How the EPO is tackling its backlog

The European Patent Office expects to register about 90,000 patents this year, its President Benoît Battistelli said in a keynote address yesterday. That would be an increase of about one-third on last year, when it registered 68,400 patents.

Battistelli said the growth in registrations was due to “a record increase in productivity” without compromising patent quality. The number of products (such as search reports) completed by each full-time equivalent staff member has increased from 49.8 in 2014 to 60.3 this year.

The Office has added 500 new examiners since 2010, which has been achieved by redeploying some staff to its core business as well as what Battistelli called “a real cultural change: the introduction of merit-based incentives and annual targets for productivity and quality for each examiner, and a reduction in sick leave by 35% in the past six years.

“That is all to improve the quality of our product. By quality, we mean patents that are legally solid,” said Battistelli. The Office is “extremely demanding” in the qualifications required of examiners, and each examiner spends three years learning the job. Every application is still worked on by a team of three.

“This is more and more important because applications are more and more complex and you need an inter-disciplinary approach,” said Battistelli.

The Office has also developed tools such as Patent Translate (which now gets about 20,000 requests each day), the Cooperative Patent Classification, a joint venture with the USPTO which has become “the world standard”, and Espacenet, which has more than 90 million patent documents. Said Battistelli: “Our objectives are stability in our procedures and predictability in outcomes.”

The Early Certainty from Search, launched from 2014, now means that applicants receive a comprehensive search report and written opinion within six months whatever the application route. “We have cleared our backlog in terms of search. Two years ago we had a backlog in search representing three years of work,” said Battistelli, adding that it will be extended to examination and opposition, with target pendency times of 12 months and 15 months respectively by the year 2020.

Finally, the Office has signed or will sign patent prosecution highway agreements that cover 95% of the world’s patent applications. In his lunchtime address, the President reported that in June the EPO Administrative Council approved reforms to the Board of Appeal, including the appointment of a President of the Boards and a move to new premises. “We want to preserve and improve the independence of these quasi-judicial authorities, but also improve their efficiency,” he said, later adding: “Good justice is not only independent but efficient.”

Turning to the Unitary Patent, he said everything depends on UK ratification post-Brexit. If the UK ratifies, then the EPO expects to grant the first Unitary Patent next year. If it does not ratify, the Unitary Patent will still be created but there will be a delay of several years until the UK has left the EU. “I am convinced we will have a Unitary Patent. We are too close to the finalisation of this project not to finalise it,” he said.

Asked about his vision for the year 2025, Battistelli said that he hoped the Unitary Patent would finally be a reality by 2025, adding: “We will have also a more harmonised patent system, maybe not fully harmonised and I’m convinced the patent system will continue to develop if everyone focuses on quality – not only the patent offices but also the professionals. We need good quality applications.”

Copyright reform coming - slowly

Fundamental copyright proposals made by the European Commission will face “a barrage of criticism” and “reform will take some time”. Those were some of the predictions made by panelists at yesterday’s session on the Digital Single Market.

The Commission’s proposals, announced on September 14, cover issues such as portability of content, exceptions to copyright, a new related right for publishers and new rules on remuneration for online content. They are part of the EU Digital Single Market strategy, set out last year. Further initiatives are due to be announced soon.

The Commission’s proposal to implement the plans by the end of next year. But Julia Reda, an MEP and member of the German Pirate Party, said that is “out of the question”. Speaking on yesterday’s panel, she said some aspects of the reforms, such as the neighbouring rights proposal, are very controversial: “This has already been rejected, twice, by the European Parliament.”

Ted Shapiro of Wiggins had a different perspective to Reda on the substance of the reforms, but agreed that “there is a legislative battle to come”. He said: “The proposals will have a profound effect on the copyright acquis. The question is how much.” The panel was moderated by Stefan Naumann of Hughes Hubbard.

Jan Bernd Nordemann of Behmert & Bochmert predicted that the reforms would be “great news for lawyers” as the implications are fought in court. On a more serious note, he said the proposals showed that “we are heading towards a single EU copyright law and copyright title – it’s still live or six steps away but we are getting there.”
The well-dressed IP strategy

What to wear is a dilemma familiar to the style-conscious everywhere and throughout time. And, as a panel... expressed in the AIPPI Congress News do not necessarily represent those of AIPPI or any of its members.

The solution, said Chris Carani of McAndrews Held & Malloy, is to have "many arrows in the quiver". While trade mark rights in the US are essential for most fashion companies, copyright can also be powerful. Although shoes, purses and dresses would generally fall into the category of "useful articles" and not be protectible under copyright law, separate features (for example a brooch on a shoe) can be protected. Fabric patterns can also be copyrightable provided they are original – though, as Carani said, there is a "continuum of originality". He recommended: "Registration is not required, but if you do register you are entitled to statutory damages and attorneys' fees. It’s a very short process, and the filing fee is only about $300."

Similarly, he said trade dress protection is only available "for the most iconic clothes" where the appearance serves as a source identifier as it must be distinctive and non-functional: "These are serious hurdles to overcome."

The most under-used right in the US is the design patent, said Carani. Its advantages include a one-year grace period, a 15-year term with no maintenance fees and an issuance time of between nine and 12 months. Tips for filing designs include: consider just claiming portions of the design, monitor the marketplace for infringements and consider filing dependent applications; and consider multiple embodiments.

Nicolas Martini of Hermès echoed the value of design rights. "Most of our cases used to be about trade marks. Now about 90% involve copying the shape or design of the product," he said. "Some products are intended to last only a few months but then last for years, so designs are very important. The only problem with designs is that registrations are expensive, but we believe they are an asset worth investing in."

Martini outlined the process of deciding how to protect new fashion designs and products, which are typically launched twice a year. "The first thing for us is to make sure we are not copying any existing rights, so every new product is checked by the legal team," he said.

Next, the team looks at which of the new products are expected to be successful, and which are likely to be copied. "They’re not necessarily the same," said Martini. Another consideration is the geographical region: a product might be a target for copying in one jurisdiction but not another.

When it comes to the tools available, a number of interesting questions: "MERely reciting the hardware is going to be helpful, even though both of those things are known," he suggested it might be even smarter to set out how to adapt an existing SIM using the software. "If it’s something physical, and you can do it by software, that should be helpful."

Beem concluded that it could be rejected under abstract idea/mathematical formula, but given that it has a "real-world effect" it might survive under step 2B of the US Alice test. By contrast, Moss said in Europe it would probably fail as drafted but: "If you got some evidence together, you could get over the hurdle ... Or if you had a phone with two SIM cards, you would probably get over the patentability threshold." Nagasawa predicted that the JPO would find the invention to be patent-eligible.

Nack’s final "stress test" hypothetical patent application was simply "a mug with a logo".

"It’s a coffee mug – what could be more real than that?" said Beem, but added: "This is the kind of thing that would face a patentability objection." He predicted it would be found unpatentable under Section 103 in the US. In the UK, it would fail the first step of the Aerotel test, said Moss, while at the EPO, the hurdle would be inventive ness. In Japan, it would clearly not be an invention, said Nagasawa – but it might be protectable as a design or a trade mark.

During the session, the panelists also set out the law and recent cases in their three jurisdictions, and discussed whether there were areas that could be harmonised.
Martini said Hermès considers everything that is available – starting with secrecy (keeping products confidential until they are put on the market) and including copyright (which is available for a wide variety of creations without registration in France), design rights, trade marks (including for features such as belt buckles) and even patent rights for technical inventions. “We know we need to invest in protection. You bet on the future and you never know if you’re going to win or not,” he said.

Federica Zambelli of Moncler agreed that cost is a consideration: “All departments need to be aware that rights have to be seen not as a cost but as an investment.” She said Moncler focuses on securing trade marks and domain names: it has about 2,000 of the former and 1,500 of the latter worldwide.

As well as owning registrations for brand names, it owns numerous shape and three-dimensional marks, which can be powerful in litigation against lookalike products. Moncler recently won Rmb3 million in the Mockser case in China in the first judgment in the country to award maximum statutory damages under the new Trade Mark Law. That is believed to be the highest damages award ever made in a trade mark case in China.

The company also has many design rights, but Zambelli said she felt it could have more, adding: “We have focused on providing internal training (500 hours last year) … We need to build up an internal culture of IP rights.”

Giving an Indian perspective, Pravin Anand of Anand and Anand reinforced the importance of protecting as much as possible, noting that companies have successfully registered trade marks for shapes, sounds and textures in India. Even without registration, he said product design and packaging can be protected, including by passing off. “That’s important from the fashion perspective.” Courts have also upheld trade mark rights, issuing substantial damage awards and other creative remedies (such as painting over an infringing sign).

One challenge in India is copyright protection. While copyright can be powerful – for example a 3D copy can infringe a 2D original – Anand said Section 15(2) of the Copyright Act 1957 poses a problem. This says that copyright in a design is extinguished if the design is registrable under the Design Act but has not been registered and a product bearing the design has sold over 50 items. This provision dates from a UK law in 1911, said Anand: “Fifty is an arbitrary figure which should probably be 50,000 today but it has not been changed. There is a need for law reform.” Possible solutions include abrogation, increasing the limit and introducing an unregistered design right.

During an extensive discussion, the panellists also discussed enforcement and defences, areas for harmonisation and developments to look out for. Carani highlighted the Varsity Brand v Star Athletic case, which is pending before the US Supreme Court and concerns copyright protection for clothes (specifically, cheerleading uniforms). “The question is essentially: is this visual art?” he said, adding: “I expect this decision to have great ramifications.”
Suffering Myriad problems

The highly charged issue of patentable subject matter in the pharma industry was debated in yesterday’s “In(gene)ous but not patentable?” session.

Manisha Desai, associate general patent counsel at Eli Lilly in the US, bemoaned the effect on patentable subject matter of the US cases Bilski v Kappos in 2010, Mayo v Prometheus in 2012, Association for Molecular Pathology v Myriad in 2013 and lastly Alice v CLS Bank in 2014. In these decisions, the Supreme Court has mandated a two-step test for patent eligibility: determine whether the claims are directed to patent-eligible subject matter and determine whether the claim’s elements transform the nature of the claims into a patent-eligible application.

The Federal Circuit has also issued some controversial decisions such as last year’s Ariosa v Sequenom decision, in which a patent covering methods to identify fetal genetic defects by analysing maternal plasma or serum was held invalid. More positively, this year the Federal Circuit found valid a patent for an advance in providing liver cells for testing, diagnostic and treatment purposes, in Rapid Litigation Management v Celladon. “I look at these two cases and I can’t understand it,” said Desai. “If you can get the Court to stop at step one you might be actually ok. The way they applied this test is very confusing, not only for the courts but also for patent drafters and examiners.”

As a result of these cases there is much discussion about patentable subject matter eligibility, and not only in the US. “There are calls for a legislative fix,” she said. “I find it really interesting how this has caused a reaction in rest of the world.”

Shortly before the US Supreme Court’s Myriad decision in 2013, the Australian Federal Court’s Judge John Nicholas ruled Myriad could patent the isolated DNA covered in the same patents as in the US case. But his decision was eventually overturned by Australia’s High Court in October last year. Judge Nicholas spoke on the panel yesterday.

“I upheld the claims on an isolated basis. Isolation was itself enough in that case, remembering the only challenge to the patents in Australia was subject matter validity,” he said. “We weren’t concerned with the breadth of claims, newness of compositions and so forth. The appeal went to the High Court, and all seven of the judges in October allowed the appeal and last year determined all the claims were invalid.”

Biosimilars boom brewing

The large potential of biosimilars – and of patent lawsuits as a result – was discussed in a panel yesterday. Moderator Dominic Adair of Bristows revealed figures showing the biosimilars market was worth $3.0 billion in 2012, up from $1.77 billion in 2010. Fritz Reiter of Sandoz showed a slide projecting that by 2020 this figure would be more like $14 billion.

The number of approved biosimilars so far is 21 in the EU, three in the US, nine in Japan, six in South Korea, and 11 in Australia. This is mostly a result of when systems for applying for biosimilars became effective. However, Australia has had biosimilars for almost the same time as in Europe, so that is probably a market size issue.

“It’s definitely not easier in Europe than in the US,” said Reiter. “The main difference is the timing: we have had 10 years of biosimilars in the EU, whereas the laws came into place in the US in 2012. I would expect in the US that biosimilars would increase dramatically.”

Bryan Zielinski of Pfizer agreed. “Ultimately you are going to see a growing rate of adoption of biosimilars, as in Europe,” he said. “The criteria applied in Europe is largely similar to the US. We are seeing simple and complex biosimilars being approved in the US.”

Unique to the US, the BPCIA outlines a number of steps – known as the patent dance – for resolving patent disputes around biosimilar products. “Whether every single step of the BPCIA is necessary or not will ultimately end up at the Supreme Court,” said Zielinski.

Mei-Hsin Wang of the China BioMedical & Technology Application Association showed a chart illustrating which drugs would be eligible for a biosimilars in the EU and the US and the size of their patent density. “There will be battles over these in coming years,” she said. Humira, the biggest selling drug, has a patent expiry year of 2016 in the US and 2018 in the EU.

RWS Group and inovia provide expert intellectual property translation, filing and search services.
Skinny label uncertainty

The issue of skinny labels was discussed on another panel during yesterday’s Pharma Day called “Skinny labels – wide impact”. Neil Trueman of Mundipharma, Mark Ridgeway of Allen & Overy and Karsten König of Harmen Utescher discussed recent cases in German and British courts. These included two cases involving Warner-Lambert and Actavis where the UK High Court acknowledged an interim injunction aimed at preventing pharmacists from dispensing a generic product for the claimed use despite it being known that off-label sales were likely to occur, and the Regional Court of Hamburg holding that the defendant was prohibited from entering rebate agreements without declarations that their pregabalin products could not be used for the treatment of the patented indication of neuropathic pain. Trueman concluded: “What we are looking for in the industry is more certainty. And give a nod to Pfizer and Actavis for fighting this out. What we need are cases where this is worked out and we come to resolutions. It is all about the circumstances of a given case. It is nice to see these second medical use patents having a lease of life and being useful.”

The panel also featured Thomas Bouvet of Véron & Associés moderating, and Larry Welch of Eli Lilly.

Gesheng Huang of Zhongzi Law Office in China said that chemical innovations could be registered as patentable subject ... featur ed Thomas Bouvet of Véron & Associés moderating, and Larry Welch of Eli Lilly.

1. Obtaining a plasma sample from the human patient
2. Detecting whether JUL-1 is present in the plasma sample by contacting the plasma sample with an anti-JUL1 antibody and detecting binding between JUL-1 and the antibody.

But another example, with the same two first claims but a third claim adding “diagnosing the patient with Julitis when the presence of JUL-1 in the plasma sample is detected”, would be found invalid.

“When I read these examples I was convinced the Patent Office had got it wrong,” said Desai. “What we decided was the Patent Office has a great sense of irony, and they did it to highlight that if you can pass step one you are safe and if you have to go to step two you might be in trouble. It shouldn’t have to be a drafting exercise but it is.”

She says that the threshold for whether something is patentable or not patentable has been put onto the courts. “And the court can basically move it to where they need it to be and it allows them to be lazy rather than go through exercise of novelty or inventive step or is there sufficient description? They can just move this sliding scale and if they don’t like something about the claims they just say it is 101 patent ineligible. I do think the judges are being a bit lazy,” said Desai.

She added: “The Myriad decision was a bit politically charged, especially as Myriad was seen as bit aggressive in asserting its patent. And we are all suffering as a result.”

Similarly, Australia’s Patent Office has given guidance. “The Patent Office has taken what some people are calling the very narrow view of the High Court decision,” said Judge Nicholas. “The upshot of the Patent Office assessment of the many solutions we see and its own analysis of the High Court decision is that you can’t have in Australia now isolated naturally occurring nucleic acid claims, DNA or RNA... nor can you claim to cDNA if it does no more than replicate what you would find in the naturally occurring DNA or RNA.”

Powell commented: “At a time when we are trying to encourage everyone to look for antibiotics, we are discouraging them from patenting them. There is a really difficult policy balancing issue here.”

Denise Hirsch of Inserm Transfert revealed that the Prometheus and Myriad decisions had affected patent licensing. She revealed a survey said 50% of respondents believe both of the decisions had affected licensing activity, 28.6% said Myriad had, and 21.4% said neither had. “The trend is fewer new deals and new deals with lower value,” she said. “But there was no substantial decrease in existing licence incomes nor termination of existing licences. Deal structures do not seem to be changed.”

1-2/12/2016
Hong Kong Convention and Exhibition Centre

IP in the Innovation Era

Mr Yi Xiaozhun
cially, China’s General Director of World Trade Organization

Dr Sonq Luling
Senior VP, Intellectual Property
Huawei Technologies Co. Ltd.

Mr Roger Martin
SVP and Chief IP Strategist, Qualcomm Incorporated

Dr Uwe Over
Corporate Vice President, Head of IP and Associate General Counsel
Henkel AG & Co. KGaA

Mr Udo Meyer, DE
Senior VP and Head of Global Intellectual Property
BASF SE

Forum Highlights
• Growth and Opportunities: The Next IP Development in Asia
• The Future is Open: Managing and Commercialising IP Assets
• Looking into China’s 13th Five Year Plan: New Opportunities in the Innovation Era
• Global Tech Summit

Concurrent breakout sessions under four main themes
• IP Practical Tips
• Industry-specific IP
• Quick Guide to IP Basics

Exclusive 50% discount for AIPPI 2016 attendees!
Register NOW at www.bipasiaforum.com

(Promo Code: BIP2016MPMIP)
Meet AIPPI’s first Chinese President

Incoming AIPPI President Hao Ma took some time out of his schedule during the Congress to talk about his plans for the next two years

What does AIPPI mean to you?
I feel extremely honoured to be an AIPPI member. I’m also honoured to work for and serve AIPPI for several reasons. One is that I believe it is the greatest IP association in the world. The second is that AIPPI is the greatest leader in the development of IP harmonisation. The third is that AIPPI is a great family.

AIPPI has nearly 120 years of history and has made many great contributions in improving and promoting the protection of intellectual property on both an international and national basis, such as the improvement of the Paris Convention and the establishment of the Trademark Law Treaty. Those and many others are the achievements of AIPPI in the past.

Second, AIPPI is the greatest leader in the development, improvement and harmonisation of IP in the world. It has made many considerable achievements harmonising fair, reasonable and well-reasoned IP-related regional treaties and agreements and released more than 700 resolutions, education programmes, conferences, forums and seminars. It is the greatest leader in the IP world. It is also the greatest family of IP experts – lawyers, patent attorneys, patent and trade mark attorneys as well as judges and others. We have 67 groups and more than 9,000 members. This is a very big family.

What impact has AIPPI had in China?
AIPPI helped China to establish the first IP association in China in 1982, the year before China’s first Trade Mark Law and before the Patent Law. Because of AIPPI, China began to learn more about what IP is and why it is important. Now China is the biggest patent filer and the biggest trade mark filer in the world, and more and more people know how to use IP. There are many IP-related litigations in China. It’s very good for China to go further in the future. I want to mention that the first president of the AIPPI Chinese group, Mr Ren, later became the president of the Supreme People’s Court, and was the first person from China to attend a WIPO meeting in 1973. He recommended that China have a patent system and establish AIPPI China.

Because of AIPPI, China organised the international IP forum in 1985, 1992 and 2012. Several years ago, we organised a platform for those young people to exchange views in the English language so that in future they can go to international forums on behalf of China. We also have the trilateral meetings each year which increase cooperation between China, Korea and Japan.

Those are some of the activities of the Chinese group, which has about 350 members today. We are hoping to provide more services to the members, increase the membership and publicise the awareness of IP.

What are your plans as AIPPI President?
It is my great honour and distinctive privilege to be elected as President of AIPPI, the first Chinese person in the history of AIPPI to become President. I will try my best to work with the International Bureau and the members of the association.

For the next two years, AIPPI needs to remain active, to improve efficiencies and enhance its global impact to have more influence on IP while maintaining the scientific research, high-quality education programme and of course the annual Congress. We need to strongly support national and regional groups and our sister associations and connect with national, regional and international institutions.
We need to improve services to our members. I believe we will continue to be a great association, and members need to be able to see the benefits of membership.
We also need to provide an opportunity to young people to exchange views and to learn how to practise IP and to make contributions to IP. We need to attract more young people in inventive ways. It’s a useful
way for young people to grow in their practice.

Next year we will celebrate the 120th anniversary of AIPPI, which is ... but if he is not travelling at a weekend, he enjoys walking in Beijing: “It's important to keep healthy.”

Hao Ma

Hao Ma's career has developed in parallel with China’s IP system. Today he is a partner and patent specialist at CCPIT in Beijing, handling filing, prosecution and litigation. The IP firm is the oldest and one of the biggest in China.

He graduated from university in 1982 and worked as an engineer in a research institute for 10 years, focusing on computer science and electronics. He then studied patent and general law, and qualified as a patent attorney and lawyer. He says he first spoke at an AIPPI Congress at Gothenburg in 2006, having already attended meetings in Geneva and Lisbon. The topic was anti-counterfeiting. “I remember I was worried about English, so I asked my colleagues on the panel for help with the questions.” In 2009 he became vice-president of the Chinese group, and in 2014 he became vice-president of AIPPI. Today he will become AIPPI President.

Hao Ma says his own work and AIPPI work take up most of his time, but if he is not travelling at a weekend, he enjoys walking in Beijing: “It’s important to keep healthy.”

What are your hopes for the future?

I hope AIPPI can increase activity in China. It will be beneficial for people in other countries to know China and for Chinese people and others to exchange ideas so we can learn more and open doors to know the world better. Chinese attorneys are not so active in international forums at the moment, because of the language, but the younger people have very good English. They can play an important role in international platforms in the future, which is important for harmonisation.

I hope that in the next two years we can achieve much. I hope that some of my thinking will be reflected in the AIPPI Strategic Plan, and that we closely work together with the national and regional groups to keep AIPPI as the greatest association, greatest leader and greatest family for the next 120 years.

TWEETS

Bugnion Italian TV interviews @RenataRighettiP, president of Bugnion and @aippi_italia #aippi2016 #aippi_org

Mladen Vulmar Plenary session General at the #aippi2016 Milan successfully completed work on a resolution to be submitted 2 EpCo

Dunstan Barnes @Dominic_adair kicking off the biosimilar panel at #aippi2016 with diagram showing recent growth in biosimilars

AIPLA Ready for friends old and new to visit us in Milan #aippi2016

news

13th Fl., 27 Sec. 3, Chung San N. Rd., Taipei 104, Taiwan, R.O.C. Tel: 866-2-25856688 Fax: 866-2-25989900/25978988 Email: email@deepnifar.com.tw www.deepnifar.com.tw

Prosecution Infringement Litigation

IP STARS

Visit us at booth #3 in the exhibition area to pick up copies of our latest issue, the IP Stars directories and other IP publications.
Courts split over hyperlinking question

T
here is a notable divide between
countries when it comes to the
question of linking to a copyrighted
work on the internet, says Yusuke Inui,
AIPPI Assistant Reporter General. The
question will be debated in today’s Plenary
Session, five years after a resolution on
exceptions to copyright and permitted uses
on the internet was passed at the Hyderabad
Congress.

Since that resolution in 2011, there have
been three important CJEU rulings on the
2001 Information Society Directive (see box),
which have set out a new framework in
Europe based on the concept of hyperlinking
being a communication to a “new public”
that was not intended by the copyright
owner. However, as submissions from the
national groups demonstrate, that approach
is not followed in other jurisdictions, such as
Canada, Japan and the US, where hyperlinks
are generally not viewed as a communication
to the public at all.

The latest CJEU ruling, published earlier
this month, developed the law by introducing
a distinction between websites that are for
financial gain and those that are not.
However, in practice it may take further cases
to clarify what constitutes financial gain.

“There has been some criticism of the
European framework,” says Inui. “Reading
the national group answers on this question,
it is clear that there are two very different
views on this point and it may be quite diffi-
cult to reach consensus.” AIPPI received 41
reports from groups and individual members,
some of which included views from relevant
industries.

Around 40% of groups take the view that
hyperlinking to a copyrighted work should
be considered a “communication” while 25%
say it should not be. Another 25% of groups
say it depends on the form of linking. The
groups are further divided on the question of
whether a “communication” should be con-
sidered to be “to the public” in some or all
cases.

Further questions to be debated are: the
distinction between direct and indirect
infringement; the impact of a disclaimer; the
significance of restriction of access to the
uploaded work; and whether the copyright
work has been uploaded without the authori-
sation of the owner.

Today’s question covers four methods of
linking: hyperlinking to a starting page; deep
linking; framing (the subject of the BestWater
case); and embedding. One key question is
whether framing and embedding should be
treated differently to hyperlinking: the CJEU
has not distinguished so far, but a distinction
is supported by some 60% of groups.

While today’s question raises some diffi-
cult and divisive issues, Inui says he is opti-
mistic that delegates will be able to reach
consensus on at least some points on an area
of law which is both developing and some-
times emotive.

The Plenary Session on Linking and mak-
ing available on the Internet takes place at
09:00 today.

Food companies have a taste for 3D trade marks

A

tendees heard from a range of coun-
sel at food and beverage companies in
the Buon appetito! IP & Food session
on Sunday.

Andrea Chianura of Lavezza in Italy gave
an overview of the coffee company’s strategy.
This included showing the “Cookie Cup”
from 2003, which was edible. The product
prompted some debate within the audience
about what protection the product could have
had. “We could have tried to register a design,”
said Chianura, although in fact it did not.

David Postolowski of Gearhart Law in the US
shared examples of some protected designs,
including the confectionery Hershery’s Kiss
and Peeps. He also said that Nestlé has since
1935 tried to protect the shape of its Kit Kat
bar in the US. In 2010 it was blocked by Cadbury.
Postolowski noted the burden for get-
ing protection is acquired distinctiveness —
the consumer has to have come to rely on the
shape mark in order to distinguish the trade
Source of the goods at issue.

Chianura noted that Nestlé has had simi-
lar problems in Europe, and said he was not
so sure about how distinctive Kit Kat was.
Postolowski responded: “I would tend to agree
except Kit Kat has been around since 1935.”

Postolowski offered some tips for protecting
the look and feel of your food product or
restaurant: focus on unique elements, have
uniformity of the product and logo; be vigilant
about enforcement of infringements, use customer
surveys and make sure it has a visual impact.

Daniele Língua of Ferrero Group in Italy
gave a presentation about copycats. The
company was able to cancel a design of Miki
Maki because it was similar to its distinctive
Tic Tac box. “So we used a trade mark to its
full extent to cancel someone else’s use of a
design,” said Língua.

He stressed the value his company sees in
three-dimensional trade marks. “We prefer
tree-dimensional trade marks,” he said.

“For Ferrero Rocher, if we had just protected
the trade dress we would have been powerless
by now.”

He added: “For a flagship product like
Ferrero Rocher 30 years ago if we had just
protected the shape, the looks of it, the trade
dress as a design by now we would be power-
less in defending against competitors and
not just competitors but imitators. So we
make vast use of 3D registrations and we
own quite a number of registrations
worldwide.”
Your reliable partners for intellectual property matters in Pakistan, South East Asia, Arabian Gulf, Middle East & Africa

SINCE 1949

UNITED TRADEMARK & PATENT SERVICES

International Intellectual Property Attorneys

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

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

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

DUBAI (UAE)
Suites 401-402, Al-Hawai Tower
Sheikh Zayed Road, Dubai
Tel: +971-4-3437 544
Fax: +971-4-3437 566
Email: Dubai@UnitedTm.com

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

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

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

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

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

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

SIERRA LEONE
105, Hunupiliya Lake Road,
Colombo 02,
Sierra Leone.
Tel: +971 11 3222790-1
Email: slanka@UnitedTm.com

SUDAN (Khartoum)
Flat No.1, 3rd Floor, Al Hurriya St.
Shalik Al Deen Brothers Bldg.
Tel: +249-183-740634
Fax: +249-183-796031
Email: sudan@UnitedTm.com

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

YEMEN
6th Floor
Iideal Clinic Building
Hadda Street, Sana’a, Yemen.
Tel: +967 181 9642
Email: yemen@UnitedTm.com
VOXPOP
What is a reform you would you like to see?

Brian Zielinski, Pfizer, San Diego, US
From the US perspective, a change in regulatory exclusivity. I’d like uniform regulatory exclusivity closer in line with what is in Europe.

Clemens Heuschi, Nokia, Düsseldorf, Germany
We are very concerned about the EPO. So reform of the technical boards of appeal is a very, very pressing issue at the moment.

Sharon Israel, Mayer Brown, Houston, US
I’d say that a growing area for reform concerns patent eligible subject matter. It’s important to have patent systems that are fair and balanced and promote innovation.

Jonathan Pollack, Sim & McBurney, Toronto, Canada
One reform I’d like to see is to get our subject matter sorted out because it is pretty bad at the moment.

Mamta R Jha, intl advocate, New Delhi, India
I would like a specialised IP court in India.

Mingo Palacio, Palacio & Asociados, Buenos Aires, Argentina
The requisite formalities of filing docs. Every single document you file in Argentina must be translated by a sworn translator in Argentina, which raises the cost and makes it prohibitive. There is no need, it is a lot of work for nothing.

Oana Laura Boncea, Romanvent, Bucharest, Romania
In Romania, first of all awareness because people don’t know what IP means. They should be more informed. There is a huge problem with research and development in Romania. It is not encouraged at all. People don’t invest in it so there is no IP.
Panelists gave diplomatic answers in a session on the Trans-Pacific Partnership (TPP) trade agreement among 12 Pacific Rim countries and the proposed Transatlantic Trade and Investment Partnership (TTIP) between the EU and US on Sunday.

Moderator Sharon Israel of Mayer Brown began the session by giving an overview of the TPP and TTIP. The TPP was agreed last October, with the countries now having two years to ratify it. This depends on the US in particular.

“It is unlikely anything will happen before the November elections,” said Israel. “It is possible something will happen after the elections and before the next president comes into office, in what we call the lame duck session, but we will have to see.”

She noted that the IP provisions that were “a little more controversial” among industry included protection of undisclosed test or other data for pharmaceutical products and a biologics exclusivity period of five to eight years.

Anthony Taubman of the WTO commented on the TPP: “The TRIPs Agreement is effectively 25 years old and this has been the period of the most dynamic and diverse developments in IP law in human history. And frankly at the WTO we have a pretty inert negotiating agenda so what happens elsewhere is extremely important.”

He added: “It is an imprint of what our members are interested in. They have perceived there is a gap in the legal framework and areas where they have concrete ambitions. There’s no doubt the TPP text is a very strong signal from the negotiating parties… that said, I wouldn’t say we would be expecting it, at least not in my career, to precipitate multilateral standards in the same areas.”

The biologics compromise will be the source of controversy still. Guillermo Carey of Carey in Chile noted that at one point in negotiations Chile drew a line and wanted five years of protection and the US didn’t want to go below eight. At the moment, Chile provides five years whereas the US provides 12.

“Expect a push by the pharmaceutical industry to say, ‘You can’t do this because it will affect availability and price.’ We do see there is going to be a lot of debate because Chile doesn’t think it should go beyond five,” he said.

Lauma Buka, trade negotiator of the European Commission, DG Trade, believes there are two possible outcomes from the TPP: “It might be that the multilateral fora is reinvigorated… or the result might be a complete and total divide between north and south.”

Buka noted that the next, and 1st, round of TTIP negotiations begins in two weeks. She said it is unlikely that the TPP approach of having an IP chapter will be adopted.

“For TTIP it is fairly established between negotiating partners we will not be taking this approach, but instead will pick certain number of issues that are of common interest and put it in very nice treaty language and then go for general principles,” she said. “There is no decision whether the parties would go for something that would require changes of existing law except potentially geographical indications, but even there the likely landing zone of compromise is likely to be between the two systems – the one the US has and the one the EU has.”

She said the link with the TPP is: “We would expect at some point that the US would come with something that would require changes to the EU legislation – on some of the trouble makers in the TPP debate that are patent related issues and data protection topics. Our line is fairly clear: we have no intention to change the current system.”

Various examples of Italian products can be seen around the MiCo during the Congress this week, including these Lamborghini and Alfa Romeo cars. AIPPI thanks all the local companies for their support. If you are staying on, note that Milan Fashion Week starts tomorrow!
**TODAY’S SCHEDULE:**

<table>
<thead>
<tr>
<th>Time</th>
<th>Event</th>
<th>Location</th>
</tr>
</thead>
<tbody>
<tr>
<td>07.30</td>
<td>RGT Breakfast</td>
<td>White 1</td>
</tr>
<tr>
<td>07.30</td>
<td>SGT Breakfast</td>
<td>Meeting 5</td>
</tr>
<tr>
<td>08.30</td>
<td>Panel Session IX: UPC Mock Trial/Brexit (RN/AL)</td>
<td>Blue 1-2</td>
</tr>
<tr>
<td>09.00</td>
<td>Plenary Session IV: Copyright (YI)</td>
<td>Red 1-2</td>
</tr>
<tr>
<td>09.00</td>
<td>Panel Session X: EU TM package (AMV/ML)</td>
<td>Yellow 1-3</td>
</tr>
<tr>
<td>10.30</td>
<td>Coffee break</td>
<td></td>
</tr>
<tr>
<td>11.00</td>
<td>Plenary Session IV: Copyright (YI)</td>
<td>Red 1-2</td>
</tr>
<tr>
<td>11.00</td>
<td>Panel Session IX: UPC Mock Trial/Brexit (RN/AL)</td>
<td>Blue 1-2</td>
</tr>
<tr>
<td>11.00</td>
<td>Panel Session XI: Parody (AMV/JO)</td>
<td>Yellow 1-3</td>
</tr>
<tr>
<td>12.30</td>
<td>Networking Lunch</td>
<td>Level 0</td>
</tr>
<tr>
<td>14.00</td>
<td>Executive Committee II</td>
<td>Red 1-2</td>
</tr>
<tr>
<td>15.30</td>
<td>Coffee break</td>
<td></td>
</tr>
<tr>
<td>16.00</td>
<td>Executive Committee II</td>
<td>Red 1-2</td>
</tr>
<tr>
<td>19.30</td>
<td>Closing Dinner</td>
<td>Hangar Bicocca</td>
</tr>
</tbody>
</table>