

## RECENT IP UPDATES

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### ARGENTINA:

#### **Actual damages derived from trademark infringement must be proved before the courts / Trademarks are meant to be used and not merely sold.**

There is a widespread consensus among the different Divisions of the Federal Court of Appeals, sharing that trademark infringement causing an unjustified damage should be compensated.

However, the trademark holder must submit sufficient evidence of any alleged damage. Also, trademarks are meant to be used and not merely sold. Federal Court of Appeals in Civil and Commercial Matters ruled that the registration of trademarks with the sole purpose of their subsequent sale is forbidden

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### ARGENTINA:

#### **New accelerated examination for patent applications.**

On September 19th, 2016 the Argentine Patent and Trademark Office (ARPTO) issued a Resolution that will come into force on October 15th, 2016 pursuant to which patent applicants will be able to request accelerated examination of patent applications.

According to this Regulation, the ARPTO is authorized to consider that the essential requirements of patentability have been satisfied as long as the patent application examination has not started by October 15th, 2016 and the patent has been granted abroad for the same invention (independently of whether priority has been claimed or not).

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### AUSTRALIA – EPO:

#### **Patent Prosecution Highway (PPH).**

Pilot program between the Australian Patent Office and the European Patent Office (EPO) started on July 1st, 2016.

A favorable examination report of one application can be used to speed up the examination of the counterpart application if a person has related patent applications in Australia (inc. a PCT application) and the EPO.

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### BAHREIN:

#### **Bahrain increases official fees - Online publication of accepted trademark applications.**

Bahrain increases official fees (1,392USD) to conform to the Law 6/2016 of the GCC Trademark Law.

The new official fees cover all trademarks matters filed from May 29th, 2016 as well as retroactively for pending trademarks applications as regards their publication and registration fees. In addition to that, Trademark applications will be published every Thursday on the official website of the Ministry of Industry, Commerce and Tourism. Such publications will contain the details of each accepted trademark application, transfers of ownership, records of name and address changes, changes of representative agent, and approved recordal of mergers.

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### BRAZIL:

#### **New possibilities for applying for priority examination at the BRPTO.**

Any interested party can now request priority examination status for a patent application by another applicant.

It would have to prove that: (i) it has been accused by the applicant of reproducing the object of the patent application, or (ii) it holds a patent application or a granted patent for a technology which is equivalent to that of the application or the holder of technology which is equivalent to that of the other patent application. Furthermore, in order to be eligible for priority examination status a national patent application (either filed with the BRPTO or under PCT) must also later be filed abroad. This initiative has duration of only one (1) year and it is limited to a maximum of one hundred (100) patent applications.

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### CAYMAN ISLANDS:

#### **Registry changes.**

Started in August 1st, 2016 patent and trademark annual fee payments will no longer be accepted in advance of January 1st in the year in which they fall due. [read more](#)

Therefore, annual fees due in 2017 must be paid on or after January 1st, 2017.

**RECENT IP  
UPDATES**

**CHINA:**

**PATENTS: SIPO issued three regulations to promote China's patent law enforcement. TRADEMARKS- More goods and services are acceptable for trademark registration. LITIGATION- New Judicial Interpretation on Patent Infringement.**

SIPO issued three regulations to promote China's patent law enforcement: (i) guide of determining patent tort; (ii) evident rule on patent administrative enforcement; and (iii) guide on patent disputes administration mediation.

Moreover, two thousand (2,000) more goods and services are acceptable to facilitate trademark registration procedure, on-line filing and searching. On the other hand, on August 1st, 2016 the Supreme Court of China (SPC) has published a new judicial interpretation regarding the applicability of relevant laws when dealing with patent infringement cases. The SPC provides guidance on issues related to (i) claim construction, (ii) determination of infringement and tests for defense, (iii) contributory liability and (iv) standard essential patents that shall be applicable to all inventions, utility models and design patents. This interpretation took effect from April 1st, 2016.

**DIJIBOUTI:**

**Accession to PCT.**

Patent Cooperation Treaty (PCT).

Djibouti became a member of the PCT Agreement on September 23rd, 2016.

**EUROPEAN PATENT  
OFFICE:**

**Changes to the EPO opposition procedure.**

Changes to the EPO opposition procedure came into force on July 1st, 2016.

The key changes include: (i) time limits will be extended only in exceptional cases upon a substantiated request; (ii) the opposition division may exceptionally consider other grounds for opposition beyond those raised in the notice of opposition; (iii) clarity objections may only be raised during opposition proceedings to the extent that a fault has been introduced by an amendment made after the grant of the patent; (iv) the final deadline for written submissions will now normally be set at two (2) months prior to the hearing; and (v) amendments filed during oral proceedings should be in the form of typed documents.

**HONG KONG:**

**Patents (Amendment) Ordinance 2016.**

Key changes that will hopefully be implemented by early 2018.

These changes are: (i) introduction of an "original grant" patent (OGP) system for direct filing of standard patent applications in the country; (ii) a substantive examination procedure for Hong Kong short-term patents; (iii) confirmation that up to two independent claims may be included in a short term patent; (iv) express provisions for second medical use; (v) introduction of provisions dealing with entitlement disputes, restoration of priority rights for applications of "original grant" standard patent and the ability to submit third party observations before the IPD; and (vi) restriction of the use by individuals of certain titles for supplying patent agency services in Hong Kong which may imply endorsement by the Government, or recognition by law.

**INDIA:**

**The Indian Government's Patent (Amendments) Rules 2016.**

The Indian Government's Patent (Amendments) Rules 2016 came into effect on May 16th, 2016. The purpose of these amendments is to speed up the patent prosecution before the Indian Patent Office.

The most significant rules for patent prosecution are the following: (i) shortened timelines for putting an application in order for grant, (ii) allowance of claim deletion at national phase entry, (iii) accelerated examination, refund of examination fees and ceasing of costs for sequence listings, (iv) reference to deposition of biological material, (v) deadline for filing the power of attorney document, (vi) speeded issuance of foreign filing licenses and (vii) stimulation of start-ups.

**INDONESIA:**

**Recordal of intellectual property licensing agreements.**

The Indonesian Government recently issued the Ministry of Law and Human Rights Regulation No. 8 Year 2016 on the recordal of Intellectual Property (IP) Licensing Agreements. The Regulation addresses a previous deficiency in Indonesia in that, without recordation, parties didn't have the ability to enforce their licensed IP against third parties

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### IRAQ:

#### **New requirements for trademark registration in class 5.**

All trademark application shall contain the following information in order to proceed with the registration procedure:

(i) Scientific name of the product, (ii) trade name of the producer, (iii) pharmaceutical formula of the product, (iv) name of manufacturing company if not the applicant, and (v) name of local distributor, if any.

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### JAPAN - VIETNAM:

#### **PPH program.**

A bilateral agreement has been signed between National Office of Intellectual Property of Vietnam (NOIP) and Japan (PPH - Patent Prosecution Highway).

The trial period of this agreement started from April 1st, 2016 and the pilot program will be implemented at the end of March 31st, 2019. Under this agreement, both national offices are encouraged to work together and enable patent applicants to request accelerated processing of patent applications in the national phase.

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### KUWAIT:

#### **Stops accepting patent application and remits to GCC patent office.**

The Kuwaiti Ministry of Trade and Industry approved Law no.115 of 2016 on the regulations implementing patent Law no. 71 of 2013.

This new Law came into force on April 4th, 2016. However, it is important to mention that the Kuwaiti Office stopped accepting new patent application as of April 4th, 2016 and it is advising potential applicants seeking for protection in Kuwait to use the Gulf Cooperation Council (GCC) regional patent office. Moreover, since Kuwait became a member of the PCT agreement on September 9th, 2016 any international patent application filed on or after this date, will automatically include the designation of Kuwait. Therefore, from now on, nationals and residents of Kuwait will have the right as from September 9th, 2016 to file international applications under PCT.

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### CAMBODIA:

#### **New procedures to record exclusive distributorships.**

The Ministry of Commerce introduced a new regulation on the procedures to record and file permission letters for imported goods bearing exclusive trademarks.

An exclusive distributorship must be registered at the Department of Intellectual Property Rights for the trademark owner or distributor to enforce their rights against third parties.

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### NEW ZEALAND:

#### **New Zealand divisional filing practice warning.**

The three main new Act divisional issues are: [read more](#)

(i) An absolute bar exists for filing a divisional application later than five (5) years from the complete filing date of the originating parent by preventing availability to request any examination of the divisional application, (ii) need to be filed within the initial response period set after issuance of an examination report, and without reliance on any extension of time, otherwise a "substantive response" must be filed on the parent in order to validly file the divisional, and (iii) may result in self-collision with its parent application where claims of the parent and/or divisional contain added subject matter not present in the original priority/provisional filing, and therefore any added subject matter should be kept in separate claims for both parent and divisional applications.

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### RUSSIA:

#### **A National Intellectual Property Registry started operating online in Russia on April, 2016.**

The Registry is designed to become an efficient means of dealing with infringements of exclusive rights on the Internet, as well as proving the ownership of intellectual property rights.

The Registry is owned and administrated by a commercial organization and public authorities.

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### SAUDI ARABIA:

#### **Final step towards regional trademark law.**

The new GCC Trademark Law and Implementing Regulations will come into force on

## RECENT IP UPDATES

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SINGAPORE:

September 28th, 2016.

It stipulates a set of provisions that will be applied uniformly across all the GCC countries in regards to the prosecution and enforcement of trademark rights. It is a unifying law; consequently, it does not offer a unitary registration system.

### **Guidelines for examining Computer Implemented Inventions (CIIS) issued by IPOS.**

Important updates that will apply to new patent applications on or after May 16th, 2016.

These updates refer to: (i) national applications for a patent (and any divisional applications arising from them) with a filing date on or after May 16th, 2016; and (ii) international applications entering national phase (and any divisional applications arising from them) on or after May 16th, 2016.

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SINGAPORE:

### **The Intellectual Property Office raises the bar on post-grant amendments.**

On July 19th, 2016 the IPO announced that post-grant amendments may not be possible if:

(i) A full disclosure of all relevant matters in relation to the proposed amendments was not provided by the patentee, (ii) there was an unreasonable delay in seeking the amendments, or (iii) an unfair advantage was obtained by delaying the amendments which the patentee knew to be needed. This criterion will apply to all pending and new request for post-grant amendments.

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TAIWAN:

### **New practice for submitting documents.**

New practice for submitting priority documents for new patent applications filed in Taiwan became effective on July 1st, 2016.

The new practice applies to (i) patent applications filed on or after July 1st, 2016 and (ii) patent applications filed prior to July 1st, 2016 for which the priority document(s) has (have) not been filed up to July 1st, 2016.

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THAILAND:

### **Trademark Act Amendments usher in Thailand's accession to the Madrid Protocol.**

Among the amendments that became effective on July 28th, 2016 it is important to point out the new chapter on trademark registration.

It introduces a set of changes for Thailand to accede to the Madrid Protocol: (i) multi-class applications are available, (ii) sound marks are registrable (iii) association of marks is no longer required and (iv) suspension of later applications for marks deemed identical or similar to previous applications /registrations.

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WIPO:

### **New Special Service: Expedited establishment of an attestation or of a certified copy from the International Register.**

As from June 6th, 2016, users of the Madrid System will be able to request the expedited establishment of an attestation or of a certified copy from the International Register.

WIPO will emit the document within five (5) working days upon the receipt of such a request and the payment of one hundred (100) Swiss francs per document in addition to the corresponding fees.