



e-News

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International Association for the Protection of Intellectual Property
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[AIPPI World Congress — Rio 2015](#)
[Agenda of the forthcoming General Assembly](#)
(AIPPI General Secretariat)

In accordance with Article 5 of the Statutes, the Bureau of AIPPI kindly invites you to the forthcoming General Assembly to be held on 14 October 2015 on the occasion of the Rio Congress. The draft Agenda can be found [here](#).

[AIPPI 2015 World Congress in Rio: ready for the start!](#)
(Luiz Henrique do Amaral, Chair Organizing Committee)

With 1,300 registered participants, the success of the World Congress in Rio is guaranteed. The sessions and the speakers are confirmed and the program will show the importance of AIPPI in forging the future of IP worldwide. The list of participants is available online and registrations continue to increase. The social Programme during the Congress will allow participants to see and experience the Brazilian culture. The opening ceremony will be followed by a reception and dinner designed to induce networking by the participants. The cultural evening at Copacabana Palace will entertain participants with a samba show and a real carnival ball. 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. Join before the next discount deadline on 2 September 2015!

Check who has registered so far.

The list of confirmed speakers of the Panel Sessions.

[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.

[Party at the Maracan  stadium](#)
(ABPI)

During the AIPPI Congress in Rio ABPI (The Brazilian Intellectual Property Association) invites you to attend the IP firm party at the Maracan  stadium.

[AIPPI Bureau](#)
[The Annual visit of the EPO by a delegation of the Bureau of AIPPI](#)
(Laurent Thibon, Secretary General of AIPPI)

A delegation of the Bureau of AIPPI visited the EPO on 30 June 2015. The AIPPI delegation comprised Laurent Thibon (Secretary General), Sarah Matheson (Reporter General), G rard Myon (Treasurer General), John Osha (Deputy Reporter General) and Marek Lazewski (Assistant Secretary General).

Forthcoming Events

September 2015: AIPPI Baltic Conference 2015 on-line registration 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.

September 2015: IP & FOOD, 22 September 2015, Milan, Italy

(AIPPI Italian Group)

IP & FOOD - Innovation to feeding the Planet: A journey through name, appearance and innovation of Italian Food Seminar organised by the Italian Group of AIPPI Milan, Italy, 22 September 2015.

View the Programme.

View the Registration.

September 2015: GRUR Annual Meeting 2015, 23-26 September 2015, Freiburg, Germany

(The German Association for the Protection of Intellectual Property (GRUR))

The German Association for the Protection of Intellectual Property (GRUR) cordially invites you to take part in the GRUR Annual Meeting in Freiburg, Germany, 23-26 September 2015.

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

Argentina: The Federal Court of Appeals considered implicit disclosure at the time of analyzing the support requirement

(Ignacio Sánchez Echagüe, Marval, O'Farrell & Mairal, Buenos Aires, Argentina)

The Federal Court of Appeals (City of Buenos Aires) decided, once again and in line with an earlier Pfizer decision (see AIPPI e-News No. 39, Dec. 2014), that the patent owner is entitled to claim obvious variations of the subject matter originally disclosed.

China: The Supreme Court of China affirmed the Invalidation Decision which declared a Chinese patent involving Lipitor of Pfizer invalid

(Ke Ke, China Patent Agent (H.K.) Ltd., Beijing, China)

In a recent judgment, the Supreme Court of China affirmed an Invalidation Decision which invalidated a Chinese patent involving Pfizer's drug Lipitor. Over and above the commercial importance of Lipitor, the judgment sheds some light on the required standard of sufficient disclosure and the use of post-filing data in China.

China: Trademark Invalidation on through Administrative Procedure

(Yuncheng Li, CCPIT Patent and Trademark Law Office, Beijing, China)

In China, Siemens has successfully invalidated, through an administrative procedure with China's Trademark Review and Adjudication Board, a number of trademark registrations, such as Cloud CT and Cloud MR, which, according to Siemens, are generic names or directly descriptive for medical diagnostic instruments.

India: Compulsory license application for "Saxagliptin"

(Neha Srivastava, Remfry & Sagar, Gurgaon, National Capital Region, India)

A recent application made by an Indian pharma company at the Indian Patent Office seeking a compulsory license over AstraZeneca AB's anti-diabetes drug "saxagliptin" is garnering sizeable attention. This is the third instance of such an application being made in India.

Japan: "Tripp Trapp" chair as a copyrighted work in Japan

(Masakazu Hoshino, Attorney-at-Law, Yuasa and Hara, Tokyo, Japan)

Many Japanese lawyers were surprised at the IP High Court judgment on April 14, 2015, which stated that the "Tripp Trapp" chair is protected as a copyrighted work since there was a general understanding in Japan that applied art is copyright-protected only in exceptional cases.

[Switzerland: Doctrine of Equivalence: 3-step-test applied by the Swiss Federal Patent Court](#)

(Peter Widmer, FMP Fuhrer Marbach & Partners, Bern, Switzerland)

The Swiss Federal Patent Court applies the Doctrine of Equivalence in construing the meaning of “imitation” of the patent claims as stated in the Art. 66 sec. 1 lit. a of the Swiss Patent Act (SPA). Infringement by equivalence is tested by the court by way of a 3-step-test.

[U.S.A.: In a Unanimous Decision, an En Banc Federal Circuit Expands the Scope of Literal Patent Infringement](#)

(Joshua B. Goldberg, Nath, Goldberg & Meyer, Alexandria, Virginia, U.S.A.)

In a unanimous decision, the CAFC provided a new, expansive, test for assessing alleged infringing acts not performed by a single infringer. Specifically, the question is “whether all method steps can be attributed to a single entity.”

[International: WIPO/WEF](#)

On April 15, 2015, WIPO, together with the World Economic Forum (WEF) launched a new program of assistance for under resourced inventors in developing countries: the WIPO-WEF Inventor Assistance Program (IAP). For more information, please consult <http://www.wipo.int/iap/en/>.

[National Groups](#)

[Argentina: AIPPI Regional Seminar](#)

(Ignacio Sánchez Echagüe, Marval, O’Farrell & Mairal, Buenos Aires, Argentina)

On August 7th 2015, the first AIPPI Regional Seminar (Argentina — Chile — Paraguay — Uruguay) on trademark matters (in particular, the cancellation of trademarks due to their lack of use) and patent matters (focusing on the patentability of pharmaceutical inventions), was attended by approximately 70 IP professionals.

[China: The 2015 AIPPI China Youth IP Seminar](#)

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

The “2015 AIPPI China Youth IP Seminar” was held in Beijing on 24-25 July 2015 and featured hot IP topics ranging from “How to stop free riders” to “Overview on damage rewards in patent infringement litigation”, and was again presented in English as it was done in 2014.

[Japan: 13th AIPPI Japan - China - Korea Trilateral Meeting in 2015](#)

(Goro Umeda, Secretariat of Japanese Group, Tokyo, Japan)

The annual meeting of the Japanese, Chinese, and Korean Groups took place from Friday 12 to Sunday 14 June 2015 in Nara, the ancient capital of Japan.

[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 Bureau](#)

[The Annual visit of the EPO by a delegation of the Bureau of AIPPI](#)

(Article by Marek Lazewski, Assistant of the Secretary General of AIPPI)

The meeting between AIPPI and the EPO is a well established tradition and provides a very good overview of important political and practical developments at the EPO, and also at other important international harmonisation and development fora on which the EPO is actively present. The latest developments at the EPO were presented, including:

- the possibility of signing validation agreements, whereby a non-EPC contracting state signs an agreement to allow patentees to have their European patent application validated in that contracting state (the first country to avail itself of this opportunity was Morocco, and negotiations are ongoing with other countries);
- improving access to prior art, and in particular Asian prior art documents (out of interest, citations of Asian prior art have risen from 2% to 25% of citations); and

- standardising documents and expanding on the EPO's Patent Translate service (the fact that many non-EPO examiners use the Patent Translate service is a testament to its quality and reliability).

The EPO is also very proud of its improving efficiency in terms of timeframes for the issuing of search reports and examination communications, for example, while maintaining levels of employment. The role of the EPO in various capacities within the PCT system was also discussed. The EPO is also proud of its performance based promotion and career criteria.

The meeting also discussed the independence of the Boards of Appeal and the perception of this independence within the public. The EPO indicated that it would finalise a proposal regarding the independence of the Boards of Appeal before the end of 2016.

The EPO is also optimistic about the speedy implementation of the Unitary Patent and Unified Patents Court (UPC). There have been numerous breakthrough developments in this regard, including Italy now ratifying the UPC agreement, CJEU's dismissal of Spain's UPC challenge, and political agreement on fees. The EPO is hoping for the UPC to commence in 2016 already.

The meeting also discussed the issue of added matter, which has just been voted in as a question to be researched by AIPPI for the Milan World Congress in 2016. This coincides well with ongoing work at the EPO, with the aim being to somewhat limit the extremely literal approach taken by some examiners. There will be ongoing dialog with the EPO as we aim to adopt a resolution on this topic at the Milan World Congress.

The discussion also covered a number of international harmonisation projects, including: IP5, Tegernsee, B+ group as well as TTIP and TPP negotiations. All these projects have now entered a phase of substantial details, which makes the work even more challenging. The danger of a patchwork of solutions emerging was acknowledged, and in this regard the dependability and quality of AIPPI's scientific work continues to be praised and appreciated.

John Osha and Sarah Matheson also presented the latest resolutions from AIPPI which may be of interest to the EPO, including the Second Medical Use resolution from Toronto and the Multinational Inventions topic, which will be discussed at the Rio World Congress later this year.

The discussion also covered numerous other opportunities for co-operation, including patent panels, mutual advertising of events and even the possibility of subscribing to the AIPPI eNews by EPO management and staff.

The delegation of AIPPI was also hosted by EPO President Benoît Battistelli for a lunch, which presented an opportunity for informal discussions between the AIPPI and EPO delegations.



Forthcoming Events

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

(Article by 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.

The title of the event is “What’s up IP? Developments in Intellectual Property Law and Practice” and the topics which will be discussed include:

- IP highlights in neighbouring countries and the new legal framework for the protection of trade secrets in the EU
- European Patent System and Unified Patent Court
- IP litigation (judges panel)

The Organising Committee has invited nationally and internationally well-recognized speakers from the Baltic countries, Scandinavia, Germany, Spain, Russia and the USA who will present and discuss the latest developments in the fields mentioned above.

The AIPPI Baltic Conference 2015 will take place at the Meriton Grand Conference & Spa hotel, conveniently located in the heart of Tallinn, close to the historic Old Town. The Old Town of Tallinn is a UNESCO World Heritage Site and is well known for its authentic and well-preserved Hanseatic architecture. Experience the city of Tallinn and its enchanting combination of old and new, medieval and modern, that gives Estonia its unique flavour.

The format of the AIPPI Baltic Conference 2015 provides variety and has a social programme which includes a welcome reception at the venue hotel, a cultural evening at the majestic Kadriorg Palace and a conference dinner at the legendary Seaplane Harbour. Attending this conference presents great value and an excellent opportunity to meet experts in all areas of IP law from the Baltics and around the world.

Check out the preliminary programme [here](#)

More detailed information and the online registration form is available at www.aippi2015.org

We look forward to seeing you in Tallinn in September!

September 2015: GRUR Annual Meeting 2015, 23-26 September 2015, Freiburg, Germany

(Article by The German Association for the Protection of Intellectual Property (GRUR))

The German Association for the Protection of Intellectual Property (GRUR) cordially invites you to take part in the GRUR Annual Meeting in Freiburg, Germany, 23-26 September 2015.

At this year’s meeting, high-level speakers from academia, private practice and institutions such as the European Patent Office, the German Federal Court of Justice and the Swiss Federal Patent Court will debate the latest developments in European, German and Swiss IP law, with a particular focus on patent law, and share with you their visions on upcoming topics.

The programme will also include an overview of new developments at WIPO and the OHIM, a discussion of current activities at EU level impacting IP issues, such as the ‘Digital Single Market Strategy for Europe’, and an insight into the latest reports by the German Group of AIPPI.

Alongside the working programme, you will enjoy a rich social programme in and around Freiburg, a venerable university town with a rich architectural heritage, picturesquely situated on the edge of the Black Forest, at the ‘three-countries-corner’ where Switzerland, Germany and France meet.

Register now and join the German IP community for an enlightening and inspiring meeting in Freiburg!

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[Articles and notes](#)

[Argentina: The Federal Court of Appeals considered implicit disclosure at the time of analyzing the support requirement](#)

(Article by Ignacio Sánchez Echagüe, Marval, O'Farrell & Mairal, Buenos Aires, Argentina)

Philips ("Koninklijke Philips Electronics c/ Instituto Nacional de la Propiedad Industrial s/ denegatoria de patente", Causa N° 8130/2010, Sala III de la Cámara Nacional de Apelaciones en lo Civil y Comercial Federal, 10/04/2015 — no online version available) was the owner of a patent application related to a recording apparatus. During prosecution, the Argentine Patent Office challenged the support of the claims arguing that certain parameters included in the claims were not specifically disclosed in the specification. This challenge eventually led to the rejection of the case.

Philips appealed the rejection to the federal courts, where the appellate court (Division III of the Federal Court of Appeals of the City of Buenos Aires) revoked the rejection and ordered the Patent Office to grant the case.

The decision of the Federal Court of Appeals, based on the report filed by the official expert, considered that the parameters included in the claims were implicitly disclosed in the specification, and, therefore, the claims were duly supported.

This decision follows an earlier Pfizer case (see AIPPI e-News No. 39, Dec. 2014) where it was decided that the patent owner is entitled to claim obvious variations of the subject matter originally disclosed. Therefore, it may be concluded from the Philips and the Pfizer cases that it is possible to claim subject matter implicitly and/or obvious from that originally disclosed.

It only remains to be seen how the Patent Office will apply these judicial holdings.

[China: The Supreme Court of China affirmed the Invalidation Decision which declared a Chinese patent involving Lipitor of Pfizer invalid](#)

(Article by Ke Ke, China Patent Agent (H.K.) Ltd., Beijing, China)

Patent Reexamination Board of SIPO & Beijing Jialin Pharmaceutical Co., Ltd. v. Warner-Lambert Company LLC with Zhang Chu as the third party of the 1st instance proceeding

In a recent judgment, the Supreme Court of China affirmed an Invalidation Decision made by the Patent Reexamination Board (PRB) of SIPO which declared a Chinese patent involving Pfizer's drug Lipitor to be invalid. The judgment is in the limelight as it addresses the required standard of sufficient disclosure and the use of post-filing data in China, besides the high commercial value of Lipitor.

The patent is owned by Warner Lambert (which is owned by Pfizer), and involves hydrates of crystalline form I atorvastatin containing 1-8 molar of water. The focus of the case was whether the description sufficiently discloses the claimed hydrates; in particular, whether the XPRDs of the hydrates of the same compound containing different amounts of water are the same, whether the description discloses sufficiently the determination of the hydrates, and whether the description discloses sufficiently the preparation of the hydrates. After a detailed investigation, the Supreme Court finally held that the patentee did not prove that the claimed hydrates containing different amounts of water have the same XPRDs, that the description does not determine the amount of water in the prepared crystalline form I atorvastatin, and that the

description does not disclose the preparation of the claimed hydrates, and thus the description fails to disclose the claimed hydrates sufficiently.

In the judgment, the Supreme Court clarified the standard for the evaluation of sufficient disclosure and the acceptability of post-filing data for proving sufficient disclosure.

As to the evaluation of sufficient disclosure, the Supreme Court held that sufficient disclosure requires meeting the following 3 requirements at the same time: carrying out a technical solution, solving a technical problem, and producing an expected effect. The evaluation of carrying out the technical solution should take place before the other two requirements; in other words, the sequence of evaluating sufficient disclosure should firstly be determining whether a person skilled in the art could carry out the technical solution, then determining whether the technical solution could solve the technical problem and produce the technical effect.

As to the use of post-filing data for proving sufficient disclosure, the Supreme Court held that it is not correct to reject post-filing data only on the ground that the data is filed after the application date. Instead, post-filing data should be considered if the data can prove that the person skilled in the art could carry out the invention according to the disclosure of the description based on his knowledge and ability before the application date. The Supreme Court stressed that when evaluating the acceptability of post-filing data, two conditions should be examined strictly: first, whether the experimental conditions, methods and the like could be easily conceived of by the person skilled in the art after reading the description; second, the evaluation should be based on the knowledge and ability of the person skilled in the art.

In light of the above grounds, the Supreme Court affirmed the Invalidation Decision and the 1st instance judgment, and reversed the 2nd instance judgment. In the previous stages, the PRB made the Invalidation Decision in 2009 declaring the patent invalid on the ground of insufficient disclosure, the Beijing No.1 Intermediate Court affirmed the Invalidation Decision in 2010, but the Beijing Higher Court reversed the Invalidation Decision and the 1st instance judgment in 2012 on the ground that the Invalidation Decision did not determine the technical problem of the patent, and was therefore wrong in its reasoning on insufficient disclosure.

Lipitor (Generic name: Atorvastatin) is used for lowering blood cholesterol and for prevention of events associated with cardiovascular disease. It is believed that Lipitor is the best-selling drug in the world.

[China: Trademark Invalidation on through Administrative Procedure](#)
(Article by Yuncheng Li, CCPIT Patent and Trademark Law Office, Beijing, China)

Siemens, a German multinational conglomerate company, is one of the world's most prominent makers of medical diagnostics equipment, including CT, MR, DR, PET/CT scanners and systems. Siemens Ltd. China, which was established in China, is a wholly owned subsidiary of Siemens.

In November 2013, Siemens Ltd. China discovered that a company had registered with the Chinese Trademark Office trademarks such as Cloud CT, Cloud PET/CT, Cloud MR, Cloud DR, Cloud MI and their equivalent in Chinese characters for goods including medical diagnostic and imaging equipment and instruments. It appeared that the registration of the said trademarks could have prevented Siemens and other competitors in the same industry from using these names in China.

Siemens Ltd. China therefore, filed an invalidation proceedings action against the registrations with the Trademark Review and Adjudication Board (TRAB).

It was found that in the industrial healthcare sector, particularly in the diagnostic and imaging sector, the initials in the registered trademarks are generic terms for:

CT = Computed tomography

PET/CT = Positron emission tomography—computed tomography

MR = Magnetic resonance (imaging)

DR = Digital radiography

MI = Molecular imaging

In addition, the word “Cloud” has in recent years become a synonym for “cloud computing”, a technical term that is used in almost every sector of industry. According to Article 11 of the Chinese Trademark Law, the following signs shall not be registered as trademarks:

1. those only comprising generic names, designs or models of the goods in respect of which the trademarks are used;
2. those having direct reference to the quality, main raw materials, function, use, weight, quantity or other features of the goods in respect of which the trademarks are used; and
3. those lacking distinctive features other than the aforesaid.

The argument was that the subject trademarks at issue are either generic names or directly descriptive, and thus these trademarks lack distinctiveness.

At the end of 2014, TRAB issued 7 decisions respectively, all in favour of Siemens Ltd. China, declaring the respective registrations to be invalid.

[India: Compulsory license application for “Saxagliptin”](#)

(Article by Neha Srivastava, Remfry & Sagar, Gurgaon, National Capital Region, India)

Introduction

“Saxagliptin”, a dipeptidyl peptidase-4 (DPP4) inhibitor which is prescribed for the treatment of Type II diabetes mellitus made headlines recently when an Indian pharmaceutical manufacturer - Lee Pharma Limited — filed a compulsory license application for the drug at the Indian Patent Office. This drug is patented in India by AstraZeneca AB and sold under the brand names “Onglyza” and “Kombiglyze”. Given that in India more than 7% of its 1.2 billion people are afflicted with diabetes - the entire pharma community is watching the case keenly.

The story so far

Compulsory licensing in India first caught attention in 2012 when Natco Pharma succeeded in obtaining such a license for Bayer’s anticancer drug Nexavar (sorafenib). The following year, another Indian generic, BDR Pharma sought a compulsory license for Bristol-Myers Squibb’s (BMS) Sprycel (dasatinib). But, BDR Pharma failed in its attempt for not having met the precondition of making sufficient prior efforts at negotiating a voluntary license. Lee Pharma’s application is the third of its kind under Section 84 of the Indian Patents Act. In its application, Lee Pharma has tendered evidence of reasonable efforts made towards negotiating a voluntary license from AstraZeneca. Alleging AstraZeneca’s non-responsiveness to its license request, Lee Pharma asserts that:

- Even 8 years after grant, AstraZeneca’s patented drug is “not worked” i.e., manufactured locally;
- Reasonable requirements of the public’ have not been met because AstraZeneca’s drug is sourced entirely from the US and Ireland and upon import, a majority of the drug is re-exported to other countries which has led to more than a 99% shortage in India; and

- The drug is “not available to the public at a reasonably affordable price” because saxagliptin is imported into India at a cost of INR 0.80- 0.92 per tablet but sold at 40 times the price of INR 41-49 per tablet.

After review, the Patent Office has served a preliminary notice to Lee Pharma. While acknowledging that Lee Pharma has made reasonable efforts to obtain a license from the patentee, and has the capacity to “work” the invention in India, the Patent Office is of the opinion that a prima facie case has not been made out.

Particularly, on “working” of the invention, the Patent Office states that manufacture in India is not a mandatory pre-condition to establish working in India and no data was furnished by the applicant to substantiate its position regarding the manufacturing capability of the patentee. With respect to “availability”, the Patent Office noted that apart from Saxagliptin, there are 3 other medicines available for treatment of the same disease in India, such as Boehringer’s Linagliptin, Merck’s Sitagliptin and Novartis’ Vildagliptin, and Lee Pharma has failed to furnish any details to evaluate the “market demand” as a result of these substitutes being present in the market. Finally, on “pricing”, the Patent Office stated that Lee Pharma’s proposed pricing of INR 27-31 per tablet is not a significant discount over AstraZeneca’s retail price and also is several times over the cost of import over AstraZeneca’s drug. Thus, there is no pricing disadvantage.

The Road Ahead

Lee Pharma is expected to enter a request for a hearing to contest the preliminary findings of the Patent Office. In a related development, infringement suit based on the same patent has been filed by AstraZeneca against Lee Pharma where the latter has deposed through an affidavit that its generic version has not been launched in the Indian market and that it has no intention of launching or exporting the patented drug until the compulsory license application is finally decided.

As the IP fraternity waits for the next chapter — the events which have unfolded so far show that, contrary to majority opinion, India is not rushing to decide matters in favour of its generic players but is ready to adopt a balanced, non-biased approach while not compromising on its public interest principles enshrined in the law.

[“Tripp Trapp” chair as a copyrighted work in Japan](#)

(Article by Masakazu Hoshino, Attorney-at-Law, Yuasa and Hara, Tokyo, Japan)

I. Case (Summary regarding copyright infringement)

Peter Opsvik A/S and Stokke A/S (“Appellant”), as a copyright holder and an exclusive licensee respectively for the Tripp Trapp chair (“Appellant’s Product”), alleged that the chairs (“Appellee’s Product”) manufactured and sold by Katoji Co., Ltd. (“Appellee”) infringe the copyright pertaining to the Tripp Trapp chair.

<*Appellant’s Product>
(Tripp Trapp chair)



<*Appellee’s Product>
(One of the Appellee’s Products)



*http://www.courts.go.jp/app/files/hanrei_jp/044/085044_hanrei.pdf.

II. Judgment (Summary regarding copyright infringement)

1. Copyright for Applied Art

a. Copyrighted work is defined as “one in which thoughts or sentiments are creatively expressed” (Article 2 (1) (i) of the Copyright Act) and Article 10 (1) (iv) prescribes “Work of fine art” as an example of copyrighted works. Article 2 (2) prescribes that “Work of artistic handicrafts” is included in “Work of fine art” but the Appellant’s Product, which is mainly for practical use and categorized into “applied art,” does not fall under “Work of artistic handicrafts” since only work mainly for appreciation falls thereunder. Then the question hereunder is whether the Appellant’s Product nevertheless falls under “Work of fine art.”

A copyright should not be denied only on the basis that the work purports to be used practically. Applied art can be protected as “Work of fine art” when satisfying the condition for “Copyrighted work” under Article 2 (1) (i) that her personality should be illustrated in any form. It should be examined depending upon each applied art.

b. The Appellant’s Product has the characteristics of a pair of parts on the left side and right side respectively that constitute the two legs of the chair, etc. These characteristics illustrate the Appellant’s personality. Therefore, the Appellant’s Product is protected as a “Copyrighted work”, falling under “Work of fine art.”

2. Copyright Infringement

a. When determining whether the Appellee’s Product infringes copyright pertaining to the Appellant’s Product, the similarity of both products should be examined, focusing on the characteristics of the Appellant’s Product, which constitute the basis for being copyrighted.

b. While both products have some common features, they are dissimilar when focusing on the two legs of the Appellant’s Product since the Appellee’s Product has four legs. The difference in the number of the legs, which is essential to the basic structure of a chair, should be more influential than common features in other parts. Therefore, both products are not similar.

III. Notes

The Appellee alleged that in order for applied art to be protected as copyrighted work, it should have artistic creativity to the extent that it can be appreciated as art. The judgment for the first instance and another judgment where the same Tripp Trapp chair was at issue were in accordance with such Appellee’s allegation. However, the IP High Court did not accept it and showed us the possibility of “double protection” under the Copyright Act as well as the Design Act for applied art.

Some Japanese lawyers doubt whether design protection is continuously desired under the “double protection” regime since a copyright is more effective in the sense of duration of the right. However, according to the Court, applied art where her personality is not illustrated is not protected under the Copyright Act but may still be protected under the Design Act, and while the scope of the Design right is not necessarily limited to the part and extent her personality is illustrated, the scope of the copyright depends upon them.

Therefore, this judgment will not influence the demand for design protection in Japan but will influence the fields like generic design since copyright should generally be taken into consideration after design protection for applied art has expired.

Switzerland: Doctrine of Equivalence: 3-step-test applied by the Swiss Federal Patent Court
(Article by Peter Widmer, FMP Fuhrer Marbach & Partners, Bern, Switzerland)

BPatGer-S2013-001 Drosiprenon of 21 March 2013; (in German)

The referenced decision dates back to spring 2013. The defendant appealed before the Swiss Federal Supreme Court, which neither expressly confirmed nor dismissed the 3-step-test of equivalence as described above (BGE 4A_160/2013, 21 August 2013). Also, the question was only considered by the SPatC in the course of a summary proceeding aiming at the issuance of preliminary injunctions. However, as the subsequent main proceedings ended without a formal decision, the preliminary injunction became final. Thus, it is fair to conclude that the SPatC will adhere to the 3-step-test as further specified below in future cases where infringement is alleged on the basis of equivalence.

As to the facts of the case, the plaintiff is the holder of two patents for the fabrication of the agent Drosiprenon. It filed for the issuance of preliminary injunctions against the defendant with the Swiss Federal Patent Court (SPatC), claiming infringement of its patents by the use of contraceptives including Drosiprenon.

The court granted a preliminary injunction, applying the Doctrine of Equivalence in construing the meaning of “imitation” as stated in the Art. 66 sec. 1 lit. a SPA. The court referred to the “Schneidmesser”- decisions by the German Federal Court of Justice (Schneidmesser I and II of 12 March 2002, GRUR 2002, p. 515 and 519) and the so called Improver-questions (GRUR Int. 1993, p. 245) and held the following: In order to establish that a process or device in dispute uses a teaching of a patent despite the fact that one or more features of the claim are not literally reproduced but instead have been replaced by other features, the following questions must be answered in the affirmative in order to establish an infringement (E. 17.2):

1. “Same effect”: Do the replaced features have the same objective function?
2. “Accessibility”: Are the replaced features and their same objective function obvious to a person having ordinary skills in the art on the basis of the teaching of the patent?
3. “Equal value”: After reading the wording of the claim in light of the description, would a person having ordinary skills in the art consider the replaced features as a solution of equal value?

Thus, the legal test for determining infringement by equivalence involves the above 3-step-test. Only when all three questions are cumulatively answered in the affirmative, a contested embodiment falls under the scope of the relevant patent claim. As stated by the SPatC, the significance of the case reported lies in the fact that the third question was not previously part of the test of equivalence in Swiss patent case law.

U.S.A.: In a Unanimous Decision, an *En Banc* Federal Circuit Expands the Scope of Literal Patent Infringement

(Article by Joshua B. Goldberg, Nath, Goldberg & Meyer, Alexandria, Virginia, U.S.A.)

On August 13, 2015, the US Court of Appeals for the Federal Circuit (CAFC) issued a unanimous en banc decision following a remand from the U.S. Supreme Court regarding the interplay between literal infringement and induced infringement. See *Akamai Technologies, Inc. v. Limelight Networks, Inc.*, In this case, the alleged infringer, Limelight, directly carries out three of the four steps claimed in the method claim 34 of US Patent No. 6108703 at issue. However, Limelight does not itself “tag[g]ing at least some of the embedded objects of the page so that requests for the objects resolve to the domain instead of the content provider domain” as required by the patent claim. Instead, Limelight contractually required its customers to do their own tagging.

At the initial trial, the jury found that Limelight and its customers jointly and directly infringed the ‘703 patent under 35 U.S.C. § 271(a). Following this verdict, the CAFC decided *Muniauction, Inc. v. Thomson Corp.*, 552 F.3d 1318 (Fed. Cir. 2008), holding that direct infringement of a claimed method requires a single entity to perform every step of the claim (the “single entity rule”). According to the CAFC in *Muniauction*, how-

ever, multiple parties collectively can meet this requirement provided a single defendant exercises “control or direction” over the entire process. Following a lengthy appeal process, the U.S. Supreme Court in June 2014 held a defendant is not liable for inducing infringement when no one party has directly infringed the patent. The case was sent back to the CAFC for reconsideration.

After an initial panel hearing and decision finding no liability for direct infringement, the case was taken up by the full CAFC. Based on the unanimous decision now rendered by the en banc CAFC, the scope of literal/direct infringement is expanded from that described by Muniuction to include certain situations where all the steps of a claimed method are not actually being performed by a single party.

Under the new standard, the “control or direction” a single party has over the entire process can also be found “when an alleged infringer conditions participation in an activity or receipt of a benefit upon performance of a step or steps of a patented method and establishes the manner or timing of that performance. In those instances, the third party’s actions are attributed to the alleged infringer such that the alleged infringer becomes the single actor chargeable with direct infringement.”

In addition, the CAFC held participants in a joint enterprise can be charged with the acts of the other for purposes of direct infringement, stating “Alternatively, where two or more actors form a joint enterprise, all can be charged with the acts of the other, rendering each liable for the steps performed by the other as if each is a single actor.”

The CAFC thus vacated all earlier precedent that limited the scope of literal infringement to principal-agent relationships, contractual arrangements, and joint enterprise. Applying this new standard to the facts of the case, the CAFC held that there was sufficient evidence to support the jury’s verdict of infringement. Accordingly, direct/literal infringement can now be proven in the US in two sets of circumstances where one entity does not themselves practice all claimed method steps, but instead is responsible for others performing those method steps: “(1) where that entity directs or controls others’ performance, and (2) where the actors form a joint enterprise.”

National Groups

Argentina: AIPPI Regional Seminar

(Article by Ignacio Sánchez Echagüe, Marval, O’Farrell & Mairal, Buenos Aires, Argentina)

On August 7th, 2015, the first AIPPI Regional Seminar (Argentina — Chile — Paraguay — Uruguay) on trademarks and patent issues took place, which was attended by approximately 70 IP professionals.

Martin Bensadon, president of the AIPPI Argentine Group, gave the opening remarks where he highlighted the benefits of AIPPI as an appropriate vehicle for sharing common IP experiences and problems.

The first panel discussed the cancellation action of trademarks due to their lack of use. The panel was moderated by Graciela Pérez de Inzaurraga (Argentina).

Jorge Otamendi (Argentina) analyzed the use requirement under the Argentine legislation, together with its historical reasons and its usefulness. Also, Mr. Otamendi commented on the use requirement for products and service trademarks.

Cristián Mir (Chile) provided the Chilean perspective, which still does not provide a use requirement for trademarks. However, Mr. Mir explained that there is a pending bill before the Chilean Congress which would incorporate the use requirements for trademarks. Also, a detailed description of how this requirement would work was provided by Mr. Mir.

Victor Abente Brun (Paraguay) analyzed the Paraguayan requirement of use of trademarks and explained that any use (national and/or international, either performed by the owner or by an authorized licensee) fulfills this requirement.

The last speaker of the first panel was Gustavo Fischer (Uruguay), who explained that this requirement was recently introduced in Uruguay, where it remains to be seen how it is going to be applied.

The second panel, which was moderated by Gastón Richelet, discussed the patentability of pharmaceutical inventions in Argentina (Cristian Bittel), Chile (Santiago Ortuzar), Paraguay (Cristobal González) and Uruguay (Santiago Lapenne).

Messrs. Bittel and González explained the impact of the guidelines regarding patentable subject matter on pharma inventions, which were approved in 2012, and how to circumvent certain restrictions. Also, Mr. Lapenne provided a thorough overview on the patentable subject matter in Uruguay absent specific guidelines on this issue. Finally, Mr. Ortuzar described the patentable subject matter in Chile and how the FTA entered with the US affected this issue.

[China: The 2015 AIPPI China Youth IP Seminar](#)
(Article by (Richard) Yi Li, Secretary General of AIPPI China)

Encouraged by positive feedback from the participants of the “Youth IP Seminar” in 2014, the Group held its “2015 AIPPI China Youth IP Seminar” on 24-25 July, 2015 in Beijing, which was again presented in English.

Mr. TIAN Lipu, the president of the Group, spoke highly of the success of the “Youth IP Seminar” held in 2014 at his opening speech. He was pleased that the plan of having an intellectual property seminar in English by the Group leaders several years ago finally came true in 2014, and continued in 2015. Mr. Tian hoped that this momentum would continue so that this IP seminar could be held annually.

The 2015 seminar was divided into 8 sessions featuring topics ranging from “How to stop free riders” to “Overview on damage rewards in patent infringement litigation” and was conducted in two half days as it was in 2014. The first session after the opening speech was on patent litigation, where a judge from the Supreme People’s Court was invited to give a key note speech. This was followed by two parallel sessions with one on trademark and another on pharma and telecom patent practice. Sessions on the second day dealt with patent prosecution practice, amendment to patent law, patent invalidation proceedings and service invention.

The seminar was well received by all the participants and everyone looked forward to the continuation of these seminars next year.



Japan: 13th AIPPI Japan - China - Korea Trilateral Meeting in 2015
(Article by Goro Umeda, Secretariat of Japanese Group, Tokyo, Japan)

The Japanese, Chinese, and Korean Groups of AIPPI held their 13th trilateral meeting from Friday 12 to Sunday 14 June at Hotel Nikko Nara in the city of Nara.

1. Number of participants

This year, we had 104 participants in total from the Japanese (including its secretariat staff), Chinese, and Korean Groups and the AIPPI Bureau. A breakdown of the participants is as follows:

	Number of participants	
	Last year (Seoul)	This year (Nara)
AIPPI Japanese Group	21	44
AIPPI Chinese Group	46	43
AIPPI Korean Group	66	16
AIPPI Bureau	1	1
Total	134	104

2. Summarized report on organized events

Friday 12 (19:00 - 21:00) Welcome Reception

Saturday 13 (07:15 - 08:30) Morning Excursion

Saturday 13
09:30 - 10:00

Opening remarks by Mr. Hirohito KATSUNUMA, Chair of Organizing Committee

Greeting from the three Groups

Mr. Chuanhong LONG, Vice President of Chinese Group

Mr. Seong-Ki KIM, President of Korean Group

Mr. Eiji KATAYAMA, President of Japanese Group

10:00 - 10:30 Keynote Speech: Mr. Yoshitake KIHARA, Deputy Commissioner, Japan Patent Office

10:30 - 11:00 Keynote Speech: Mr. Ryuichi SHITARA, Chief Judge, Intellectual Property High Court

11:00 - 12:30 Topic 1: Updates on intellectual property systems in each country

China: Mr. Chuanhong LONG

Korea: Ms. Yoon Suk SHIN

Japan: Mr. Hideto KOHNO

12:30 - 13:30 Lunch

13:30 - 15:00 Topic 2: Employee invention system in each country

Moderator: Mr. Kenichi NAGASAWA, Vice President of Japanese Group

China: Mr. Bei LIU

Korea: Mr. Jin Hwan KIM

Japan: Ms. Makiko HIRAI

15:00 - 15:20 Coffee break

15:20 - 16:50 Topic 3: Trade secret (related to Q247)

Moderator: Mr. Shoichi OKUYAMA, Vice President of Japanese Group

China: Mr. Nongfan ZHU

Korea: Mr. Hwan Sung PARK

Japan: Mr. Kazuhiko YOSHIDA

16:50 - 17:00 Closing address by Mr. Kenichi NAGASAWA
18:30 - 22:30 Farewell Dinner

Sunday 14 Excursion and Golf

3. Luncheon meeting of representatives

Representatives from the three groups met over lunch on 13 June to discuss the time and place for the next year's meeting. The Chinese Group recommended Xining in Qinghai province as its host city. The next meeting was tentatively scheduled for Friday 15 and Saturday 16 July 2016.

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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).

AIPPI is the oldest global association for the protection of intellectual property and has the respect and ear of governments and global organizations, such as the World Intellectual Property Organization and the World Trade Organization. Since it was founded in 1897, AIPPI has been consulted (and still is) by decision makers worldwide on current intellectual property issues.

Your contribution please!

Readers of these e-News are encouraged to provide us with their contributions for our future editions. Articles should comply with our current editorial policy and guidelines. Contributions may be submitted by email to enews@aippi.org

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