Three views from in-house

Diverse perspectives on the challenges of managing innovation in an increasingly politicised climate were provided yesterday by in-house counsel from 3M, Canon and Embraer at a lunchtime discussion. Dean Harts of 3M said that his company recently received its 100,000th patent, while Kenichi Nagasawa said Canon had some 860 people working in IP worldwide. By contrast, said Wander Stange Menchik, Embraer has only been dealing with IP since 2006 and has an in-house team of just four people.

“Our competitors are much larger and have a stronger IP tradition. We’re still learning,” he said, speaking in Portuguese. He said his priorities are to ensure that IP rights and open innovation in that context can present difficulties.

Nagasawa faces somewhat different problems, which include the exponential growth in patents; the threat from patent and trade secrets disputes in Germany, Japan, the US and Korea. “The US is the most expensive jurisdiction for patent enforcement – but also the most expensive for defendants,” he commented.

Malaysia Dairy v Ankenævnet for Patenter og Varemærker in 2013.

In the latter, Yakult claimed Malaysia Dairy had registered a trade mark in Malaysia and a shape mark in Denmark similar to its small plastic bottle for a milk drink in bad faith. An important facet of the CJEU decision was that it determined that the applicant’s knowledge that a third party is using a conflicting mark is not in or of itself bad faith. It said that in order to establish bad faith it is necessary to take into account all relevant factors at the time of filing the application.

Cohen Jehoram gave some advice for dealing with bad faith applications and checking the company is not infringing others’ rights, and to structure the assets in the best possible way – something that is becoming more of a challenge: “The fiscal incentive law in Brazil is being reviewed and that could be a major obstacle if you invest in Brazil.”

On the positive side, there are few competitors and not much litigation in the aviation industry. But Embraer faces challenges arising from open innovation and cooperation: the company has more than 200 contracts with partners all over the world, including with universities and research institutes. Managing the IP rights and open innovation in that context can present difficulties.

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Harts said that 3M is active in 200 countries, and two-thirds of its sales are outside the US; he compared his experience of patent and trade secrets disputes in Germany, Japan, the US and Korea. “The US is the most expensive jurisdiction for patent enforcement – but also the most expensive for defendants,” he commented.

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Fathoming functionality for designs

Panelists were invited to "tame the beast" of functionality in a panel on industrial designs yesterday morning, which also served as an appetiser ahead of the Working Question on design functionality scheduled for debate at next year's AIPPI Congress in Milan.

Design law is one of the least harmonised areas of IP, not least in the terminology used, Chris Carani of McAndrews Held & Malloy said. One issue that continues to cause difficulty is the exception, common to most laws, that covers functional attributes. Speakers from the United States, China, Brazil and the EU discussed various cases where functionality had been addressed (see images).

These cases raise two policy questions regarding functionality, said Carani: first, what is the test to establish whether a design is eligible for protection? And, second, what is the scope of protection when particular elements of a design are dictated solely by function - should any aspects of the design be disregarded?

On the first, as Sara Ashby of Red Solicitors in the UK illustrated, many tests have been proposed, including the multiplicity of forms theory, the alternative designs theory, the aesthetic consideration solely by function – should any aspects of particular elements of a design be disregarded?

On the second, what is the scope of protection when particular elements of a design are dictated solely by function - should any aspects of the design be disregarded?

The applicant's intention is a subjective factor that needs to be proven by means of objective evidence. If possible, provide materials such as emails and other correspondence that show the applicant knew or should have known about your mark and his intention at the time of filing, he advised.

Cohen Jehoram warned it is impossible to prove beyond doubt that the CTO proponent possessed the necessary mens rea when filing to register the contested mark, but the burden of proof can shift when enough probabilities are shown.

Danny Awdeh of Finnegan began his presentation by highlighting US presidential hopeful Donald Trump last month asking for a website called stoptump.us to be taken down on the grounds that it infringes his trademark and was registered in bad faith. He then analysed four Trademark Trial and Appeal Board cases in the US dealing with bad faith: L'Oreal v Marcon in 2012, Telefones De Mex v Estrada in 2010, Edom Laboratories v Lichter in 2012, and Taiwan Semiconductor Manufacturing v Semiconductor Manufacturing International in 2010.

Some bad faith uses can be fairly blatant. In TelMex, Estrada alleged that he intended to use the mark AUDITORIO TELMEX on facilities for events such as sports. He claimed to have never heard of the opponent even though he had lived in Mexico for 30 years and lived 10 miles from the Auditorio Telmex arena.

"So the TTAB found he had been so disingenuous and it was so obvious he was trying to trade off the reputation of TelMex they found Estrada exhibited ‘not only bad faith, but a general lack of respect for the application and opposition process’", related Awdeh.

Awdeh gave some helpful strategies for dealing with bad faith. These cases are highly fact intensive so the burden is on the plaintiff to prove the facts, he said.

Bad faith filings can be addressed through opposition/cancellation proceedings before the TTAB and litigation in federal court. But the TTAB only has the authority to decide registration issues, so if a trade mark owner would like an injunction or damages, it will need to pursue relief through federal courts.

He said the best evidence of bad faith or fraud usually comes from the applicant or registrant itself. "Trade mark owners should take early discovery to obtain documents and written admission surrounding the selection of the mark at issue," he said. In addition, a live deposition may reveal motives indicative of bad faith or fraud.

Mariangela Sampaio from Unilever Brazil noted a number of cases in this country. These included Speedo suing a former partner and an Apple case against the Brazilian registrant for IPHONE.

She gave several pieces of advice for protecting trade marks against bad faith. "Whenever possible try to seek the well-known status of the trade mark," was one of her suggestions. "In Brazil it is possible to seek well known status through a specific procedure."

Another strategy was to check what other registrations those you believe are acting in bad faith are contaminated by those. If they have a large number of registrations that appear to have been made in bad faith this could help your case. "Evaluate what other trade marks and publications the company involved in the conflict has in order to check whether you could use this argument in your defence," said Sampaio.
Potatoes were on the menu at yesterday’s session on collective marks and geographical indications. Armed with promotional golf equipment and cuddly toys, and sporting a potato-themed tie, Patrick Kole of the Idaho Potato Commission illustrated why the state of Idaho in the United States (“a place I’m proud to call home”) produces “the best potatoes in the world”.

Idaho’s elevation, soil quality and history of farming all contribute to its strong potato industry. “We depend on a lot of things to make our agricultural products unique. A geographical indication is a connection to the soil combined with unique qualities of workmanship that go into the product,” said Kole, who noted that Idaho potatoes can command a premium of up to 50 cents per 5lb bag.

To protect and promote the Idaho potato brand, the state created the Idaho Potato Commission in 1937. Governed by nine commissioners, it has a $13.5 million annual budget. Since its launch, the Commission has spent over $400 million on promoting the brand.

But, said Kole: “There are legal problems that come when you become successful,” which means an enforcement programme is essential. Potato manufacturers from other regions have sought to capitalise on the Idaho name: the Commission spent $13 million on one court case against a party that was putting Canadian potatoes into Idaho bags.

Kole’s potato presentation accompanied a discussion on the panel about the relative merits of collective marks and geographical indications. Sandra Leis of Dannemann Siemens set out the similarities and differences between the two means of protection in several useful charts. She also noted that there is very little harmonisation around the world, but that it is evolving thanks to the recent Geneva Act of the Lisbon Agreement, numerous bilateral agreements and discussions about extending protection under Article 23 of TRIPs to other agricultural products such as cheese.

Volker Schoene of Loschelder compared the enforcement of collective marks and GIs, using the German brand Dresden Stollen as an example. He concluded that “GIs are the strongest” as public as well as private law sanctions are available, and public authorities may take action. When the chips are down, GIs can also be enforced against both local non-members of the community and non-local producers.

A lively discussion included questions from the audience on the scope of GIs and the possible mashing of different rights, as well as recent trends in various countries, demonstrating that this issue continues to be a hot potato.

Then Kole handed out some more cuddly toys to the audience members who had attended the whole session. And with that, the session finished – just in time for lunch.
Double trouble for trade mark approval

The difficulty of getting through a double examination by two agencies when trying to get a trade mark registered was discussed in the Pharma track session ‘Don’t miss the (right) mark’ yesterday. The differing experiences of Brazil, the US, Canada and the Philippines were analysed by panellists.

Jacques Labrunie of Gusmao Labrunie in Brazil moderated the session and revealed this issue is a big problem in his country. Trade marks are regulated by both the patent and trade mark office and the health surveillance agency Anvisa.

This causes many problems. “It is a lot of work for all the Brazilian pharmaceutical industry concerning the trade marks,” he said. “You have the trade mark regulated at the BPPTO and check with Anvisa that there are no confusingly similar names registered.”

“The understanding of confusion is a little bit different as well,” said Labrunie. “So having these two agencies is a challenge in Brazil.”

Anvisa issued a new rule, Number 59, in October 2014, which introduced new regulations of pharmaceutical names and marks. This eliminated the requirement for three separate letters to disassociate similar word signs, extended Anvisa’s discretionary power on regulating names and marks, and included some definition of elements of the regulation.

US, Canada and the Philippines

Matthew Asbell from Ladas & Parry in the US explained that his country also has an onerous double process. USPTO registration considers prior federal marks, distinctiveness and significance, and compliance with other statutes, but FDA approval is also required. The FDA analysis needs no priority, and uses Peca phonetic and orthographic computer analysis, scripting review of what a mark may look like when handwritten. It also reviews packaging for the relative size of the company and international non-proprietary names (INNs).

The FDA approval process can cause frustration because there are limited legal arguments available and the rationale for refusal is not always given.

“That the FDA doesn’t always give a reason makes it a bit of a challenge,” said Asbell. “Some legal steps can be taken but sometimes it is just guesswork [for why approval was not given], which makes it problematic.”

Applicants can look to assistance from the WHO if the stem is included or file a citizen’s petition asking for the reason for denial.

“There is a higher standard at the FDA,” Asbell said. He added that the double process should be done simultaneously to avoid what he called a “train wreck scenario”, where an application is accepted by the USPTO but then rejected by the FDA.

Asbell also revealed that new rules were released in September covering biosimilars. Biosimilars will be approved based on: a high similarity to an FDA-approved biologics product; no clinically meaningful differences in terms of safety, purity and potency; the same clinical result with no difference in safety or efficacy when alternating with the reference product; and avoiding inadvertent substitution without intervention of an MD.

“It remains to be seen how this will be implemented because this is a new guidance that only came out a month ago,” said Asbell.

Steven Garland from Smart & Biggar in Canada said his country has a similar double process challenge. He said the sweeping changes to its Trademark Act last year will have a big impact. “The Act has fundamentally amended and will be coming into force in 2017,” he said. “It will have an effect on pharmaceutical companies and brands.”

The requirement for use has disappeared. But to keep a mark there must be use, with challenges allowed after three years. “You could imagine if you are a pharmaceutical company, this could become problematic,” said Garland, noting the long approval process to register a drug. “It remains to be seen how that is treated,” he said.

Another change is anything filed after June 13 2015 will require inclusion of brand name assessment. One possible result is that Health Canada will refuse to issue a notice of compliance if the brand name is deemed unacceptable and the sponsor does not wish to move forward.

Health Canada brand name assessment will include initial brand name review for naming practices that could render the product misleading, all brand names and other product names unacceptable and the sponsor does not wish to move forward.

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“When an application is accepted by the FDA, but it doesn’t check with IPO registra- tions. “The FDA doesn’t care about what the IPO has in its database,” she said.

If challenges are made, the FDA merely notifies the opposer that IP matters are beyond its jurisdiction and should be addressed to the IPO or the relevant courts.

Nakan concluded with some recommendations. Since the Philippines IPO and FDA independently evaluate the validity of a proposed mark, applicants should comply with both IPO and FDA requirements. While the FDA does not yet have a specific rule in place against the use of an INN as a brand name, applicants should refrain from using the INN because they will encounter challenges in registering the brand name as a trade mark, she said.

The Myriad difficulties of patenting

Attendees heard about the continuing effects of the US Supreme Court’s verdicts on patent eligibility in yesterday’s ‘Personalised Medicine’ pharma session.

Adrian Looney of Pfizer noted the impact of the Court’s Myriad decision, which said DNA is not allowed to be patented. “That is a big issue for us in pharma and also the diagnostic world,” Looney said. “In oncology, almost 50% of the compounds are either natural products or derived from natural products. That is going to make it more difficult and what I am advising my scientists when they are looking at natural extracts is that we are going to have to have the conversation very early in the process and sometimes the molecule we want to develop we aren’t going to develop.”

He noted that one compound concerns a treatment for Alzheimer’s. “It might be the exception to the rule but we still would have preferred to patent it in the US.”

Also in the session, Hugo Caro, head of Ferrer Internacional, gave an update on the new patent law in Spain. Article 6 of the new law passed in July 2015 contains a test mirroring Article 54 of the European Patent Convention. This stipulates that novelty will reside in the disease to be treated, the dosage required, the technical effect, synergies with other compounds and the group of patients to be treated.

In the case of European patents, the Spanish courts would normally accept the validity of Swiss-type claims filed or having a priority date earlier than January 29 2011 and the validity of purpose-limited product claims granted by the EPO in accordance with decision GO2/08, he noted.

“At present there is not sufficient case law interpreting the scope of the terms ‘treatment’, ‘treating’, ‘use to treat’ and similar expressions, but one could expect a Spanish court to interpret these terms according to their new natural meaning.”
Strong feelings on compulsory licensing

There was what Assistant Secretary General Ralph Nack called an “exciting and controversial” debate on compulsory licensing yesterday, featuring representatives of the pharmaceutical industry and lawyers from India, Brazil, Thailand and the US.

The context was the recent grant of compulsory licences for medicines in countries such as India, Indonesia and Thailand. Manisha Desai of Eli Lilly in the US said that granting compulsory licences leads to uncertainty for businesses—adding “the worst thing for us is uncertainty” as it means less incentive to invest and long-term increases in costs.

But Rodolfo Martinez of Martinez & Associates in Brazil said: “It is unfair to use the expression ‘uncertainty’ when you’re playing by rules established 100 years back in the Paris Convention.”

He later added: “I don’t think the compulsory licence is a positive instrument. But you have to look at the domestic market in each country. In a country like Brazil where the government is footing the bill, price becomes a matter of interest.”

Guilherme Leser of Merck (MSD) in Brazil noted that policies on compulsory licensing are often driven by political considerations, making it difficult to predict long-term trends. Brazil, for example, has its second health minister within a year. “I don’t see any pharmaceutical company investing in R&D in a country where there is uncertainty,” he added. Merck had a compulsory licence granted on a drug in Brazil in 2007.

The panel, chaired by Hari Subramaniam of Subramaniam & Associates, discussed recent cases including the pending Lee Pharma v AstraZeneca case in India, concerning compulsory licence applications for the drugs Onglyza and Kombiglyze. They also addressed the national and international legal frameworks and whether importation can or cannot constitute working an invention, and Brazil’s so-called Productive Development Partnerships (PDPs), designed to promote technology transfer in the country.

It was a session that did not offer any easy answers, but did show the strength of feeling on all sides. As Desai, who was born in India, said: “I want to see the environment improve so Indians can have access to our latest medicines. There is no certainty that is going to happen.”
Felipe Claro, AIPPI President is keeping a close watch on a number of important IP issues. “Worldwide harmonisation has been from the very beginning the biggest issue for the association,” he says. “And enforcement has become very important in the Latin-American region, where we need to see how the Latin-American economies fit within the IP structure to better succeed. Early IP awareness initiatives are also welcome to educate young people and to reduce the improper use of IP rights.”

AIPPI’s study of topical IP issues provides a way forward, he says, not only for IP owners but also for IP users and regulators. The Rio Congress takes place between the World Cup 2014 and the Olympic Games 2016, and Brazilian IP firms hosted a reception last night at the Maracanã Stadium. “This is a powerful message at a time when IP is permeating the daily lives and the many sports activities enjoyed by Brazilians in all walks of life,” says Claro, who is from Chile.

AIPPI’s goal is to have a positive impact on the understanding of IP around the world. “If you look at it from a distance, you will see that AIPPI is always dealing with change and it is always promoting positive change globally, so that the IP world can become less complicated and better understood by everyone,” he says.

The association is also trying to have a positive impact in other ways. For example, AIPPI’s commitment to environmental protection has moved the Association to apply for observer status before the United Nations Framework Convention on Climate Change. In addition, the Rio Congress is the association’s first paperless Congress, which Claro says “is a giant step forward in the protection of the environment” for AIPPI.

Another important part of IP is prior art. “It is the reason why exclusive protection is given to IP innovators for a certain period of time. So we should also include prior art in the IP equation and the governmental bodies in charge of keeping this information available should redouble their efforts to maintain cheap, integrated and user friendly databases, which are accessible to all market players.”

Another issue on which AIPPI is keeping a close watch is plain packaging. It is taking a strategic approach to how it is trying to exert influence. A decision in the WTO dispute on Australia’s plain packaging measures is expected in the first part of 2016. AIPPI considered the possibility of filing an amicus brief submission. Its Amicus Brief Committee analysed the practice before the WTO concerning the filing of amicus briefs and publicly available material concerning the present status of the proceedings, and concluded that any amicus brief it filed would more useful be deployed at the appellate stage, rather than at what might be characterised as the ‘first instance’ panel stage.

“AIPPI believes its preferred course would be more effective because the scope of the panel decision will be known, permitting a more targeted and detailed focus in any brief filed” explains Claro. “Accordingly, AIPPI will continue to monitor developments in the WTO proceedings. AIPPI’s Resolution on Plain Packaging passed at its ExCo meeting in Helsinki, Finland in September 2013 is a public document that can be used by anyone in any submission or brief filed at the panel stage.”
Claro told AIPPI Congress News at last year’s event in Toronto that a goal was to make the association more flexible and beneficial to members. He says this remains a goal, and is being approached in three ways. One is extensive changes modernising AIPPI’s statutes and regulations, and updating its terminology, which should be confirmed at its General Assembly and Executive Committee meetings in Rio. The second is more proactive efforts to form National Groups in key regions of the world, as demonstrated by two new National Groups being admitted in Rio. The third is increased visibility with governmental organisations including IP offices, resulting in the observer status at OHIM in Alicante.

"More visible to the members may be things such as the recent recruitment of an Executive Director. John Bochnovic is here in Rio and the new website we will open after Rio by the end of October," says Claro.

Increasing AIPPI’s LatAm membership
This year’s Congress has been a great opportunity for AIPPI to increase its presence in Latin America by showing new attendees what the association does and how it does it.

"We want to attract more new Latin-American members to show them the AIPPI work and experience, so that they can actively participate in the future and have a stronger voice in the Committees, the Executive Committee and other AIPPI bodies," says Claro.

He notes the Brazilian Association of Intellectual Property (ABPI) has been generous in agreeing to change their annual meeting format this year. "The ABPI and its members are putting all their efforts into supporting the AIPPI Congress," he says. "The result is that the single largest National Group representation at the Congress will be from Brazil."

Claro identifies a number of IP challenges in the region.

"Latin America needs to diversify and improve its productive structures, train professionals, decentralise management and invest in innovation and education to reduce the underlying frustration of developing countries and to catapult their economies to be, one day, globally IP compliant," he says.

He says attention has now shifted to the recent adoption of the Trans-Pacific Partnership, which will need to be approved by the legislatures of the 12 countries involved.

"This is a tool that some Latin American countries now have at hand," he says. "The fact that the TPP covers around 40% of global trade and also that the IP standards have been raised in several respects is something that should keep AIPPI busy for quite a while."

He adds: "However, my personal concern is that I do not see initiatives to have these new IP standards replicated within the TRIPS Agreement; without that, this important WTO global treaty could lose its efficacy and risks becoming obsolete if these standards and vital matters (such as the internet) remain outside its scope. Obviously no one wants to see this happen. AIPPI is determined to offer whatever assistance it can to help in having more countries embrace these new IP standards."
What to do when your brand gets taken for a ride

Free riding of trade marks is up for discussion at this year’s Congress in Working Question 245 “Taking unfair advantage of trademarks: parasitism and free riding”. Michael Loney reports

Free riders try to take advantage of the reputation attaching to a trade mark. This can be a tough problem to tackle because a likelihood of confusion is traditionally required to succeed in an action against a free rider.

But trade mark and unfair competition laws have evolved in a number of jurisdictions to provide broader protection against free riding. This includes recent decisions not requiring a likelihood of confusion where the public has made a connection between the sign used by the free rider and the trade mark. This has been taken as proof that the free rider has taken unfair advantage of the trade mark.

Today’s working question will examine the exact status of any available protection against free riding. It is not always clear whether the protection can be evoked at all, and, even if it can, the requirements for protection and the scope of protection can be unclear. The working question will explore whether changes to the status quo are desirable.

Graciela Pérez de Inzaurraga of Argentinian law firm Hausheer Belgrano & Fernández is the chair of the Q245 working committee. She says free riding is a common problem. “But when this situation arises some trade mark laws – not in all jurisdictions, but in some jurisdictions – are not yet equipped to deal with this issue because there is not confusion,” she says.

Free riding is seen as a problem because they are taking advantage of something the trade mark owner has invested time and money in building a reputation around. De Inzaurraga notes some situations where the use may be legitimate, however, for example in comparative advertising or if there has been prior use in good faith.

Finding some consensus
The Reporter General received 47 reports for this working question. The reports reveal broad consensus on the issue. “There was consensus, apart from some jurisdictions, that there should be legislation to prevent this use and there was also consensus on what could be called enhanced protection,” de Inzaurraga says. “Let’s say it is outside the boundaries of confusion to have this enhanced protection, the mark that’s being enforced should be well known or at least known in the relevant segment of the public or should have a unique distinct character.”

Most groups responded that their jurisdictions provide for protection against the taking of unfair advantage of trade marks. However, exceptions to this were Australia, Brazil, Canada, Egypt, Russia, the United States and Venezuela. The US is strongly against a statutory provision on free riding because it would create conflicts with existing statutes, precedents and policies, lead to litigation and possibly be unconstitutional and vague and indefinite.

A majority of the groups also agreed that there should be protection against similar use. But the summary report notes that a significant minority disagrees, meaning there is probably not sufficient basis for a resolution on this aspect.

The reports reveal most countries have multiple causes of action available that can be invoked cumulatively, in many cases at least under trade mark law and unfair competition law.

The plaintiff generally bears the burden of proof but the defendant bears the burden of proving any defences it invokes. However, in Brazil this burden can be shifted if the consumer is deemed by the court to be in a less favourable position to produce evidence. In Uruguay, the burden of proof can be shifted if it is clear that one party has evidence in its possession that it does not reveal.

VOXPOP
WHAT HAS BEEN YOUR HIGHLIGHT OF THIS YEAR’S CONGRESS?

Daniel Sánchez
Olivares,
Mexico City, Mexico

There were interesting topics. I was always interested in hearing about copyrights. I always learn when I come to AIPPI.

RP Bhattacharya
De Penning & De Penning
Kolkata, India

We enjoyed the discussion on FRAND. It said how standard essential patents are being looked at and how it is impinging upon competition law. It was very interesting because it has got a lot of impact for India also. We are having a lot of litigations on the same thing.

Ana Amelia Montenegro
Licks Advogados
Rio de Janeiro, Brazil

The FRAND panel was amazing. That was the highlight. They gave us a great overview of United States precedents. I thought it was very interesting as a Brazilian attorney. Our firm handles a lot of cases in this area.

Carolina Celis Espinosa
Olarle Moure & Asociados
Bogota, Colombia

The best part of it was the “Double jeopardy” panel. Here in Brazil there is Anvisa that checks the regulatory issues of the patents. They have been denying some patents based on what they say are technical concepts but in truth it is not that. So it has been really complicated for solicitors. It is interesting.

Natalie Raffoul,
Clancy + Raffoul
Ottawa, Canada

The green technology session yesterday I thought was very good. That’s the politically correct answer. But the dancers are the ones everyone wants to hear about!

Dean Pelletier
Pelletier Law
Chicago, USA

I would say the opportunity to network. This is the first time I have been to the Congress, and it was as good as I expected.

Tammy Terry
Osha Liang
Houston, USA

The highlight was to reconnect with all the AIPPI friends. This is my second time. The working committees have worked very efficiently so that’s been great and it has been good to see that a lot of the people that we saw last year really did return this year.

Paula Clancy
Clancy + Raffoul
Ottawa, Canada

The dancers at the cultural event, for sure. It was eye popping. It put Toronto to shame, and we’re Canadian. We had the Cirque du Soleil but that was tame in comparison to this.

Luis Schmidt
Olivares
Mexico City, Mexico

It was a wonderful venue and great Congress!
Forty-one of the groups submitting reports believe there should be protection against the taking of unfair advantage of trade marks as defined in the working guidelines. Only Australia, the Republic of Korea, the US and Venezuela did not agree. Australia said that it has enough checks and balances in place, making further cause of action unnecessary.

A large number of groups deem harmonisation in the area of free riding desirable, although disagreeing with this notion were the Czech Republic, Egypt, Hungary, New Zealand, the Republic of Korea, the US and Venezuela.

No consensus
No clear consensus for protection emerged from the reports. Some suggestions for the requirements for protection included a certain level of reputation, a connection between the invoked trade mark and the sign used by the third party, some kind of unfair advantage, and with the trade mark owner generally bearing the burden of proof.

Some suggestions against and/or limitations to the protection included parody, freedom of expression, comparative advertising, prior use in good faith, “due cause” and “fair use”.

The groups generally agree that it should at least be possible to invoke the protection in civil proceedings. Many also find that it should be an option in criminal and administrative proceedings.

De Inzaurraga notes, however: “There was no consensus in achieving a definition for what is taking unfair advantage of another party’s trade mark. Consensus with regard to definitions is difficult to arrive at.”

She concludes the preliminary draft resolution that the working committee has been working on looks good. “It is meaningful and makes a stand in connection with the topic,” she says. “Based on the reaction of delegates to the preliminary draft I think the debate will be centred on what requirements need to be met to trigger this special protection. That will be one of the key topics to be debated. A second topic will be concerning defences to be [raised in enforcement actions].”

Working Question Q245, Taking unfair advantage of trademarks: parasitism and free riding, will be discussed today from 8.30am to 12.00pm.
TWEETS

Fernandez Secco  Ayer por la noche en The Cultural Evening en el Copacabana Palace. @AIPPI_ORG @abpi_brasil #AIPPI #ABPI @isaferuy

Graeme Boocock PhD I can think of worse ways to kill an hour between meetings! #AIPPI2015 @AIPPI_ORG

Vanrellip Non traditional Marks sounds like a Mark,smell like a Mark #AIPPI #AIPPI2015

ASIPI Hoy Presidente de ASIPI moderador del panel sobre Marcas No Tradicionales durante Congreso de AIPPI en Rio de Janeiro

Juan Pittaluga Siempre es un gusto compartir con mis colegas y amigos de @LlipCia @AIPPI_ORG #riodejaneiro

Citemark IP Interesting session about bad faith trademark registration. #Aippi #AIPPI2015

Richard P. Beem The next #Embraer will be a small entrepreneurial company. Wander Stange, #IP Head, Embraer #patent @AIPPI

WIPO WIPO is at the #AIPPI2015 World Congress in Rio de Janeiro. Come visit us at booth 32-33! http://ow.ly/Tl6l2

Ray Farrell Time to vote on resolution re: Inventorship of Multinational Inventions at @AIPPI_ORG 2015 World Congress in Rio

IP Federation Alan Johnson of Bristows discusses the Unified Patent Court (UPC) at AIPPI in Rio de Janeiro

Curtis Behmann Evening fun at Copacabana Palace. Finally found out why our photos are on our name badges! #AIPPI2015 @AIPPI_ORG

Noel Courage For one evening, everyone at #aippi2015 is from #Brazil @aippi_org #samba

Monday night’s Cultural Evening at the Copacabana Palace Hotel

The Women in AIPPI reception on Monday evening

Leiz Leonardos & Advogados hospitality suite

Bristows brunch at Duo on Sunday

Ci vediamo a Milano!

AIPPI World Congress
Milan, Italy, September 16-20 2016
News in brief

INDIA
Merck (MSD) last week won a favourable decision in its battle with Glenmark over generic versions of its diabetes drugs Januvia and Janumet. Justice AK Pathak of the Delhi High Court said the generic versions violated Merck’s patent for sitagliptin, and ordered it to stop selling its rival products and to pay Merck’s costs. Glenmark can seek to appeal the decision. The litigation dates back to 2013.

NEW ZEALAND
A New Zealand High Court judge has ruled that the country’s trade minister Tim Groser should “reconsider his decision” to not release information about the Trans-Pacific Partnership trade negotiations. The judge said there was “no lawful basis” for the information to be withheld. Law professor Jane Kelsey, Consumer NZ and Greenpeace had asked for a judicial review of Groser’s refusal of their request for information under the Official Information Act.

An agreement on the TPP was reached between 12 nations last week. The news of the agreement was met with much criticism because the actual text was not released. Wikileaks leaked what it said was the full IP chapter late last week.

UNITED STATES
Fashion designer Stella McCartney is suing Steve Madden for selling a “knock-off” version of her Falabella bag. In a suit filed in the Southern District of New York last week, McCartney’s lawyers sued for trade dress infringement, unfair competition, deceptive trade practices, trade dress dilution and design patent infringement “Plaintiff’s FALABELLA Collection of bags, with their distinctive trade dress, achieved prominence in the fashion industry, and after Plaintiff obtained design patent protection for its design, Defendant began importing and selling a tote bag, that, although virtually identical in appearance to Plaintiff’s design, is a poorly-made copy,” says the complaint.

McCartney is seeking an injunction against Steve Madden.

IRELAND
The Irish Times and The Times of London have resolved a dispute over the latter’s use of “The Times Irish edition” for its digital version in Ireland. The Irish Times had alleged trade mark infringement but the Dublin High Court declined to grant an injunction in July. The Court was informed on Monday that the case had now settled, according to the Guardian newspaper.

The government has declined to strengthen measures against “copycat packaging” following a consultation. Trade mark owners in the UK have long campaigned for a civil injunctive power to tackle unfair commercial practices, arguing that Trading Standards is overstretched and has only brought one case in the past seven years. But the Department for Business, Innovation and Skills (BIS) said it was not yet persuaded that a change was necessary. The British Brands Group described the announcement as “deeply disappointing”.

UNITED STATES
Apple could have pay more than $862 million in damages to Wisconsin Alumni Research Foundation – the University of Wisconsin-Madison’s licensing arm – after a jury in Wisconsin said the technology giant infringed a patent for improving processor efficiency. The jury said the patent was valid and the technology was used in Apple’s A7, A8 and A8X processors in the iPhone 5S, 6 and 6 Plus and versions of the iPad.

A trial has been scheduled to determine damages. Judge William Conley ruled that Apple could be liable for up to $862.4 million in damages. The case involves US patent no 5,781,752 entitled “Table Based Data Speculation Circuit for Parallel Processing Computer”.

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WARF sued Apple in January 2014. WARF also sued Apple again last month, alleging infringement by the company’s latest chips, the A9 and A9X, which are used in the iPhone 6S and 6S Plus, and the iPad Pro.

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Please look out for our article in the International Briefings section of Managing IP magazine distributed at AIPPI!
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<thead>
<tr>
<th>Time</th>
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<tr>
<td>08.30 - 12.00</td>
<td>Plenary Session IV Q245</td>
<td>Segovia I-IV (2nd Floor)</td>
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<td>08.30 - 10.00</td>
<td>Panel Session VIII Inventor remuneration: the global puzzle</td>
<td>Louvre I-II (Ground Floor)</td>
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<td>08.30 - 10.00</td>
<td>Panel Session IX ISP liability: a rundown on takedowns (and more)</td>
<td>Louvre III-IV (Ground Floor)</td>
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<td>Coffee break</td>
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<td>10.30 - 12.00</td>
<td>Panel Session X Post grant oppositions: a game changer?</td>
<td>Louvre I-II (Ground Floor)</td>
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<td>10.30 - 12.00</td>
<td>Panel Session XI Mediation in IP cases: expedient or coercive?</td>
<td>Louvre III-IV (Ground Floor)</td>
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<td>General Assembly</td>
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<td>Networking Lunch</td>
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