality sub-group. WIPO also worked on developing PCT tools for applicants (such as a tool to allow them to upload documents and a cross lingual search tool). For 2011, the major focus of work is to implement the recommendations of the PCT Working Group.

Members of the team of Ms Wang (Deputy Director, General Brands and Design Sector) reported on the activities of this sector. The objectives for 2011 are to reach 33000 applications on the International Registries of Madrid and Lisbon and to obtain the accession of new countries such as Brazil, South Africa and Malaysia. The Hague Agreement saw in 2010, an increase of 32% in applications on the International Designs Registry and the accession of new countries like Norway and Argentina. For 2011, an objective is to bring in Nordic countries, the UK, Germany and Italy. In relation to the Appellations of Origin, a working group has the task of modernizing the Lisbon Agreement, the regulation of which needs to be amended.

Mr Wichard (Deputy Director General, Global Issues Sector) reported that the Intergovernmental Committee achieved some positive developments in 2010 and that some texts are expected in 2011. He underlined that a new working method was employed in the Intergovernmental Committee, which gave positive results. Previously, the texts were drafted by the Secretariat and submitted to the working groups. For the Folklore Working Group, they used open drafting groups with experts from the member states, which gave very positive results. Genetic Resources and Traditional Knowledge are not as advanced as Folklore as there are more political issues.

Mr Onyeama (Deputy Director, Development Sector) reminded us that 45 recommendations have been made for the development agenda (announced in 2010). The challenge now is to obtain concrete results. The Committee on Development and IP has to deal with 19 projects adopted by the General Assembly including (a) technical data base assistance to developing countries; (b) ITT support structure; and (c) developing tools for access to patent information, for the member states. As these issues are more technical than political it is expected that some results may be achieved in 2011.

Francis Gurry finally hosted the AIPPI delegation at a very pleasant lunch.

AIPPI
e-News

No. 17
March 2011

International Association for the Protection of Intellectual Property
AIPPI General Secretariat |Toedistrasse 16 | CH-8027 Zurich
Tel. +41 44 280 58 80 | Fax +41 44 280 58 85
enews@aippi.org | www.aippi.org

Meeting of the AIPPI Bureau with the EPO president and other officials

Stephan Freischem, Secretary General

Meeting of the AIPPI Bureau with the EPO president and other officials

AIPPI delegation:
Yoon Bae Kim– President
Thierry Calame– Reporter General
Stephan Freischem– Secretary General
Gunnar Baumgärtel– Treasurer General
Laurent Thibon– Deputy Secretary General

EPO delegation:

Benoît Batistelli President
Raimund Lutz Vice-President Directorate-General Legal/International Affairs
Wim van der Eijk Principal Director, Patent Law and International Affairs
Milena Lonati Principal Director, Quality Management
Mr. Eugen Stohr Director, International Affairs
Heli Pihlajamaa Director, Patent Law
Alfred Spigarelli Director, Patent Procedures Management
Niclas Morey Director, Trilateral Affairs and International Organizations & Associations

On 1 February 2011, members of the Bureau of AIPPI met with senior officers of the EPO and discussed current patent issues. The main objectives of this meeting were to provide first-hand information on current developments in the EPO; to report on recent investigations and publications of AIPPI and to identify options for future collaboration between the EPO and AIPPI.

International cooperation and work sharing
The first part of the meeting considered different initiatives in international collaboration by IP offices. This included a review of latest developments of the IP5 initiative (www.fiveIPoffices.org) launched by the EPO, USPTO, JPO, KIPO and SIPO in 2007, and of the Trilateral (EPO, USPTO and JPO). Some of the ten Foundation Projects, established in October 2008, are rapidly advancing: one category of initiatives is directed to improving accessibility of prior art to examiners; this includes common classification and machine translation.

A Cooperative Patent Classification (CPC) based on the ECLA and co-managed by the EPO and the USPTO has been adopted. The CPC is based on WIPO´s International Patent Classification (IPC) system and will considerably facilitate sharing and joint use of search results.

A pilot for a common citation document (CCD) aimed at facilitating efficient access to and re-use of search results has been set up. All the trilateral offices will enter their search results in a format similar to the International Search Report for PCT applications into this joint document.

To enable examiners worldwide to use the search results of other major offices, the EPO, like WIPO, is working hard to improve machine translations. Existing patent translations can be used to improve the accuracy of such translations. AIPPI proposes use of the patent classification for machine translations as terms may have different meanings and translations depending on the technical field in question.

As part of inter-office work sharing, the exchange of unpublished prior art is problematic. Clarification is needed on whether the 18 month period, during which an application is confidential from the public, prevents confidential inter-office communications for the purpose of sharing the search results.

The PCT system provides a very convenient platform for work sharing. The trilateral offices (EPO, JPO and USPTO) will offer to applicants an additional joint service of a collaborative search carried out by examiners from all three offices; this is likely to speed up considerably examination after entry into the national/regional phase and to improve the patent quality. AIPPI welcomes this initiative but fears that applicants may be reluctant to use this service if it adds significantly to the PCT costs. AIPPI proposes that at least some of the costs of this service should be financed from savings made during national/regional searches or examinations.

Recent and future changes to the EPC
Mandatory submission of the search report of the office of first filing under new Rule 141 is considered to be very useful to the EPO examiners as it is still difficult to obtain such search reports directly from other offices. Rules 161 and 162 of April 2010 will be revised to change the deadline from one to six months. This amendment becomes effective on May 1, 2011. Further changes to Rule 71 introduce an additional round for correcting clerical errors after the 71(3) communication is received. An official notification on the event triggering the 2-year deadline of Rule 36 for filing divisional applications is intended.

The EPO is considering changing the third party observation procedure to increase its attractiveness by keeping any third party informed of progress of the proceedings including any consideration of its intervention. Also, additional options for Examiners to request clarifications before performing the search are being investigated.

AIPPI is very critical of new Rule 36 restricting applicant´s rights to file divisional applications. AIPPI Resolution Q 193 calls for the opportunity to file divisional applications any time before grant of a patent. This resolution, amongst others, was adopted in 2007, on the basis of the existing regime in the EPO. AIPPI observes that other initiatives to restrict the right to file divisionals were stopped. In Argentina, the PTO stopped a similar proposal after harsh criticism. In the United States, the Supreme Court declared such a proposal from the USPTO invalid. The EPO sees the new rules on divisionals not so much as a limitation of the applicant's rights but as a means for accelerating and streamlining the procedure. The success of these rules will be evaluated over the next two years.

AIPPI mentioned a further unexpected effect of the 2010 rule change; new Rule 137 (5) EPC, excludes claim amendments relating to unsearched subject-matter. The EPO will not perform supplementary searches for regionalized PCT applications if it has executed the international search. Thus, Rule 137 (5) may exclude certain PCT applications entering the EPO with

amended claims from examination. The applicant would have to file a divisional application after entering the regional phase to enable the EPO examiner to search and examine the amended claims. The EPO response is that Rule 137 (5) only links claim amendments to the search during the European phase. Any claim amendment within the original disclosure, filed upon entry into the European phase, must be examined by the EPO examiner independent of whether it was considered in the ISR or not.

Patent quality standards
The EPO has developed an increasing number of tools (such as surveys and statistics) for obtaining metrics on the quality of patents. Comparative studies of the trilateral offices on the use of the PCT system and studies on schemes for deferred examinations will be considered for optimizing and harmonizing patent proceedings.

AIPPI activities
Thierry Calame (AIPPI Reporter General) informed the EPO about recent AIPPI resolutions concerning patentability criteria and explained the working process leading to such resolutions. Also, he explained the current project of AIPPI concerning inventive step / non-obviousness requirement: it commenced in 2010 with Q213 (The person skilled in the art in the context of the inventive step requirement in patent law) and will be continued in 2011 with Q217 (patentability criteria for inventive step / non-obviousness). The EPO observes these investigations closely and it appreciated the update on AIPPI´s work results in this area. AIPPI was invited to contact the EPO if it needed official support from the EPO for its work or at its meetings.

It was very encouraging to see that, under the current President, the EPO has immediately responded to comments and criticism from users of the patent system concerning the 2010 rule changes. The EPO remains very open to external input: AIPPI will not miss this opportunity to continue to communicate its views to the EPO and looks forward to continuing this fruitful cooperation.

AIPPI
e-News

No. 17
March 2011

International Association for the Protection of Intellectual Property
AIPPI General Secretariat |Toedistrasse 16 | CH-8027 Zurich
Tel. +41 44 280 58 80 | Fax +41 44 280 58 85
enews@aippi.org | www.aippi.org

Access to Medicines, Patent Information and Freedom to Operate jointly organized by WHO, WIPO and WTO, February 18, 2011, Geneva.

Konrad Becker, chairman of Q166

Some very prominent and experienced speakers at the symposium gave a good overview of the actual problems and possible solutions for access to medicines, patent information and the determination of freedom to operate. The symposium was divided into three sessions, each concluded by a discussion round.

Most drugs on the WHO Essential Medicines list (EML) are patent free. For those that are still under protection, the main concern is length of protection but, also lack of knowledge about the patent situation, i.e. what is protected, where, and for how long. Patent information raw data should be transformed into accessible, reliable, neutral and relevant information. The discussion then centered around problems for the generic industry, a plea that WIPO should take central responsibility in providing national entry and grant/rejection information, and transparency of patent information.

A study on the patent status of 77 protected medicines on the WHO EML was presented. The first step was finding a US base patent, then finding derivative patents in the US FDA Orange Book. Family searches in databases (Derwent World Patent Index, INPADOC, LexisNexis Total Patent Family) led to more or less complete patent families. Patent owners were then asked to check and complement the data, and most patent owners were found to be cooperative.

Efforts to create a patent pool for antiretroviral (ARV) drugs were reported. This pool was established in November 2010 and - so far - had obtained a license from NIH, but it hoped for more. A pre-requisite for the pool was for it to be updated with reliable and timely patent information. Information was difficult to obtain (if at all) from developing countries.

Vaccines were not included in the WHO EML; methods of making vaccines were usually in the public domain. However, some of the more effective adjuvants were still under protection. For nearly all approved vaccines, except human papilloma virus (HPV) vaccines, patents were not a barrier, . There were several vaccines for dengue fever in development, and each player seemed to have the needed patents in hand (and did not interfere with the other companies). Generic vaccines were not in sight since practical difficulties in vaccine production were dominant, and all vaccines had to undergo proper testing and registration.

In the discussion, there was concern that developing countries lacked capacity with regard to both patent lawyers and scientists, who understood patents. Very often, patent information, if available at all, was not accurate. Some further problems in developing countries were taxes and tariffs, even on life-saving drugs, fakes and low-quality copies. Lack of patents in a developing country was not the only question to be addressed; but, also patent protection in a country where the drugs could be manufactured cheaply and then exported.

An overview of patent information resources and WIPO experience on legal status information was given. Some information was available from national patent registers and national patent gazettes/bulletins. Many countries did not report pending applications, but only grants, and the publication of gazettes suffered substantial time delays. Secondary sources on legal status were EPO´s INPADOC database, available through espacenet, and WIPO´s Patentscope. Their reliability was directly dependent on the reliability of national databases and the provision of information in a timely manner.

Very often there were information gaps because the chemical names, INNs (international non-proprietary names assigned by WHO) and brand names, did not match or could not be retrieved.

Translations seemed to be another major hurdle. Also, a claims analysis needed to be performed but this was not just a matter of counting patents. Pitfalls included the possibility of continuation/divisional applications and the possibility of patent extensions popping up later, even though the basic patent had lapsed or expired.

” In discussion at the symposium, it was again pointed out that a procurement officer in a developing country could not do his job if the country did not make patent information available to the public. A complaint was aired that patent attorneys “encoded ” simple things when writing patent applications, so that patent attorneys were needed to “decode ” the text to allow the lay person to understand it.

In the final panel discussion, a plea was made that the databases should be fed by patent applicants. Since INNs did not exist at the time of filing the basic patent, there should be a requirement to include these INNs in patent applications as soon as they were known. The panel concluded that research and generic industries needed each other and that both had their place in the health industry.

From the viewpoint of an AIPPI representative (and patent attorney), it was clear that AIPPI has an ongoing task of explaining the patent system to the general public. Once again, it was felt that those not directly involved very often mixed up patent applications and granted patents. Also,there is a clear need to educate the public and regularly reinforce the need to always check the scope of granted claims to find out whether a patent is important for a particular medicine, its manufacture and possible uses.

The important conclusions of the symposium are:

* all countries should make their patent registries available for searching on the internet at no charge;,

* such registries should provide information about whether or not a patent application/patent belongs to a particular patent family;

* whether a patent application has been filed and is pending should be available in the publicly accessible part of registries´ databases, no later than 18 months after filing; and

* granted patents should be available (at no charge) to allow determination of the scope of patent claims.

AIPPI
e-News

No. 17
March 2011

International Association for the Protection of Intellectual Property
AIPPI General Secretariat |Toedistrasse 16 | CH-8027 Zurich
Tel. +41 44 280 58 80 | Fax +41 44 280 58 85
enews@aippi.org | www.aippi.org

Working Questions Hyderabad

Thierry Calame, Reporter General

Q216 Exceptions to copyright protection and the permitted uses of copyright works in the hi-tech and digital sectors

Question Q216 continues the studies on exceptions to copyright protection and the permitted uses of copyright works in the hi-tech and digital sectors which led to the Paris Resolution in 2010. Initially, the intention was to deal with exceptions and limitations in the context of Internet Service Providers (ISPs), search engines, social networking sites such as Facebook and Twitter, format shifting/digitisation, orphan works as well as the fair use and private use exemptions in one question. During the preparatory work, however, it became clear that the Question is too broad to be covered by one Resolution. The topic is, therefore, dealt with in a two year-cycle. While the Resolution adopted in Paris in 2010 dealt with ISPs, format shifting/digitisation and orphan works, the other issues will be studied now. Specifically, this Question will first explore exceptions or permitted uses in relation to user-generated content (UGC), whether these exceptions apply to social networks such as YouTube, MySpace and Facebook which encourage internet users to upload UGC onto their sites making the content publicly available to others, and finally, whether there are any limitations on those exceptions and permitted uses when these UGC sites are put on notice of unlawful content uploaded by internet users. Secondly, Q216 will look into the question what exceptions or permitted uses apply in relation to temporary acts of infringement and whether transient copies of electronic works held for example in a cache or in a computer's working memory (RAM) amount to infringing copies. Thirdly, search engines roam the internet searching for key words in the URLs and metadata behind websites and supply large quantities of information to the user on the search results page by way of a collection of hyperlinks as words or images (thumbnails). This Question will deal with the issue of whether there are any exceptions or permitted uses relevant to the hyperlinking or location tool services provided by these search engines. Finally, Q216 will explore whether there is a private copying exception and if so whether any copyright levies apply to such private use.

Q217 The patentability criterion of inventive step/non-obviousness

The inventive step / non-obviousness requirement has become the focus of attention on many levels. The European Patent Office's initiative to 'raise the bar' and the US Supreme Court decision in KSR v Teleflex are only two examples of recent attempts to revisit the inventive step requirement. In view of the breadth of the topic AIPPI decided to deal with this question in two consecutive years. Q213 commenced with an examination of the role of the skilled person in the context of the inventive step requirement regarding patent validity and infringement, which was considered at the 2010 Paris Congress and led to Resolution Q213. Q217 continues these studies by exploring the larger and more fundamental question of the patentability criteria for inventive step / non-obviousness. Inventive step is approached differently in different jurisdictions. Therefore, the studies will first deal with the standard and required level of inventive step. Secondly, Q217 will explore how claims are construed and how prior art is interpreted in different jurisdictions. Thirdly, Q217 will look into the question of whether lack of inventive step can be found over a single prior art reference and whether two or more prior art references can be combined. Fourthly, the Question will consider the role, if any, the technical problem to be solved plays in determining inventive step. Moreover, in some jurisdictions, advantageous effects, secondary considerations (such as commercial success of the claimed invention, failure of others to solve the problem, etc.) and “teaching away” are factors in the inventive step determination. Therefore, Q217 will also explore what role, if any, these considerations play in determining inventive step. Finally, this Question will highlight to what extent the approach taken by a regional patent granting authority during examination may diverge from the approach taken by the national patent granting authority and to what extent the approach taken during examination may diverge from the approach taken by the courts.

Q218 The requirement of genuine use of trademarks for maintaining protection

This Question will look at the genuine use requirement to maintain protection of a trademark, thereby allowing the trademark proprietor to continue to benefit from the rights granted by the registration. As the number of registered trademarks becomes greater, “old registrations” increasingly collide with new businesses in need of standout trademarks for their goods and services, and therefore the use requirement is an interesting current topic of trademark law. Q218 will first deal with the nature and level of required use to maintain protection. The aim of this investigation is to distinguish “use” that does not meet the standard. In this respect, Q218 will consider factors such as the scale of use, time and geographic considerations, internal, test marketing and promotional uses as well as use by a third party. Moreover, this Question will also look into the issue of a proprietor´s concrete use in comparison to the trademark as represented in the Register – both in respect of the goods and services registered and the specific appearance of the trademark. What is the effect if the use is limited to a part of the registered goods or services or, alternatively, if distinctive elements of the specific trademark are omitted? Q218 will equally address the question of how to prove use, e.g. by way of advertising material and sales figures or, alternatively, survey evidence. Finally, this Question will deal with the consequences if a mark has not been put to genuine use within a prescribed period and whether trademark owners can cure this vulnerable position if they can rely on a proper reason for not having put the mark to genuine use or by starting to use the mark in a genuine way after a prescribed period or by re-registering the trademark.

Q219 Injunctions in cases of infringement of IPRs

The availability of injunctive relief is fundamental to the protection of Intellectual Property Rights (IPRs) as exclusive rights. However, the 2006 decision of the US Supreme Court in eBay v Merc-Exchange demonstrated, at least with regard to permanent injunctions in the United States, that an injunction will not necessarily be granted as a matter of course even if findings of both validity and infringement have been made. This Question will, therefore, examine the conditions under which injunctions - both permanent and provisional ones - are available to protect IPRs. Specifically, Q219 will consider in detail the circumstances in which an injunction either must be granted or will not be available following a finding of validity and infringement. This Question will also consider the extent to which an element of judicial discretion applies to the grant of an injunction and whether there are any specific considerations relevant to particular IP holders, in particular Non-Practicing Entities (NPEs) which use patents not as a basis for producing and selling goods, but for the primary purpose of obtaining license fees. Moreover, Q219 will look at the scope of an injunction a court may be prepared to grant, in particular whether a Court has only the power to grant an injunction against named parties in the proceedings or potential infringers more generally; and whether a Court has only the power to grant an injunction which prevents the specific infringing acts or which prevent infringement of the relevant IPR more generally.

AIPPI
e-News

No. 17
March 2011

International Association for the Protection of Intellectual Property
AIPPI General Secretariat |Toedistrasse 16 | CH-8027 Zurich
Tel. +41 44 280 58 80 | Fax +41 44 280 58 85
enews@aippi.org | www.aippi.org

London Agreement Entering into Force in Hungary on 1 January, 2011

Eszter Szakács, Hungarian Group Reporter

The Republic of Hungary has acceded to the Agreement dated 17 October 2000 on the application of Article 65 EPC ("London Agreement"). Hungary is the 16 contracting state to the Agreement.

The London Agreement entered into force for Hungary on 1 January, 2011. Joining the London Agreement will bring significant cost reductions in the validation of European patents in Hungary.

As of 1 January 2011, no Hungarian translation of the European patent specification needs to be supplied if the patent is granted in English or if an English translation of the patent is supplied. However, a Hungarian translation of the claims must always be supplied. Where no English translation of the patent specification is available, applicants will still have the option of supplying a Hungarian translation.

Importantly, if the Hungarian translation of the claims defines a narrower scope of protection than the original language, the translated version prevails. It is therefore still essential that the translation of the claims is done by skilled professionals based on thorough study and review of the specification. However, this does not apply in revocation proceedings.

It is to be noted that translation requirements are still imposed on patentees in infringement lawsuits and non-infringement proceedings.

Iin the event of patent infringement the Hungarian translation of the patent specification shall be submitted to the Court and the Hungary domiciled or seated infringer shall not be held liable for infringement until the patent claims and specification are supplied to the alleged infringer in Hungarian. Alternatively, the patentee will need to prove that the infringer could have understood the text of the patent even without translation.

If a request for a declaration of non-infringement is filed against the patent the patentee is once again obliged to provide the other party with the Hungarian translation unless the patentee admits non-infringement.

The costs of the translation shall be borne by the patentee in the above cases.

AIPPI
e-News

No. 17
March 2011

International Association for the Protection of Intellectual Property
AIPPI General Secretariat |Toedistrasse 16 | CH-8027 Zurich
Tel. +41 44 280 58 80 | Fax +41 44 280 58 85
enews@aippi.org | www.aippi.org

Integration of the Copyright Office to the Ministry of Commerce and Industry

Irma Murillo de Gago, Attorney-At-Law, IMC Legal, Panamanian Group Reporter

In the Republic of Panama, Bill No. 241 to amend Copyright Act No. 15 of 1994 enacted August 8, 1994 [sobre *Derecho de Autor y Derechos Conexos*] has recently passed third reading by the National Legislature Assembly and is expected to be approved by the Executive, namely the President, shortly.

Bill No. 241 seeks to integrate the Copyright Office with the Ministry of Commerce and Industry. Initially, the Copyright Office was created as a body attached to the Ministry of Education, assisting the Minister of Education in performing the function of state management of copyright and related rights. While the Copyright Office was a subordinate Office under the Ministry of Education, the Patent and Trademark Office was created as part of the Ministry of Commerce and Industry.

The Ministry of Commerce and Industry has traditionally interacted with other public bodies and private entities encompassing inter-agency collaboration and private sector consultation to create a successful policy for economic development.

Underlying Bill No. 241 is the desire to promote the role of IP in a knowledge-based economy. Producing knowledge and technology transfer are key factors to achieving sustainable development in our country.

The legislative initiative to allow national IP policy to rest with the Minister of Commerce and Industry is an effort to strengthen IP protection in the Republic of Panama and to progress the transition of harmonizing national IP Laws with international commitments.

AIPPI
e-News

No. 17
March 2011

International Association for the Protection of Intellectual Property
AIPPI General Secretariat |Toedistrasse 16 | CH-8027 Zurich
Tel. +41 44 280 58 80 | Fax +41 44 280 58 85
enews@aippi.org | www.aippi.org

ECJ decision on European and Community Patent Court

Court of Justice of the European Union, PRESS RELEASE No 17/11

The draft agreement on the creation of a European and Community Patent Court is not compatible with European Union law.
For further information please refer to the website of the Court of Justice of the European Union
http://curia.europa.eu/jcms/upload/docs/application/pdf/2011-03/cp110017en.pdf

AIPPI
e-News

No. 17
March2011

International Association for the Protection of Intellectual Property
AIPPI General Secretariat |Toedistrasse 16 | CH-8027 Zurich
Tel. +41 44 280 58 80 | Fax +41 44 280 58 85
enews@aippi.org | www.aippi.org

US patent law reform is passed by the US Senate; further actionis awaited

Joshua B. Goldberg, United States Group Reporter

On March 8, 2011, the US Senate passed the America Invents Act (S. 23) providing several significant changes to the US patent laws. Some of the provisions in the Senate measure include, among others:

- The ability for the US Patent & Trademark Office to set its own fees and to eliminate the practice of fee-diversion.
- A transition to a first-to-file system (also known as a first inventor to file system).
- Broader leeway for pre-issuance third-party submissions with explanations.
- A new "first-window" post-grant patent opposition system with broader jurisdiction (but a shorter timeframe) than reexaminations.
- A provision that eliminates certain tax strategy patents.
- Creation of Micro-entities.
- An administrative procedure for challenging business method patents.
- Repeal of the residency requirement for Federal Circuit judges.
- Elimination of the best mode defense.
- USPTO authority to establish satellite offices.
- USPTO authority to prioritize applications of national importance.

This bill, which was passed by a 95-5 margin and is supported by the Obama administration, will now move on to the US House of Representatives for further discussion and consideration. Given the strong support in the Senate, this bill is expected to proceed quickly and easily. Further updates will be provided as new information becomes available in this regard, including the full scope and impact of any changes to the US patent laws.