

APAA BULLETIN

ASIAN PATENT ATTORNEYS ASSOCIATION



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FOREWORD

The Asian Patent Attorneys Association ("APAA") is a non-governmental organization established in December 1969 dedicated to promoting and enhancing intellectual property protection in the Asian region.

The Association now has over 2,400 members which include some of Asia's leading practitioners of intellectual property law. We meet annually at a Council meeting and triennially at a General Assembly at a location within the Asian Region to, amongst others, network and exchange views and information concerning intellectual property protection in the Region. With its large pool of members and expertise, APAA is well placed in enhancing intellectual property awareness and promoting knowledge dissemination.

With one of its objects to promote awareness and knowledge of intellectual property law and practice in the Asian Region, APAA has been periodically publishing "APAA News" which contains useful information concerning the latest intellectual property developments in the Asian Region accessible to APAA members. Additionally, the Association has also published commemorative books entitled "30 Years of APAA" and "APAA at 40".

One of the initiatives announced at the commencement of my term in bringing positive changes to the Association is the progression of our Workshop Group to the full-fletched APAA Academy. I believe that internally APAA members will benefit and externally, the profile of the Association at the international level will be further acknowledged through the work of the APAA Academy under its three branches, namely Conference Programme, Professional Training and Publication.

The APAA Bulletin is the first of the series of annual publication that the Association intends to publish. It differs from the previous APAA News in that the original contents rich high quality reports from our Recognized Groups have been edited and formatted for enhanced presentation. Other than having a different look and feel, the materials are now customized in an electronic format which can readily be uploaded onto our newly revamped APAA website. Guidelines for preparing reports in Bulletin publication compliant format are introduced.

I congratulate Mr. Pravin Anand and his team in the APAA Academy for their industry and dedication which make publication of the Bulletin possible.

C. K. Kwong JP (Justice of the Peace)
President - APAA
2015

PREFACE

The objective of the Publication committee of the APAA Academy is dissemination of knowledge amongst the members and observers with an Asian interest. A secondary objective of the publication committee is promotion of the association by way of increasing its visibility and profile by way of high quality publications. The publications are to reflect the law and practice in various intellectual property topics of interest in the Asian region.

The APAA council at the Hong Kong 2009 meeting and the Excom Adcom Committees in the meeting held at Jeju in March 2010 authorized me to initiate the publication project of APAA which was initially termed as the book project. The Excecutive Committee finally formalized the project under the APAA Academy in the Hanoi meeting in 2013. Under this project APAA is to bring out a series of books on various topics and subjects in the field of intellectual property. A formal ad-hoc committee for the Project comprising of a dedicated group for the project was also established.

The main objective of the publication project was to provide important information in Asian intellectual property issues to readers all over the world.

As the APAA members already brought a wealth of information during the council meetings, initial steps were taken to collate said information and present it in a concise and uniform manner. The APAA Bulletin is the first publication in this direction.

I am grateful to all the Group Report and Committee Report Contributors. The continuous and excellent recommendations from APAA president, Mr. C. K. Kwong JP (Justice of the Peace), on the project are duly acknowledged. I acknowledge the support of my Co-Chairs of the APAA Academy Group Mr. Alex Ferdinand S. Fider (Co-Chair - Conference Programs) and Mr. Anton Blijlevens (Co-Chair- Professional Training) and the members of the Publication Subcommittee Mr. Alonzo Q. Ancheta; Mr. Satyapon Sachdecha; Mr. Keisuke Soeda; Ms. Marion Heathcote; Mr. Cyril Chua and Mr. Kenny Wong. The role of the publisher, Lexis-Nexis, is greatly appreciated.

Any suggestions for improvement or mistakes in the Bulletin may kindly be intimated at pravin@anandandanand.com

Pravin Anand
Co-Chair - APAA Academy
2015

APAA 2014 GROUP REPORT OF AUSTRALIA

A. IP Statistics Year 2013

1. Number of applications filed with the Patent Office 2013

NA.

2. Domestic–Foreign Breakdown 2013

NA.

3. Examination requests made, reports issued and waiting period 2013

NA.

B. Legislative Changes and Policy Update

1. Patent

1.1. Major Changes and Implications

On 19 March the Australian Government introduced into Parliament the **Intellectual Property Laws Amendment Bill 2014**, which proposes to amend the *Patents Act 1990* (CTH) to:

– implement broad trade organisation agreement on trade-related aspects of intellectual property (TRIPS protocol) enabling Australian medicine producers to manufacture and export patented pharmaceuticals to countries experiencing health crises, under a compulsory license from the Federal Court; and

– allow for a single trans-Tasman patent attorney regime and single-patent application and examination processes for Australia and New Zealand as part of the broader, single economic market (SEM) agenda for the two countries.

From practice perspective, there had been significant changes in IP Australia's practice regarding extensions of time for opposition proceedings which is causing some significant difficulties for the profession at this time.

1.2. Important Case Law

D'Arcy v. Myriad Genetics Inc. **[(2014) FCAFC 115]** (Isolation Gene Sequences patentable)

Five Justices of the Full Federal Circuit affirmed the decision of Nicholas J at first instance that isolated DNA and RNA are patentable subject matter.

The patent in question covered the isolated BRCA1 gene and its breast and ovarian cancer promoting mutations. Section 18(1)(a) of the Patents Act 1990 requires that the claimed invention must be a "manner of manufacture" within the meaning of section 6 of the Statute of Monopolies in order to constitute patentable subject matter. Nicholas J found, at first instance, applying the broad construction given to the term "manner of manufacture"

by the High Court in *National Research and Development Corporation v. Commissioner of Patents (NRDC Case)* [(1959) HCA 67 : (1959) 102 CLR 252] that each of the challenged claims were to an artificially created state of affairs with economic utility. Both Nicholas J and the Full Court made it clear that DNA and RNA that occur naturally inside the cells of the human body cannot be the subject of a valid patent.

1.3. Practice Note/Update

NA.

2. Design

2.1. Major Changes and Implications

NA.

2.2. Important Case Law

2.2.1. *Seafolly Pty Ltd. v. Fewstone Pty Ltd.* [(2014) FCA 321]

Dodds-Streeton J found that Fewstone Pty Ltd (trading as City Beach Australia) (City Beach) had infringed the copyright owned by Seafolly Pty Limited (Seafolly) in three artistic works. City Beach had instructed its designers and manufacturers to make swimwear based on pictures and samples of Seafollly's swimwear. City Beach sought to rely on the defence in respect of one of Seafolly's artworks which consisted of a smocking and shirring design (known as the Senorita artwork) arguing that the design used in the Senorita garments was a three-dimensional embodiment of the Senorita artwork which was woven into, and had become part of, the structure of the Senorita garment; accordingly the Senorita artwork was a "corresponding design" for the purposes of section 74(1) of the Act.

Dodds-Streeton J concluded that the Senorita embroidery design was not embodied in the Senorita garments in the requisite sense. Accordingly, the Senorita artwork was not a corresponding design within the meaning of section 74(1) of the Act. In light of this conclusion, Dodds-Streeton J was not required to consider the requirement of three dimensionality. In her opinion, however, the requirement of three-dimensionality was not satisfied either. While the smocking did protrude slightly from the surface of the garment, the protrusion was minimal and not three dimensional.

2.2.2. *Removerite Incorporated* [(2013) ADO 7]

Removerite Incorporated's (Removerite) two designs application for screws (the Designs) were objected to at time of examination. The Examiner alleged that the Designs were not new and distinctive because they were substantially similar in overall impression to prior article whose patent also belonged to Removerite. Removerite requested to be heard, and argued that the distinctive features of the Designs related to the enlarged flanges and the taper of the shanks. The Delegate of Designs accepted that the Designs were new, and noted that the only issue to be determined was whether the designs were distinctive. The Delegate held that the Designs were not substantially similar in overall impression to the prior article on various grounds.

2.3. Practice Note/Update

NA.

3. Trade Mark

3.1. Major Changes and Implications

NIL.

3.2. Important Case Law

3.2.1. *Cantarella Bros Pty Ltd. v. Modena Trading Pty Ltd.* [(2014) HCA 48] (trade-mark infringement, validity)

This concerns to the use of the registered trademarks ORO and CINQUE STELLE in relation to coffee products. The High Court has been asked to consider and clarify the criteria for assessing the registrability of foreign words as trademarks, including those whose translation into English has a laudatory or descriptive connotation. The relevant test (for the time being) is whether other traders, motivated only by proper motive, would desire to use a word in a manner which would otherwise infringe the mark if registered.

3.2.2. *Phone Directories Company Australia Pty Ltd. v. Telstra Corporation Ltd.* [(2014) FCA 373] (registrability, misleading and deceptive conduct/ unfair competition)

These cases concern disputes between the parties (and the Registrar) about the registrability of the word 'Yellow' and 'yellowbook.com.au' as trademarks, and the use by Phone Directories Company Australia of yellow-coloured covers for their print and electronic directories in a manner alleged to be likely to cause consumer confusion with Telstra's products and reputation. The cases are noteworthy because they highlight the difficulties in both obtaining registration of a colour mark, or of a word which denotes a colour, and of being able to restrain the use of colours or of words denoting the colour despite extensive (but not exclusive) reputation.

3.2.3. *Kosciuszko Thredbo Pty Ltd. v. ThredboNet Marketing Pty Ltd.* [(2013) FCA 563] (misleading and deceptive conduct/unfair competition)

This case concerns a dispute about the alleged unauthorised use of the term 'Thredbo' as part of a domain name. 'Thredbo' is a well-known ski area in Australia, and for that reason also has natural geographic significance. The case is noteworthy because it highlights the difficulties in being able to establish that a word having a geographical connotation has taken on a secondary meaning to such an extent that its use has the capacity to be controlled.

3.2.4. *Mastronardi Produce Ltd. v. Registrar of Trade Marks* [(2014) FCA 1021] (registrability)

This case concerns an appeal to the Federal Court from a decision of the Registrar to refuse registration of the invented word 'Zima' in relation to tomatoes. On appeal, the Federal Court affirmed that the two questions that needed to be addressed when considering the inherent capacity of a trade mark to distinguish were: (i) whether the term 'Zima' would be understood as an invented word for public and (ii) how likely it is for other traders to think of the word 'Zima' to use it on golden-grape tomatoes. Expert evidence led by the Applicant established that it had been careful to use 'Zima' in Australia in a trade mark sense, that it itself did not source its tomatoes only from a single variety, and further that other traders had a range of other terms available to them to describe their orange-grape tomatoes.

3.2.5. *Bugatti GmbH v. Shine Forever Men Pty Ltd.* [(2013) FCA 1116] (trade mark infringement and opposition to registration)

This concerns the infringement of a registration for 'BUGATTI' covering clothing as a consequence of the use of 'BUGATCHI UOMO', and a related opposition by Bugatti to the registration of those words. The marks were found to be deceptively similar and hence infringed. The case is noteworthy because Shine was found to be a user of the trade mark in Australia even though it was an importer and distributor of clothing manufactured and marked offshore, and that Bugatti was awarded in full the damages it had sought (approximately AUD550,000).

3.2.6. *Lift Shop Pty Ltd. v. Easy Living Home Elevators Pty Ltd.* [(2014) FCAFC 75] (trade mark infringement, use of a trade mark)

This case was concerned with whether use of a competitor's trade mark as a keyword in search engine optimisation methods (SEO) would constitute infringement of that trade mark. In Australia, the answer is largely dependent on whether use of the trade mark amounts to use "as a trade mark" within the meaning of the Trade Marks Act 1995. The case is noteworthy because the Full Court considered whether a composite device trade mark containing the words "LIFT SHOP" had been infringed by use by a competitor of the key words "lift shop" in SEO. The Full Court found that this was not use "as a trade mark" and therefore did not constitute infringement.

3.3. Practice Note/Update

NA.

4. Copyright

4.1. Major Changes and Implications

NIL – Some minor amendments.

4.2. Important Case Law

4.2.1. *Vaysman v. Deckers Outdoor Corporation Inc.* [(2014) FCAFC 60]

Vaysman was a repeat copyright and trade mark infringer in respect to the use of various UGG marks; and the manufacture and sale of counterfeit UGG boots. Vaysman appealed against a sentence of three years, and varying sentences of between seven days and six months, to all be served concurrently, issued in April 2010, for contempt of Court. He had moved overseas and declared bankruptcy before the sentences were handed down and was imprisoned on his return to Australia in mid-2013. The Full Court allowed the leave to appeal, although filed out of time; and reduced the three-year sentence to two years. The Court decided that, while comparable sentences of not more than 12 months had been imposed, the various serious nature of Vayman's conduct, the three-year sentence should only be reduced to two years.

4.3. Practice Note/Update

NA.

C. Proposed Legislative Changes

The final report by the Australian Law Review Committee on "copyright and the digital economy" was issued on November 2013. The main recommendation is the introduction of a US-style "fair use" provision in the Australian Copyright Act. The Government response is not expected until early to mid-2015.

The anti-counterfeiting trade agreement was signed by Australia in 2011 but has not yet been ratified.

D. Others (Geographical Indications/ Plant Variety/etc.)

Anti-Counterfeiting

4.3.1. *Facton Ltd. and Ors. v. Remmy Cardin Pty Ltd.* [(2014) FCCA 627]

The applicants alleged copyright and trade mark infringement, breaches of the Australian Consumer Law and "passing off" by the sale of counterfeit clothing bearing the applicants' G-STAR branding. The respondent did not file an address for service or appear before the court. The applicants filed an interlocutory application seeking default judgment and damages.

The Federal Circuit Court of Australia entered default judgement in favour of the applicant, declaring that the respondent had infringed the applicants' trademarks, copyright works, contravened sections 18 and 29 of the Australian Consumer Law and engaged in the tort of passing off. The court made orders for injunctions and delivery up and ordered the respondent to pay damages and the applicants' costs.

4.3.2. *Malletier v. Sonya Valentine Pty Ltd.* [(2013) FCA 933]

The applicant, Louis Vuitton Malletier, sold luxury goods internationally, including in Australia. The applicant alleged trade mark infringement, misleading or deceptive conduct and passing off. Its range of goods included sunglasses. It was the owner of two relevant Australian trade mark registrations for the mark "LOUIS VUITTON" and the device mark: The respondent appeared to be an importer and distributor in Australia of goods including sunglasses sourced in China, which bore the mark "LOUIS V". The applicant alleged that the expression "LOUIS V" was deceptively similar to its registered mark "LOUIS VUITTON", and that the flower symbol referred to was deceptively similar to its flower device mark. The Australian Federal Court found TM infringement and contravention of the Competition and Consumer Act. Declarations and a permanent injunction were issued. An order for delivery up and destruction of a wide range of artefacts including the sunglasses was also issued as well as procedural orders to assist in the election between damages and an account of profits as well as to establish the circumstances, including sales and conduct of the applicant to assess damages pursuant to the Competition and Consumer Act.

4.3.3. *Halal Certification Authority Pty Ltd. v. Scadilone Pty Ltd. & Ors.; Halal Certification Authority Pty Ltd. v. Quality Kebabs Wholesalers Pty Ltd. & Ors.* [(2014) FCA 614]

The applicant, Halal Certification Authority Pty Ltd, certified that food was halal and prepared in accordance with Islamic rites. It issued certificates bearing a seal, which was registered as a trade mark. Halal Certification Authority commenced proceedings against two restaurant operators Scadilone Pty Ltd and White Heaven Pty Ltd. It also commenced proceedings against the wholesale manufacturer of kebabs, Quality Kebab Wholesalers Pty Ltd. Halal Certification Authority alleged that Scadilone and White Heaven had infringed its trade marks by displaying a certificate, entitled "Certificate of Halal Products", on their respective premises, which included its seal. These businesses obtained the certificates from Quality Kebab Wholesalers. Quality Kebab Wholesalers claimed that the certificates were

manufactured by a rogue former employee. In addition to relief for trade mark infringement, Halal Certification Authority claimed relief for misleading or deceptive conduct in contravention of the Australian Consumer Law. The Australian Federal Court granted partial relief. While this case deals with purely local infringement it provides an example of a possible means for control of imported goods, by use of Certification Trademarks, if the marks or deceptively similar marks are applied by the copier without the authority of the Australian certifying authority.

4.3.4. *Seafolly Pty Ltd. v. Fewstone Pty Ltd.* [(2014) FCA 321]

The applicant, Seafolly Pty Ltd, and the respondent, Fewstone Pty Ltd, both design, manufacture and sell swimwear and beachwear. Fewstone trades as City Beach Australia. Seafolly commenced proceedings against Fewstone in the Federal Court of Australia, alleging copyright infringement in three artistic works: the "English Rose" artwork; the "Covent Garden" artwork; and the "Senorita" artwork. The Australian Federal Court found that the omission in the Australian Copyright Act of an exclusive right to make an adaptation does not mean that the adaptation of an artistic work is open to all. It does not follow that any conduct short of an exact or near-identical copy of an artistic work cannot infringe copyright.

An award of compensatory damages of $ 20,000 for damage to reputation was awarded. General and specific deterrence warrant a substantial award of additional damages in the amount of $ 150,000 was also awarded. The court found there was a causal connection between the designs and still sufficient similarity to find infringement.

This case and the Louis Vuitton case illustrate that a copier can't necessarily avoid infringement even if they do not make a direct copy of the goods and/or TMs.

E. Special Event Organised by Recognised Group

Annual Day Meeting

The Annual Day Meeting of 2014 was held in Perth, Western Australia, on 27 June 2014. We were pleased once again to have an international visitor, Mr Wonkee Jung, President of NEIT International Patent & Law Firm.

We were also lucky to have President of the New Zealand Institute of Patent Attorneys, Logan O'Callahan and Lisa Bailey as a representative of IP Australia. Both of these visitors gave an excellent presentation on "A Single Economic Market Developing between New Zealand and Australia" and "The Single Patent Examination Process".

Each of the members of the various Standing Committees gave a presentation on developments on their groups and how best to provide additional information to APAA from the Australian Group.

Mr Greg Munt, International Senior Vice-President of APAA also presented on what is happening in APAA internationally including development of the APAA Academy and Asian IP Forum.

There were also some discussions as to whether APAA Australia could develop co-ordinated meetings with other groups, for example, the New Zealand Group.

At the Annual General Meeting positions on the Executive remained as per last year with Paul Harrison continuing as President, and David Webber continuing as Vice President and Secretary.

F. International Events Attended on behalf of Recognised Group

AU President Paul Harrison continues to represent APAA at the WIPO PCT Working Group. Unfortunately Paul could not attend the joint Japan/Korea Patent Committee meeting in Seoul. However, communication between the Australian, Japanese and Korean groups has been excellent and continues to provide a platform for expressing the views and concerns of APAA to WIPO and other entities.

Paul Harrison was also invited by the FICPI Australia Group to provide a report on the latest developments at WIPO PCT Working Group meeting. This has proved beneficial and continues to develop the close relationships between APAA and FICPI which will be beneficial in expressing the views of members to WIPO and other government bodies.

G. Future Events Planned by Recognised Group

The next Australian Day Group meeting will be held in August 2015. It is the Australian Group's intention to again invite the APAA Executive as well as members from Japan, Korea and any other groups to join in the meeting.

H. Contributed by

Paul G Harrison.

APAA 2014 GROUP REPORT OF HONG KONG

A. IP Statistics Year 2014

1. Number of applications filed with the Patent Office 2013

Year	Patent/PCT	Utility Model	Design	Trademark	Madrid	GI/Plant Variety
2013	13,916 (Standard Grant-6,564) 552 (Short-Term Grant-538)	NA	4,584 Registered-4765	37,092 Registered-31,464	NA	NA

2. Domestic–Foreign Breakdown 2013

NA.

3. Examination requests made, reports issued and waiting period 2013

NA.

B. Legislative Changes and Policy Update

1. Patents

1.1. Major Changes and Implications

The Advisory Committee appointed by the Hong Kong Government recommended the following:

I. Introduce original grant of patents.

II. Retain current system of re-registration of patents.

III. Amendment to current system of short-term patents.

IV. Introduce a full regulatory system w.r.t patent agency services.

The Government introduced transitional measures to regulate providers of patent agency services and the possible interim regulation of the use of professional titles such as "Patent Agent" and "Patent Attorney".

1.2. Important Case Law

Please refer to the Standing Committee Reports for full details, but there have been a couple of notable cases in Hong Kong since my last report. There has been a rare fully contested patent trial. Judgements have also been given in relation to copyright cases involving applications for interlocutory injunctions based on a copyright claim, copyright in a restaurant menu (a case also involving trade mark issues) and a Court of Appeal decision in relation to assessment of damages in a copyright case. The courts have also given judgements in two Trade Mark-related cases – one in relation to an application filed in bad faith, the other in relation to infringement and passing-off issues between Juicy Couture and Juicy Girl.

1.3. Practice Note/Update

The Director of the IP Department (IPD), Peter Cheung, retired and a new Director of IPD was appointed. The Hong Kong Group of APAA celebrated its fortieth anniversary on 20 October 2014. The Hong Kong Intellectual Property Academy has been established. A separate Education Committee is working on details of courses and IP education opportunities that will be offered in the future. The Hong Kong IP Academy will work closely with the APAA Academy.

2. Copyright

2.1. Major Changes and Implications

A Copyright (Amendment) Bill was introduced in 2011 to introduce a variety of different measures aimed at strengthening copyright protection in the digital environment. However due to public concern over potential abuse of these measures, introduction of the Bill was delayed. It was recently re-introduced to the legislative process with broadly similar changes of that of 2011 with key emphasis on works of parody, where a "fair dealing" exception has been introduced as a direct result of public concerns over this issue.

3. Trademarks

NA.

4. Designs

NA.

C. Others (Geographical Indications/ Plant Variety/etc.)

NA.

D. Special Event Organised by Recognised Group

NA.

E. International Events Attended on behalf of Recognised Group

NA.

F. Future Events Planned by Recognised Group

NA.

G. Contributed by

Tim Hancock, President, Hong Kong Group of APAA, 4 November 2014.

APAA 2014 GROUP REPORT OF INDIA

A. IP Statistics Year 2013

1. Number of applications filed with the Patent Office 2013

Year	Patent/PCT	Utility Model	Design	Trademark	Madrid	GI/Plant Variety
2013	NA	NA	8,337	1,94,216	NA	NA

2. Domestic–Foreign Breakdown 2013

	Patent	Utility Model	Design	Trademark	Plant Variety
Domestic	NA	NA	5,428	1,79,436	NA
Foreign			2,909	14,780	

3. Examination requests made, reports issued and waiting period 2013

NA.

B. Legislative Changes and Policy Update

1. Patent

1.1. Major Changes and Implications

New category of applicant called "small entity" interpreted as per the Micro, Small and Medium Enterprises Development Act, 2006 and a new form applicable thereto have been introduced.

1.2. Important Case Laws

1.2.1. *Dr. Aloys Wobben & Ors. v. Yogesh Mehra & Ors.* [AIR 2014 SC 2210 : 2014 (7) SCALE 536]

The Supreme Court held that the Defendant would be disentitled to file a counter claim if *prior* to the infringement suit, he has already filed *revocation* under section 64(1) before the IPAB; the Defendant cannot file revocation after filing counter claim for the same; on filing post-grant opposition, such person is barred from filing revocation or counter claim as a defendant in the infringement suit.

1.2.2. *Bayer Corporation v. Union of India (NATCO Case)* [AIR 2014 Bom 178 : 2014 (60) PTC 277 (Bom)]

Compulsory license granted by Indian Patent Office in favour of Natco Pharma Limited was upheld by the Bombay High Court and as per a recent order, the Court agreed with IPAB's decision holding that the grant of compulsory licenses is to be considered on a case-to-case basis.

1.2.3. *Chemtura v. Union of India* [2009 (41) PTC 260 (Del) : MIPR 2009 (3) 287]

The Delhi High Court held that failure to comply with requirements of section 8 is a serious issue effecting the validity of the patent.

1.2.4. *Ericsson v. Micromax series of cases Telefonaktiebolaget Lm Ericsson (Publ) v. Mercury Electronics & Anr.* [2013 (56) PTC 85 (Del) : 206 (2014) DLT 423]

The Delhi High Court had ordered the Defendant to pay interim royalty to Plaintiff during the pendency of the suit. But in *XU Dejun & Ors. v. Vringo Infrastructure Inc. & Anr.,* concerning a CDMA technology patent, a Division Bench of the Delhi High Court, reversed the trend of setting interim arrangements, where the plaintiff alleges infringement of SEPs and claims FRAND negotiations.

1.2.5. *Teijin Ltd. v Union of India* [AIR 2014 Bom 68 : 2014 (4) BomCR 208]

The Bombay High Court restored a patent that had ceased due to procedural lapses on the part of the Patent Office.

1.2.6. *Nitto Denko Corp. v. Union of India & Ors.* [W.P. (C) 3756/2013]

In the matter of a civil writ petition questioning delay in issuance and seeking directions regarding timeline of issuance of first examination report (FER), the Delhi High Court issued orders directing the Indian patent office to file an affidavit indicating the concerned state of affairs and disclosing annual pendency of patent matters. Accordingly, a committee has been constituted to look into the same.

1.3. Practice Note/Update

The Indian Patent Office starts functioning as International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA). Further, draft guidelines have been made available for examination of Computer Related Inventions (CRI) and pharmaceutical inventions. Lastly, in an order passed in the matter of *NTT DoCoMo Inc. v. Controller of Patents & Design* [OA/39/2011/PT/CH], the Intellectual Property Appellate Board (IPAB) has held that where a patent applicant is not the true and first inventor of the invention, it is mandatory to file a "proof of right" while applying for the patent.

Also, a trend of the High Court towards granting interim injunctions in pharmaceutical patent matters has been seen in India in the recent past (***Novartis A.G. v. Ranbaxy Laboratories Ltd.* [MIPR 2014 (3) 142]**)

2. Design

2.1. Major Changes and Implications

No significant changes.

2.2. Important Case Law

Supreme Court: NA.

High Courts/IP Special Courts/District Courts

2.2.1. *Whirlpool of India Ltd. v. Videocon Industries Ltd.* [2014 (60) PTC 155 (Bom) : 2015 (1) BomCR 137]

(i) Suit for infringement under section 22 is maintainable against subsequent registered proprietor.

(ii) For defence of functionality the only consideration to determine functional requirements of the said product should be the design.

(iii) If the Defendant itself had registered a design identical to the Plaintiff's, it cannot be contended that the Plaintiff's design is not novel or original.

(iv) If minor differences between two designs were such that the latter can be regarded as novel then Defendant's product must also be regarded novel.

(v) Issue of *Passing Off:* If the class of consumers is such that may get confused between two similar goods, it amounts to passing off.

2.2.2. Steelbird Hi-Tech India Ltd. *v. S.P.S. Gambhir & Ors.* [2014 (58) PTC 428 (Del) : MIPR 2014 (1) 277]

The Court laid down a test for novelty and originality by citing *Simmons v Mathieson & Cold* [(1911) 28 RPC 486]. It further cited *Phillips v Barbro Rubber Company* [(1920) 37 RPC 233] to state that to determine infringement eye should be that of an instructed person with common trade knowledge and usage. It distinguished between "new" and "original" and cited what Buckley LJ said in *Dover Ltd. v. Nurnberger Celluloidwaren Fabric Gebruder Wolff* [(1910) 27 RPC 498]. The Court also observed that the "beak shaped design" is not original and common in the helmet industry.

2.2.3. *Standard Corporation India Ltd. v. Tractors and Farm Equipment Ltd.* [MIPR 2014 (2) 23]

The Division Bench of the Madras High Court confirmed that the right to seek reliefs before a Court of law cannot be curbed at the outset without having proper reasons to do so.

2.3. Practice Note/Update

NA.

3. Trade Mark

3.1. Major Changes and Implications

3.1.1. Recent Developments/Notifications – TRADE MARK REGISTRY

The Controller General of Patents, Designs and Trade Marks (CGPDTM) launched the "*Dynamic Trademark Utility*" to allow easy access to trademark registry's functioning. It introduced online filing of replies to examination reports, forms of renewal, opposition, corrections, duplicate registration certificate, legal certificates etc.

The CGPDTM published *"Guidelines for functioning under the Madrid Protocol"* in view of India's accession to Madrid Protocol. It also launched a *Stock and Flow based Dynamic Trademark Utility.* Lastly, the Government amended Trademark Rules to increase application fee per form and the fees for expedited examination of trademark.

3.2. Important Case Law

Supreme Court/High Courts/IP Special Courts/District Courts

3.2.1. *Living Media India Ltd. & Anr. v. Alpha Dealcom Pvt. Ltd. & Ors.* [2014 (58) PTC 589 (Del) : 208 (2014) DLT 145]

The Delhi High Court observed that the word "TODAY" is not an invented word, instead, it is an adopted word and is descriptive of the business of news and current affairs, hence, cannot be monopolised by one entity.

3.2.2. ***Jones Investment Inc. Co. v. Nagarajan Srinivasan*** **[MIPR 2014 (1) 377]**

The Intellectual Property Appellate Board held that an MNC cannot claim infringement of trademark by a local Indian company purely based on international presence, unless presence in India is established.

3.2.3. ***Sonu Nigam v. Amrik Singh (alias Mika Singh) & Anr.*** **[Suit No. 372/2013, decided on 26.04.2014]**

The Bombay High Court recognised personality rights of music composers and singers from the Bollywood industry.

3.2.4. ***Procter & Gamble Manufacturing Co. Ltd. v. Anchor Health & Beauty Care Pvt. Ltd.*** **[MIPR 2014 (2) 250 : 2014 (59) PTC 421 (Del)]**

The Delhi High Court discussed descriptiveness of a trademark and that taglines/slogans are valid trademarks as they serve the purpose of trademark by enabling consumers to identify the goods and services.

3.2.5. ***M/S Allied Blenders & Distillers Pvt. Ltd. v. Shree Nath Heritage Liquor Pvt. Ltd.*** **[2014 (59) PTC 42 (Del) : 211 (2014) DLT 346]**

Trademarks Officer's Choice and Collector's Choice were in question. The Court applied the test of similarity/dissimilarity, trade channels, nature, character and use of goods/services by consumes. It held that the possibility of confusion cannot be ruled out.

3.2.6. ***Techlegal Solutions Pvt. Ltd. v. Genelia Ritiesh Deshmukh*** **[2014 (59) PTC 510 (Bom) : 2014 (4) BomCR 822]**

The Plaintiff claimed monopoly over a well-known, old, colloquial Marathi term that was not coined by him. The Bombay High Court held that the mandate of intellectual property rights should not unnecessarily extend to cover all uses of common/colloquial phrases in use in India.

3.2.7. ***People Interactive (I) Pvt. Ltd. v. Gaurav Jerry*** **[MIPR 2014 (3) 101]**

The dispute revolved around domain name shaadi.com and shaadihishaadi.com. The Bombay High Court ruled in favour of the plaintiff and explained and observed the terms meta-tags and meta-tagging.

3.2.8. ***Precious Jewels v. Varun Gems*** **[(2015) 1 SCC 160 : 2014 (9) SCALE 146]**

The Supreme Court discussed the application of section 35, and acknowledged the right of using one's own name or surname as part of trademark.

3.2.9. ***Emcure Pharmaceuticals Ltd. v. Corona Remedies Pvt. Ltd*****. [2014 (60) PTC 332 (Bom) : 2015 (1) BomCR 197]**

The Bombay High Court dealt with Effect of Acquiescence (section 33, Trademarks Act). The court ruled that mere delay will not defeat rights of the registered proprietor and that mere silence is not equivalent to acquiescence.

3.3. Practice Note/Update

NA.

4. Copyright

4.1. Major Changes and Implications

There were no legislative developments this year.

4.2. Important IP Case Law

Supreme Court: NA.

High Courts/IP Special Courts/District Courts/Patent Office:

4.2.1. *Multi Screen Media Pvt. Ltd. v. Sunit Singh & Ors.* [CS (OS) 1860/2014]

The Plaintiff filed a suit for permanent injunction seeking John Doe orders ('Ashok Kumar' orders) against the world at large and 219 rogue websites in relation to infringing broadcasting rights of 2014 FIFA World Cup broadcasts. An *ex parte* injunction was granted by the Hon'ble Court.

4.2.2. *Institute for Inner Studies & Ors. v. Charlotte Anderson & Ors*. [2014 (57) PTC 228 (Del) : MIPR 2014 (1) 129]

The Court discussed scope of Copyright Law w.r.t. literary works and laid distinction between realms of Copyright protection as opposed to Patent protection.

4.2.3. *Tech Plus Media Pvt. Ltd. v. Jyoti Nanda & Ors*. [2014 (60) PTC 121 (Del)]

The Court dismissed suit by Plaintiff against its ex-employee claiming copyright infringement of its database of users sing it could not have "authored" such database.

4.2.4. *M/s. Jagdamba Impex v. M/s. Tristar Products Pvt. Ltd.* [2014 (59) PTC 149 (Del) : MIPR 2014 (2) 164]

The Plaintiff claimed copyright over drawings of a machine developed and manufactured by it. The Court observed that more than 50 articles had been produced by Defendants by the application of the drawing therefore no copyright can be claimed under section 15(2) of the Copyright Act.

4.2.5. *Ramesh Sippy v. Shaan Ranjeet Uttamsingh and Ors.* [MIPR 2014 (1) 32]

Appellant claimed to be "author" and "first owner of copyright" in the cinematograph film *Sholay* and not just his father as claimed by Respondents. The Court dismissed the suit and held that authorship of a work comes into existence only when it is complete.

4.2.6. *Paragon Rubber Industries v. Pragati Rubber Mills & Ors.* [2014 (57) PTC 1 (SC) : 2013 (14) SCALE 273]

The Supreme Court held that a composite suit is not maintainable unless the court has jurisdiction to entertain the suit in relation to entire cause of action and relief.

4.2.7. *Tekla Corporation & Anr. v. Survo Ghosh & Anr.* [AIR 2014 Delhi 121 : MIPR 2014 (2) 264 : 2014 (59) PTC 323 (Del)]

The Court refused to recognise defence of "copyright misuse" holding that nothing outside section 52 which provides exhaustive list of defences to copyright infringement could constitute a valid defence.

4.2.8. *Pepsico Inc. v. PSI Ganesh Marketing & Anr.* [MIPR 2014 (2) 240 : 2014 (59) PTC 275 (Del)]

The Court awarded punitive damages against the Defendant for infringing Copyrights in the artistic label "AQUAFINA" of the plaintiff.

4.2.9. *King.com Ltd. v. Apeejay Surrendra Park Hotels Ltd.* [Suit No. 576 of 2014]

The Court granted injunction restraining defendant from using the images of "Candy Crush Saga" game in relation to its online advertisements for a live music gig.

4.3. Practice Note/Update

4.3.1. E-Filing of Copyright Applications – The system of electronic filing has been introduced and electronic filings of Copyright Applications have begun.

4.3.2. Digitisation of Data & Online Search Facility – The data relating to copyright applications and registrations is now available online and open to public search.

5. Geographical Indications

5.1. Major Changes and Implications

There were no legislative developments this year.

5.2. Important case law

Supreme Court: NA.

High Courts/IP Special Courts/District Courts:

5.2.1. Case Name and Citation: NA.

A settlement recorded before High Court in the champagne dispute between Comité Interprofessionnel du Vin de Champagne and a Californian company, F. Korbel & Bros, Brown Foreman Worldwide LLC from using the expressions, "California CHAMPAGNE" and "Russian River Valley CHAMPAGNE", on wines produced in California.

5.3. Practice Note/Update

NA.

C. Special Event Organised by Recognised Group

NA.

D. International Events Attended on Behalf of Recognised Group

NA.

E. Future Events Planned by Recognised Group

NA.

F. Contributed by

India Group.

APAA 2014 GROUP REPORT OF INDONESIA

A. IP Statistics Year 2013

1. Number of applications filed with the Patent Office 2013

Year	Patent	PCT	Utility Model	Design	Trademark	GI	Copyright	Plant Variety
2013	1313	6056	343	4258	82477		6301	NA

2. Domestic Foreign Breakdown 2013

	PCT	Patent	Utility Model	Design	Trademark	Copyright	Plant Variety
Domestic	NA	648	234	2828	NA	6174	NA
Foreign	6056	665	109	1430	NA	127	

B. Legislative Changes and Policy Update

1. Patent

No change.

2. Design

No change.

3. Trademark

No change.

4. Copyright

Draft bill of copyright law was passed by the House of Representatives on 16 September 2014.

Some important changes are:

1. Management of a trade center is prohibited to allow the sale and or reproduction of goods resulting from violation of copyright and/or related right within their trading area organised under his management (article 10). Management of a trade center who violates this article is subject to a criminal fine of Rp. 100,000,000 (one hundred million Rupiah).

2. Copyright Duration

   Protection over copyright: apply during the life of the author + 70 years (earlier it was + 50 years),

4. Regulates right, function and procedure of Collective Management Society to collect and manage royalty of copyright owner.
5. Copyright works on expression of traditional heritage is owned by state.
6. Government has an authority to block website containing material of copyright infringement.
7. Criminal copyright infringement requires a formal complaint from copyright holder.

C. OTHER

A new Government Regulation No. 45 of 2014 on types and tariffs of non-taxed revenues of the Ministry of Law and Human Rights of the Republic of Indonesia was signed by the Indonesian President on 30 May 2014, and the Government Regulation came into effect on 3 July 2014.

D. Special Event Organised by Recognised Group

NA.

E. International Events Attended on Behalf of Recognised Group

NA.

F. Future Events Planned by Recognised Group

NA.

G. Contributed by

Migni Myriasandra.

APAA 2014 GROUP REPORT OF JAPAN

A. IP Statistics Year 2013

1. Number of applications filed with the Patent Office 2013

Year	Patent	PCT	Utility Model	Trademark	Designs	Madrid	Plant Variety
2013	328,436	43,075	7,622	117,674	31,125	1,881	1,027

2. Domestic–Foreign Breakdown 2013

	Patent	Utility Model	Design	Trademark	Plant Variety
Domestic	271,731	5,965	26,407	92,495	613
Foreign	56,705	1,657	4,718	25,179	414

3. Examination requests made, reports issued and waiting period 2013

	First Action Waiting Time		*Accelerated Examination*	
	Period (Months)	Backlog (No. of Applications)	No. of Petition	Examination Period (Months)
Patent	11	NA	NA	NA
Design	6.4	NA	NA	NA
Trademark	4.3	NA	NA	NA

B. Legislative Changes and Policy Update

1. Patent

1.1. Major Changes and Implications

1.1.1. Patent Law has been amended to re-introduce a post-grant opposition system. Japan Patents Office (JPO) has jurisdiction for both Opposition and Individual Trials. Further, Petitioner for Opposition can be anyone, however, in case of individual trials it can only be the interested party. Petition in case of opposition has to be filed within six months from patent publication as against individual trials where petition can be filed at any time. Furthermore, vis-à-vis examination, *ex parte*/documentary proceeding is available in case of oppositions and *inter partes*/oral documentary proceeding is available in case of individual trials.

1.2. Important Case Law

1.2.1. Supreme Court: NA.

High Courts/IP Special Courts/District Courts: IP High Court

***Apple Inc. v. Samsung Electronics Co. Ltd.* [Heisei 25 (Ne) 10043, Heisei 25 (Ra) 10007, and Heisei 25 (Ra) 10008, decided on 26 May 2014 by IP High Court (Grand Panel)]**

The case relates to the enforcement of SEP (Standard-Essential Patent). In this case, the court found that seeking damages can be "an abuse of right" if the amount of damages exceeds an amount equivalent to the FRAND (Fair, Reasonable and Non-Discriminatory) license fee, but cannot be "an abuse of right" if the amount of damages falls within a range of the amount equivalent to the FRAND license fee.

1.2.2. Supreme Court: NA.

High Courts/IP Special Courts/District Courts: IP High Court

***Genentech Inc. v. Commissioner of JPO* [Heisei 25 (Gyo-ke) 10195, Heisei 25 (Gyo-ke) 10196, Heisei 25 (Gyo-ke) 10197, and Heisei 25 (Gyo-ke) 10198, decided on 30 May 2014 by IP High Court (Grand Panel)]**

The court held that a request for a patent term extension should be rejected in accordance with Article 67-3 (1)(i) if either one of the following conditions is met:

First condition: A ban of practice of the patent was not lifted by the "disposition designated by Cabinet Order" (=market approval);

Second condition: An unbanned product by the "disposition designated by Cabinet Order" does not fall within the patented invention.

1.3. Practice Note/Update

NA.

2. Design (Disc Holder Case)

2.1. Major Changes and Implications

2.1.1. Design Law has been amended to be in accordance with Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs.

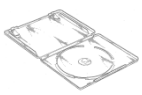
2.2. Important Case Law

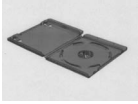
2.2.1. Supreme Court: NA.

High Courts/IP Special Courts/District Courts: Tokyo District Court

Heisei 25 (wa) 12233 [Decided on 23 January 2014 by Tokyo District Court]

The registration is a partial design in which an element for securing an aperture of disc thereto is excluded.





The court had evaluated the common points and different points between the Design registration No. 1308670 and the accused product and found that most of the common points are found in the prior article and the different points prevail. The Tokyo District Court judged that both designs were not similar to each other, and thus, decided non-infringement by Defendant and rejected Plaintiff's demands for the injunction and damages. An abstract of the judgment is as follows – "The subject design is a partial design. The portion to be protected is a 'container for disc' except for two-dot chain line, 'fastener', which is positioned at slightly lower part of the centre in the base portion."

2.3. Practice Note/Update

NA.

3. Trade Mark

3.1. Major Changes and Implications

3.1.1. Trademark Law has been amended to include protection of non-traditional trademarks including sounds, colours, motion, hologram and position marks.

3.2. Important Case Law

3.2.1. Supreme Court: NA.

High Courts/IP Special Courts/District Courts: IP High Court

Ate My Heart Inc. v. Commissioner of JPO (LADY GAGA Case) **[Heisei 25 (Gyo-Ke) 10158, decided on 17 December 2013 by IP High Court]**

The case relates to distinctiveness of the name of a famous singer. The court found that "LADY GAGA" is well known in Japan as a female American singer, and if the mark is used for "phonographic records; downloadable music files; exposed cinematographic films; pre-recorded video discs and video tapes" in Class 9, traders and consumers coming into contact with the mark would recognise the relevant goods as indicating either the person singing the song(s) contained in such goods, or the person appearing and singing in the video(s) pertaining to such goods, in other words, as indicating the quality (contents) of such goods, and the mark is, therefore, incapable of demonstrating the function of a mark for distinguishing one's own goods from the goods of others. The court affirmed the JPO decision.

3.3. Practice Note/Update

NA.

4. Copyright

4.1. Major Changes and Implications

4.1.1. Copyright Law has been amended to expand publishing rights to cover an electronic book. The amendments shall come into force on 1 January 1 2015.

4.2. Important Case Law

4.2.1. Supreme Court: NA.

High Courts/IP Special Courts/District Courts: Osaka District Court

H25 (Yo) 20003 *(Wall of Hope Case)* [Decided on 6 September 2013 by Osaka District Court]

In this case, the main discussion was on the "Right to Maintain Integrity". Article 20 of the Copyright Act of Japan defines Right to Maintain Integrity as follows:

a. The author shall have the right to maintain the integrity of his work and its title, and no distortion, mutilation or other modification thereof shall be made against his intent.

b. The provisions of the preceding paragraph shall not apply to any of the following modifications: a modification of an architectural work by means of extension, rebuilding, repairing, or remodeling.

4.2.2. Supreme Court: NA.

High Courts/IP Special Courts/District Courts: Tokyo District Court

H24 (wa) 964 *(Toyama-no-Kinsan Case)* [Decided on 30 April 2014 by Tokyo District Court]

The court applied Article 114(2) of Copyright Act and Article 38(2) of Trademark Act of Japan in this case.

4.3. Practice Note/Update

NA.

C. Others (Geographical Indications/ Plant Variety/etc.)

The Japanese government (MAFF: Ministry of Agriculture, Forestry and Fisheries) has established Geographical Indication Protection Act. The Act shall come into force within one year from 25 June 2014.

D. Special Event Organised by Recognised Group

The 2014 annual general meeting of the Recognised Group of Japan was held on 18 February 2014 at The Hilltop Hotel followed by a seminar with a focus on topics discussed at the Standing Committees in 2013 Hanoi Meeting and a reception attended by our members and a number of distinguished guests from the JPO, IP High Court and JPAA.

E. International Events Attended on Behalf of Recognised Group

The Japan-Korea Joint Patent Committee meeting was held on 19 July 2014 in Seoul. The Japan-Korea Joint Trademark & Design Committee meeting was held on 19 July 2014 in Tokyo.

F. Future Events Planned by Recognised Group

The 2015 annual general meeting is scheduled to be held on 20 February 2015.

G. Contributed by

Shigeru Inaba.

APAA 2014 GROUP REPORT OF KOREA

A. IP Statistics Year 2013

1. Number of applications filed with the Patent Office 2013

Year	Patent	PCT	Utility Model	Trademark	Designs	Madrid	Plant Variety
2013	204,589	NA	10,968	144,667 (177,685)	66,940 (70,054)	NA	NA

( ): including multiple designs and multiple classes of trademarks

2. Domestic–Foreign Breakdown 2013

	Patent	Utility Model	Design	Trademark	Plant Variety
Domestic Foreign	159,978 44,611	NA	NA	NA	NA

3. Examination requests made, reports issued and waiting period 2013

	First Action Waiting Time		*Accelerated Examination*	
	Period (Months)	Backlog (No. of Applications)	No. of Petition	Examination Period (Months)
Patent	NA	NA	NA	NA
Design	NA	NA	NA	NA
Trademark	NA	NA	NA	NA

B. Legislative Changes and Policy Update

1. Patent

(a) Major Changes and Implications

I. Filing in English

Filing in English will be possible with effect from 1 January 2015.

II. Extending deadline for filing translation of PCT applications

One more month shall be given for the filing of the Korean translation.

III. Allowing amendments based on the original application

Amendments or corrections made to the patent applications filed on or after 1 January 2015 can be made based on the specifications filed on the PCT filing date in foreign language. The specifications in foreign language will be considered the original specifications supporting the amendments and corrections.

(b) Important Case Law

I. Supreme Court: See below

High Courts/IP Special Courts/District Courts: NA.

2012 Hu 4162 [Decided on 20 March 2014 by Korean Supreme Court *en banc*]

It was held that the confirmation trial cannot review the non-obviousness issue on the validity. Validity of a patent can be ruled invalid only by the Invalidity Trial.

(c) Practice Change

NA.

2. Trademarks

(a) Major Changes and Implications

I. Lowering the standard for "secondary meaning" of non-distinctive marks

The revised act effective from 11 June 2014 eased the bar of the "secondary meaning" required for non-distinctive marks to be registered by deleting the word "remarkably" (vis-à-vis Trademark as a source indicator).

II. Preventing the dilution of famous marks

Registration of a mark would be refused if it is likely to have consumers confused with another person's famous mark, or dilute the distinctiveness of another person's famous mark.

III. Preventing the registration of a mark that lacks good faith

Rightful use of a registered trademark is barred when the use results in an unfair competition.

(b) Important Case Law

I. Supreme Court: NA.

High Courts/IP Special Courts/District Courts: See below

2013 Na 26816 [Decided on 17 October 2013 by Seoul High Court]

The case relates to the enforceability of a 3D trademark registration. Plaintiff Pfizer filed an infringement suit against the Defendant in relation to the sale of a diamond shaped blue coloured product () to treat sexual dysfunction which was similar to Plaintiff's product VIAGRA. The High Court had decreed in favour of the plaintiff.

(c) Practice Change

NA.

3. Designs

(a) Major Changes and Implications

I. The term of a design right has been extended

The term of a design right was extended to 20 years from the filing date from 15 years from the registration date.

II. Adoption of "related design" system

Similar design system was replaced by new "Related Design".

III. Improvement of multiple design system

Multiple Design Application covering up to 100 articles in the same Locarno Class became acceptable**.**

IV. Adoption of Locarno Classification

Locarno classification was made acceptable.

V. Expansion of the grounds for a request of re-examination

Post-amendment, re-examination based on an amendment of any specifications indicated in the application has been made possible (Argument for re-examination – also possible).

VI. Improvement of exception of loss of novelty

In order to claim exception of loss of novelty at the filing time of design application, the relevant documents to prove the design has an exception of loss of novelty must be submitted at the filing time of design application or within 30 days from the filing date.

VII. The Hague Agreement came into effect

The Hague Agreement came into effect in the Republic of Korea on 1 July 2014.

(b) Important Case Law

I. Supreme Court: See below

High Courts/IP Special Courts/District Courts: NA.

2012 Hu 3343 [Supreme Court]



Perspective view Front view Rear view

Even though the elements of a partial design application, '' and '' of the subject design are separated physically by the body of mobile phone, these parts can be perceived respectively as "rabbit's ears" and "rabbit's tail" and thus the integrity of these parts can be perceived as "a rabbit" to produce a visual aesthetic sense as a whole. The application, therefore, satisfies the statutory requirement of a single design.

(c) Practice change

NA.

C. Special Event Organised by Recognised Group

In June 2014, APAA Korea Group hosted the "2014 APAA Young Patent Attorney Talk-Concert" for the non-member patent attorneys.

D. International Events Attended on Behalf of Recognised Group

In March 2014, APAA Myanmar Recognized Group hosted the "Myanmar IP Seminar" in Yangon; 3 members of APAA Korea joined the seminar as speakers.

E. Future Events Planned by Recognised Group

(1) Hosting an international IP Seminar on the issues of Amendments of IP Law and notable cases in Korea, the U.S., the E.U., Japan, etc.

(2) Rendering service for research to heighten the need and values of IP.

F. Contributed by

Jordan Y. Kim.

APAA 2014 GROUP REPORT OF MACAU

A. IP Statistics Year 2014

1. Number of applications filed with the Patent Office 2013

Year	Patent/PCT	Utility Model	Design	Trademark	Madrid	GI/Plant Variety
2013	**For Invention patent** 60 56 (2012) 94 (2014) **PRC Extension** 348 239(2012) 227(2014)	21 26(2012) 20(2014)	141 167(2012) 108(2014)	10.084 9,581 (2012) 9240 (2014)	NA	NA

2. Domestic–Foreign Breakdown 2013

NA.

3. Examination requests made, reports issued and waiting period 2013

NA.

B. Legislative Changes and Policy Update

1. Trademark

1.1. Major Changes and Implications

Registrations and renewals are now valid for a period of seven years after granting.

1.2. Important Case Law

NA.

1.3. Practice Note/Update

NA.

2. Patents

2.1. Major Changes and Implications

The enactment of the IPC, a self-regulating patent registration system. The IPD will handle formal examination of the application and the applicant will have to revert to the State Intellectual Property Office (SIPO) for examination of its patent application.

2.2. Important Case Law

NA.

2.3. Practice Note/Update

Macau and Mainland China have different juridical systems therefore protection in China does not automatically imply protection in Macau, however it is possible to apply for extension of Chinese patents into Macau within the three months following the publication of the granting decision in China after the introduction of the re-registration system similar to that of Hong Kong. Although the number of applications of patents have been decreasing consistently since 2008, the applications for extension of patents have been increasing every year; 2011 being the only exception with a slight decrease.

C. Others (Geographical Indications/ Plant Variety/etc.)

NA.

D. Special Event Organised by Recognised Group

NA.

E. International Events Attended on Behalf of Recognised Group

NA.

F. Future Events Planned by Recognised Group

In order to incentivise and facilitate the acquisition of new members, a registration package has been put in place with all the necessary documents and information, and distributed among all members, requesting them to try to get more members to join the group. Informal contacts with the Macau Intellectual Property Department (IPD) were conducted, relating to the implementation of online applications as well as regarding other points of concern to the Group. A proposal of alteration of Macau Industrial Property Code (IPC) is still pending.

G. Contributed by

APAA Macau Group, Nuno Sardinha da Mata, President and Luis Reigadas, Vice-President.

APAA 2014 GROUP REPORT OF MALAYSIA

A. IP Statistics Year 2014

NA.

B. Legislative Changes and Policy Update

1. Patent

1.1. Major Changes and Implications

There were no amendments to the legislation and the law remains unchanged for 2014.

1.2. Important Case Law

1.2.1. *Seng Kong Shutter Industries Sdn Bhd & Anr v. SKB Shutters Manufacturing* [(2014) 4 CLJ 1037]

The Court accepted the test in *The General Tire & Rubber Co v. The Firestone Tyre & Rubber Co Ltd* [(1972) RPC 457] which states that in assessing whether a prior article anticipates the subject invention of a patent it is by comparing the features of the claims of the patent with the features of the prior article. The Court further accepted the approach adopted for assessing non-obviousness as laid down in *Windsurfing International Inc. v Tabur Marine (Great Britain) Ltd*. [(1985) RPC 59].

1.2.2. *Chien Jin Plastic Industries Sdn Bhd v. Polyware Sdn Bhd* [(2014) 1 LNS 1053]

The High Court held that it could not rule on the validity of the patent without the evidence of expert witness.

1.2.3. *Cadware Sdn Bhd v. Ronic Corporation* [(2013) 6 MLJ 19]

Pursuant to the Court of Appeal's decision to reverse the decision of the High Court Judge, the Respondent filed an application for leave to appeal to the Federal Court against the decision of the Court of Appeal. However, the Respondent's application for leave to appeal to the Federal Court was dismissed.

1.3. Practice Note/Update

NA.

2. Design

2.1. Major Changes and Implications

There were no amendments to the legislation and the law remains unchanged for 2014.

2.2. Important Case Law

2.2.1. *Veresdale Ltd. v. Doerwyn Ltd.* [(2014) 1 LNS 495]

The Court referred to the case of *Ford Motor Company Limited v. Iveco Fiat Spa's Design Application* [(1993) RPC 399] where it was held that the "must match" exclusion means that where an article (the door panel) is intended to form an integral part (of the vehicle), the said article (the door panel) is excluded from registration.

2.2.2. *F&N Dairies (Malaysia) Sdn Bhd v. Tropicana Products Inc. & Anr.* [(2013) 1 LNS 380]

Pursuant to the Court of Appeal's decision to reverse the decision of the High Court Judge, the Respondent filed applications for leave to appeal to the Federal Court against the decision of the Court of Appeal. However, the Respondent's applications for leave to appeal to the Federal Court were dismissed.

2.3. Practice Note/Update

3. Trade Mark

3.1. Major Changes and Implications

There were no amendments to the legislation and the law remains unchanged for 2014.

3.2. Important Case Law

3.2.1. *Mesuma Sports Sdn Bhd v. Majlis Sukan Negara*, Malaysia [(2014) 1 LNS 1055]

The Court of Appeal held that as the Appellant did not have a good title to the Design and Respondent was the originator of the Design, registration of the Design was baseless and hence Trade Mark Register be rectified by removing the registration.

3.2.2. *Chua Cheng Kiat v. Chua Cheng Ho* [(2014) 1 LNS 502]

The Defendant succeeded in proving joint ownership of a trade mark since by doing that it bought over the business and the mark with the Plaintiff and has been running his business since.

3.2.3. *Wieland Electric GmbH v. Industrial Automation (M) Sdn Bhd & Anr.* [(2014) 7 CLJ 970]

Defendant appointed by plaintiff as sales agent registered a trade mark identical to the Plaintiff's. The Court held that the Defendant misled and misrepresented itself to the Registrar and the Plaintiff was the rightful proprietor. Failure to file opposition to Defendant's registration did not preclude the Plaintiff from taking an action.

3.2.4. *Cargill Incorporated v. Pendaftar Cap Dagangan* [(2013) 10 CLJ 144]

The Court held that the trade mark "POULTRY FOCUS" is not descriptive of the goods for which registration was sought and any reference would only be indirect. It did not accept submission that the combination was not inventive and therefore, the mark was registrable.

3.2.5. *Ken Holdings Bhd & Ors. v. Sri Seltra Sdn Bhd & Ors.* [(2014) 9 MLJ 858]

The Court held that passing off is no longer confined to the traditional take on passing off and misrepresenting one's business as that of another's in any way likely to cause damage or that one's business is an extension/branch connected with another's business

3.3. Practice Note/Update

NA.

4. Copyright

4.1. Major Changes and Implications

There were no amendments to the legislation and the law remains unchanged for 2014.

4.2. Important Case Law

Supreme Court: NA.

High Courts/IP Special Courts/District Courts:

4.2.1. *Sherinna Nur Elena bt Abdullah v. Kent Well Edar Sdn Bhd* [(2014) 7 MLJ 298]

The Plaintiff held no copyright in the photograph as he was not the photographer/author/arranger or producer of the photograph and hence did not have *locus standi* to maintain the suit.

4.2.2. *Microsoft Corporation v. Conquest Computer Centre Sdn Bhd* [(2014) 6 CLJ 876]

The Court dismissed the Defendant's contention that the work installed into the Defendant's computer was a trial version entitled to be used for free. The Court held that the Defendant infringed and would continue to infringe copyright in Plaintiff's work by selling computers pre-installed with the Plaintiff's software, thus re-producing & marketing pirated copies of the software, without the Plaintiff's license/ consent and without providing paraphernalia to purchasers.

4.2.3. *Public Prosecutor v. Chan Chun Tat* [(2014) 10 MLJ 746]

The Court set aside the Sessions Court's decision ruling that prosecution had successfully proved a *prima facie* case against the Defendant. As a result, the Defendant was called to enter his defence against the charge before the same Sessions Court Judge.

4.2.4. *Lee Chye Yen & Anr. (t/a "Ebiz Solution Network") v. EoneNet Com Sdn Bhd* [(2014) 4 MLJ 595]

The Court of Appeal held that the statutory declaration could not have been admitted as a *prima facie* evidence to support claim of ownership of copyright as the respondent had failed to comply with requirements under section 42(1)(a)(iii) of the Copyright Act, 1987.

4.2.5. *Vision Cast Sdn Bhd & Anr. v. Dynacast (Melaka) Sdn Bhd & Ors.* [(2014) 1 LNS 557]

The Court held that ownership of copyright of disputed images or photographs belonged to the respective photographers or with the other entities which had been attributed to in the respondents' promotional material since there was no similarity between the layout/title/content of the respondents' and appellants' promotional materials and mere calling of a witness from the agency that compiled the respondents' promotional material was not sufficient to prove the respondents' claim of ownership of the copyright to the images or photographs.

4.3. Practice Note/Update

There have been no changes/developments in the copyright enforcement over the last year.

5. Emerging IP

5.1. Major Changes and Implications

5.1.1. Increased Opportunities for Monetisation of Intellectual Property in Malaysia

The Industrial Designs (Amendment) Act, 2013 was introduced to facilitate monetization of IP, clarify rights of owners and emphasise on eligibility of registered designs to be used as collateral. The Intellectual Property Corporation of Malaysia (MyIPO) launched

the IPR Marketplace online portal "www.iprmarketplace.com.my" where Owners can place their IP for sale/out-licensing.

5.1.2. Japan Patent Prosecution Highway Program

The Japan Patent Office (JPO) and MyIPO initiated the Patent Prosecution Highway pilot program to aid Japanese applicants to secure their patent rights expeditiously in Malaysia. This program will run on an initial trial basis for three years before an evaluation to determine whether and how the program should be fully implemented thereafter will be conducted.

5.2. Important Case Law

NA.

5.3. Practice Note/Update

NA.

6. Anti-Counterfeiting

6.1. Major Changes and Implications

There have been no changes/developments in enforcement over the last year.

6.2. Important Case Law

There were no cases relating to recent anti-counterfeiting efforts reported in the past year.

6.3. Practice Note/Update

NA.

7. Intellectual Property Court

7.1. Major Changes and Implications

The past year has seen a new Judge sitting in the IP Court with the previous presiding Judge elevated to the Court of Appeal. Some IP suits are being heard and disposed of faster than before in about within six to nine months. The Chief Justice of Malaysia said that he was satisfied that judges had complied with his practice direction. Some judges who did not comply with these were required to deliver their decisions within four weeks and provide grounds within eight weeks explaining the delay.

7.2. Important Case Law

There were no cases relating to recent anti-counterfeiting efforts reported in the past year.

7.3. Practice Note/Update

NA.

C. Others (Geographical Indications/ Plant Variety/etc.)

NA.

D. Special Event Organised by Recognised Group

NA.

E. International Events Attended on Behalf of Recognised Group

NA.

F. Future Events Planned by Recognised Group

NA.

G. Contributed by

Michael Soo, Group President.

APAA 2014 GROUP REPORT OF NEW ZEALAND

A. IP Statistics Year 2013

1. Number of applications filed with the Patent Office 2013

Year	Patent	PCT	Utility Model	Trademark	Designs	Madrid	Plant Variety
2013	6,902	NA	NA	10,541	1,052	NA	NA

2. Domestic–Foreign Breakdown 2013

	Patent	Utility Model	Design	Trademark	Plant Variety
Domestic	1,434	NA	243	4,508	NA
Foreign	5,468		809	6,033	

B. Legislative Changes and Policy Update

1. Patent

1.1. Major Changes and Implications

1.1.1. The Patents Act has been amended by the Patents Act 2013. Key changes under the Act include examination for obviousness and usefulness. An invention will need to involve an "*inventive step*" and demonstrate "*specific, credible and substantial utility*", as well as the exclusion of computer programs "as such" from patentability.

1.2. Important Case Law

1.2.1. Supreme Court: NA.

High Courts/IP Special Courts/District Courts: High Court

***Merial Ltd. v. Bayer New Zealand Ltd.* [(2013) NZHC 2013]**

This decision has sent a strong message to practitioners that the High Court will not entertain an attempt to supersede the jurisdiction of the Commissioner of Patents. More generally, the case is an authority that if a cause of action in the High Court covers

grounds properly provided for within a statutory dispute procedure, a plaintiff can expect that cause of action to be struck out.

1.3. Practice Note/Update

NA.

2. Design

NA.

3. Trade Mark

3.1. Major Changes and Implications

NA.

3.2. Important Case Law

3.2.1. Supreme Court: NA.

High Courts/IP Special Courts/District Courts: NA.

Hayden Crowther v. Apple Inc **[(2013) NZIPOTM 48]**

The decision confirms that merely causing a consumer to think of another mark is not enough to prevent use or registration. Rather, a consumer needs to be taken further, so as to be likely to believe there is a business connection between the two marks.

3.2.2. Supreme Court: NA.

High Courts/IP Special Courts/District Courts: High Court

Tasman Insulation NZ Ltd. v. Knauf Insulation Ltd. **(No. 2) [(2014) NZHC 960]**

In this recent decision, the High Court made important findings on the scope and nature of evidence required to prove that a trade mark has become a "generic term" under section 66(1)(c) of the Trade Marks Act 2002.

3.2.3. Supreme Court: NA.

High Courts/IP Special Courts/District Courts: NA.

Holdfast New Zealand Ltd. v. Mechanical Plastics Corp. **[(2013) NZCA 335]**

Holdfast was to act as the New Zealand distributor for wall anchor products that were designed, manufactured, and patented by MPC – a corporation based in the United States of America. Holdfast supplied its anchors under the same product code, used the same branding, and represented its products as MPC's new design. However, Holdfast's promotional material and website, both before and after the appointment of a new exclusive distributor by MPC, represented itself as an authorised distributor of MPC's products. The Court found that Holdfast's substitution of its products for MPC's was a classic case of reverse passing off but no evidence could be found as regards bait-and-switch advertising.

3.2.4. Supreme Court: NA.

High Courts/IP Special Courts/District Courts: NA.

Intercity Group (NZ) Ltd. v. The Nakedbus NZ Ltd. **[(2014) NZHC 124]**

New Zealand's first substantive decision on the unauthorized use of trademarks as keywords in Google Ad Words has determined that the use of trade marks in this way is not, of itself, registered trade-mark infringement, passing off or conduct in trade likely to mislead or deceive in breach of the Fair Trading Act 1986. The Court in the said case had held that "Nakedbus"

(defendant) purchase of the keywords InterCity (Plaintiff being Intercity, New Zealand's largest long-distance bus company) was "*use in the course of trade"* in terms of section 89(1) of the Trade Marks Act 2002. However, as the purchase of the keywords was not seen or known or understood by consumers, it could not be «*taken*" as anything by consumers, let alone "*taken as being use as a trade mark*", and so there was no use of a sign "*likely to be taken as being use as a trade mark*" in terms of section 89(2) of the Act and no trade mark infringement".

3.2.5. Supreme Court: NA.

High Courts/IP Special Courts/District Courts: NA.

***Coca-Cola Co. v. Frucor Soft Drinks Ltd.* [(2013) NZHC 3282]**

The case relates to a global IP fight between two soft drink giants, Coca-Cola and PepsiCo (with bottler and distributor Frucor Soft Drinks as first defendant). Coca-Cola took exception to PepsiCo's "Carolina" bottle and alleged trade-mark infringement, passing off and breach of the Fair Trading Act 1986. PepsiCo argued that it was not using the shape of the "Carolina" bottle as a trade mark, but rather that it had always used the shape in combination with one of three of its word and logo trademarks as a combination sign. Coca-Cola was not permitted to compare PepsiCo's signs to the unregistered "silhouette" of Coca-Cola's bottle. Coca-Cola had contended that if the shape of the bottle alone could not be a sign, a competitor could simply use a registered shape mark but avoid infringing that mark by adding a brand name. Coca-Cola ultimately failed on the basis that the bottles were not sufficiently similar. The decisive loss suffered by Coca-Cola illustrates the difficulty of enforcing shape trademarks, particularly where the shape relied on is different to (or a simplified version of) the mark that has been registered. The decision has been appealed.

3.2.6. Supreme Court: NA.

High Courts/ IP Special Courts/District Courts: High Court

***Crocodile International Pte Ltd. v. Lacoste* [(2013) NZHC 2265]**

CIL sought to have a CROCODILE and device trade mark registered by Lacoste revoked for non-use. CIL argued that it was an aggrieved person because it was the registered proprietor of that mark. However, the Assistant Commissioner found that CIL was unable to show that it was an "aggrieved person" because it could not establish that Lacoste's mark would prevent the registration of its own mark at the date of application. On appeal, this was overturned. The decision signals that the Courts are likely to take a liberal approach to the threshold question of whether an applicant is an "aggrieved person" and that any business impact on the applicant (particularly where the mark is a factor preventing the applicant from trading in New Zealand) might suffice to give standing.

3.3. Practice Note/Update

NA.

4. Copyright

4.1. Major Changes and Implications

NA.

4.2. Important Case Law

4.2.1. Supreme Court: NA.

High Courts/IP Special Courts/District Courts:

***G-Star Raw CV & G-Star Australia Pty Ltd. v. JeansWest Corporation (New Zealand) Ltd.* [(2013) NZHC 2679]**

In this decision, the Defendant (JeansWest Corporation) was found liable under New

Zealand's Copyright Act 1994 ("**Act**") for secondary infringement for importing an infringing product, in circumstances where the copying of the product itself (which took place in Australia) would not have constituted copyright infringement under Australian law. The case highlights the differences between New Zealand's and Australia's copyright and design laws, and the need for Trans-Tasman businesses to seek advice in relation to both.

4.3. Practice Note/Update

NA.

C. Others (Geographical Indications/ Plant Variety/etc.)

1. **Haka 'Ka Mate' Attribution Act 2014:** The Act grants Ngati Toa Rangatira (a New Zealand tribe, or iwi) a right of attribution to the Ka Mate haka, the traditional Maori dance made famous by the All Blacks, New Zealand's national rugby team. The Act requires that any time the Ka Mate haka is used in a publication for commercial purposes, communicated to the public or featured in a film shown or issued to the public (subject to certain "fair dealing"-type exceptions) a statement must accompany it to state that Te Rauparaha was the composer of Ka Mate and a chief of Ngati Toa Rangatira. The Act does not interfere with the use of Ka Mate by the All Blacks, as the New Zealand Rugby Union has a separate agreement with Ngati Toa Rangatira allowing the performance of Ka Mate. Lastly, it would be important to note that no copyright subsists in the Ka Mate.
2. **Copyright (Infringing File Sharing) Amendment Act 2011:** The Act implements a "three-strike" regime under which copyright owners can require ISPs (Internet Service Providers) to issue infringement notices to alleged infringers. The first notice is a detection notice, the second a warning notice and the third is an enforcement notice. If the alleged infringement continues despite the notices, a copyright owner can apply for damages through the Copyright Tribunal. Seventeen decisions had been issued by the Copyright Tribunal since the Act's inception. Since that time, only three further decisions have been issued (as of 11 September 2014).
3. **Smoke-free Environments (Tobacco Plain Packaging) Amendment Bill:** The Smoke-free Environments (Tobacco Plain Packaging) Amendment Bill ("**Bill**") had its first reading on 11 February 2014. The Bill passed its first reading and maintained its cross-party support through the Select Committee stage. The Bill currently awaits its second reading in Parliament and it seems likely that it will continue to enjoy strong support.
4. **Second-level domain names:** New Zealand Domain Names Commission Limited (the "**DNCL**") was seeking submissions on a proposal to extend the .nz domain name space by allowing anybody to register domain names at the "second level". The proposal will mean, for example, that *APAA.nz* will be a valid domain name, whereas previously only third-level domain names (for example *APAA.co.nz*) were available. From 30 September 2014, the revised version of the DNCL policy document will take effect, meaning that second-level domains will become available.
5. **Dot Kiwi Domain Names:** The sunrise period for the new .KIWI top level domain ended 17 March 2014.
6. **Nice Agreement Accession:** This concerns New Zealand's imminent accession to the Nice Agreement, which has since entered into force in New Zealand on 16 October 2013. Given that New Zealand has been using the Nice Classification system for more than 60 years, formally acceding to Nice is unlikely to materially affect daily practice. However, accession will have the benefit of allowing New Zealand to participate in future development of the system.

D. Special Event Organised by Recognised Group

NA.

E. International Events Attended on Behalf of Recognised Group

NA.

F. Future Events Planned by Recognised Group

NA.

G. Contributed by

John Glengarry.

APAA 2014 GROUP REPORT OF PAKISTAN

A. IP Statistics Year 2013–2014

1. Number of applications filed with the Patent Office 2013

Year	Patent/PCT	Utility Model	Design	Copyright	Trademark	Madrid	GI/Plant Variety
2013	934 695 (as of October 2014)	NA	464 431 (as of October 2014)	3575 3260 (as of 30 September 2014)	20,822 17,755 (as of September 2014)	NA	NA

B. Legislative Changes And Policy Update

1. Information Technology (IT)

1.1. Major Changes and Implications

Upgradation of Industrial Property Automation System (IP AS) from old technology (Centura) to latest technology (Java) in IPO-Pakistan offices. WIPO Scan+ in Registries for scanning and indexing of IP Applications was deployed. Introduction of implementation of Electronic Document Management System (EDMS) for storing and access of paper documents of IP Applications in digital form. Digitisation of IP applications records under Trade Related Technical Assistance and completion of TRTA programme Old European Commission. Further, scanning of IP paper records has started. Lastly, online filing (e-filing) of IP applications has been introduced, however, it has not been implemented as yet.

1.2. Important Case Laws

NA.

1.3. Practice Note/Update

NA.

2. Trademark

2.1. Major Changes and Implications

NA.

2.2. Important Case Laws

High Court

2.2.1. *Rupali Polyester Limited v. Baba China Builders & Developers & 6 others* [(2014) CLD 1601]

The plaintiff was engaged in the businesses of manufacturing, exporting, indenting, banking and trade financing and had applied for registration of its trade mark "Rupali" in all classes of the Classification of Goods and Services. Plaintiff alleged that the Defendant Company, engaged in the business of construction, had infringed their trade mark "Rupali" leading to confusion and deception amongst the public.

The court considered the intention of plaintiff to use the mark, honest concurrent use by the defendant and that the registration of the mark of the plaintiff is beyond the scope of the memorandum of association of the company.

2.2.2. *Shield Corporation Limited v. Dalda Foods (Private) Limited* [(2015) CLD 528]

The plaintiff filed a suit for infringement and passing off against the defendant for the use of the mark "shield and device of shield" as being confusingly similar to the mark of the plaintiff. *Ad-interim* injunction was passed against the defendant stopping them from using the trade mark in any manner whatsoever including the commercials/advertisements on electronic media and print media. The said decision was appealed to a Divisional Bench of the High Court, where the impugned order was suspended until the next date of hearing. The matter is pending adjudication.

2.3. Practice Note/Update

NA.

3. Patents

NA.

4. Designs

NA.

5. Geographical Indications

NA.

C. Special Event Organised by Recognised Group

NA.

This event was not organised by the Recognised Group.

D. International Events Attended on Behalf of Recognised Group

NA.

E. Future Events Planned by Recognised Group

NA.

F. Contributed by

Khushnum Muncherji.

APAA 2014 GROUP REPORT OF PHILIPPINES

A. IP Statistics Year 2013

1. Number of applications filed with the Patent Office 2013

Year	Patent	PCT	Utility Model	Trademark	Designs	Madrid	Plant Variety
2013	3,090	2,609	683	22,662	1,362	3,262	No Data

2. Domestic–Foreign Breakdown 2013

	Patent	Utility Model	Design	Trademark	Plant Variety
Domestic	205	651	877	12,250	No Data
Foreign	2,885	32	485	10,412	

3. Examination requests made, reports issued and waiting period 2013

	First Action Waiting Time		*Accelerated Examination*	
	Period (Months)	Backlog (No. of Applications)	No. of Petition	Examination Period (Months)
Patent	32.40	NA	NA	NA
Design	3.40	NA	NA	NA
Trademark	2.80	NA	NA	NA

B. Legislative Changes and Policy Update

1. Patent

1.1. Major Changes and Implications

1.1.1. No amendments or revisions were made to provisions of the Philippine Intellectual Property Code in the last 12 months immediately preceding 31 August 2014.

1.2. Important Case Law

NA.

1.3. Practice Note/Update

2. Trade Mark

2.1. Major Changes and Implications

2.1.1. Trade mark Law has been amended to include protection of non-traditional trademarks including sounds, colours, motion, hologram and position marks.

3.2. Important Case Law

3.2.1. Supreme Court

Birkenstock Orthopaedie GMBH and Co. KG (formerly Birkenstock Orthopaedie GMBH) vs. Philippine Shoe Expo Marketing Corporation (G.R. No. 194307, 20 November 2013)

Birkenstock Orthopaedie attempted to register its BIRKENSTOCK marks in the Philippines, but it was hindered by Shoe Town's prior registration for BIRKENSTOCK AND DEVICE. Birkenstock filed a cancellation case, but this was rendered moot when Shoe Town forgot to file a Declaration of Actual Use and its registration was cancelled. Consequently, there was no more obstacle to the registration of Birkenstock Orthopaedie's marks.

However, when Birkenstock Orthopaedie's marks were published, Shoe Town filed an opposition claiming that although it failed to maintain its registration, it continued to use the mark. Moreover, Shoe Town and its predecessor claim that they had been using BIRKENSTOCK AND DEVICE in the Philippines for more than sixteen (16) years.

The Supreme Court ruled that Birkenstock Orthopaedie could register its BIRKENSTOCK marks in the Philippines.

First, under the old trademark law (which was the basis of Shoe Town's cancelled registration), Shoe Town was required to file a Declaration of Actual Use to maintain its registration. When it did not file the Declaration, its mark was automatically cancelled and it was deemed to have abandoned or withdrawn any right or interest over the mark BIRKENSTOCK.

Second, because Shoe Town was not the true owner of the mark, it had no right to register it in the first place. Ownership was acquired by using a mark in commerce (whether in the Philippines or abroad). Here, Birkenstock Orthopaedie proved that it was using BIRKENSTOCK abroad even before Shoe Town or its predecessor began using the mark in the Philippines. It also presented its company's history and trademark registrations in different countries.

High Courts/IP Special Courts/District Courts: IP High Court

Ate My Heart Inc. v. Commissioner of JPO (LADY GAGA Case) [**Heisei 25 (Gyo-Ke) 10158 decided on 17 December 2013 by IP High Court]**

The case relates to distinctiveness of the name of a famous singer. The court found that "LADY GAGA" is well known in Japan, as a female, American singer, and if the mark is used for "phonographic records; downloadable music files; exposed cinematographic films; pre-recorded video discs and video tapes" in Class 9, traders and consumers coming into

contact with the mark would recognise the relevant goods as indicating either the person singing the song(s) contained in such goods, or the person appearing and singing in the video(s) pertaining to such goods, in other words, as indicating the quality (contents) of such goods, and the mark is, therefore, incapable of demonstrating the function of a mark for distinguishing one's own goods from the goods of others. The court affirmed the JPO decision.

3.3. Practice Note/Update

NA.

4. Copyright

4.1. Major Changes and Implications

4.1.1. Copyright Law has been amended to expand publishing rights to cover an electronic book. The amendments shall come into force on 1 January 2015.

4.2. Important Case Law

4.2.1. Supreme Court

NA.

High Courts/IP Special Courts/District Courts: Osaka District Court

H25 (Yo) 20003 *(Wall of Hope Case)* [Decided on 6 September 2013 by Osaka District Court]

In this case, the main discussion was on the "Right to Maintain Integrity". Article 20 of the Copyright Act of Japan defines Right to Maintain Integrity as follows:

a. The author shall have the right to maintain the integrity of his work and its title, and no distortion, mutilation or other modification thereof shall be made against his intent.

b. The provisions of the preceding paragraph shall not apply to any of the following modifications: a modification of an architectural work by means of extension, rebuilding, repairing, or remodeling.

4.2.2. Supreme Court

NA

4.3. Practice Note/Update

NA.

C. Others (GI/Plant Variety/etc)

NA.

D. Special Event organized by Recognized Group

The 2014 annual general membership meeting of the Intellectual Property Association of the Philippines (IPAP), Philippine Recognized Group of the APAA, was held on 29 January 2014 at the SyCipLaw Center. At the annual meeting, the President reported the representatives to the Standing Committees and the Philippine delegation to the 2013 Hanoi Council Meeting in Vietnam.

The IPAP also conducted the 2nd Lecture series which covered the amendments to Republic Act No. 8293, otherwise known as the "Intellectual Property Code of the Philippines", specifically on the Law on Copyright.

The 2nd Lecture Series was held on 31 July 2013, at the Sycip Law Center, Makati City, Philippines. The lecture featured the following speakers and topics:

a. "Overview of the Amendments to the Intellectual Property Code of the Philippines" by Atty. Louie Calvario, Attorney VI, Office of the Director General, Intellectual Property Office of the Philippines;

b. "Effect of the Copyright Law Amendments on the Book Publishing Industry" by Atty.

Andrea Pasion-Flores, Director, National Book Development Board; and

c. "Effect of the Copyright Law Amendments on Collecting Societies" by Atty. Mark Thursday P. Alciso, General Manager and Acting General Legal Counsel, Filipino Society of Composers, Authors and Publishers (FILSCAP).

The lecture was free of charge and MCLE-accredited under Updates on Substantive and Procedure Law and Jurisprudence. It was organized primarily for IPAP members and lawyers of IPAP member-firms.

E. International Events Attended on behalf of Recognized Group

Mr. Rogelio C. Nicandro, Ms. Aleli Angela G. Quirino and Mr. Bienvenido Somera, Jr. attended the AIPPI conference in Helsinki, Finland on 5-11 September 2013. Ms. Quirino and Mr. Nicandro were the Philippine Group representatives for the Exco.

F. Future Events Planned by Recognized Group

The 2015 annual general membership meeting is scheduled to be held on 28 January 2015.

G. Contributed by

Pablo M. Gancayco.

APAA 2014 GROUP REPORT OF SINGAPORE

A. IP Statistics Year 2013

1. Number of applications filed with the Patent Office 2013

Year	Patent	PCT	Utility Model	Trademark	Designs	Madrid	Plant Variety
2013	9,722	NA	7,622	21,245	1,681	NA	NA

2. Domestic–Foreign Breakdown 2013

	Patent	Utility Model	Design	Trademark	Plant Variety
Domestic	3,165	NA	NA	12,381	NA
Foreign	6,557	NA	NA	8,864	NA

B. Legislative Changes and Policy Update

1. Patent

1.1. Major Changes and implications

1.1.1. Positive grant patent system and new search and examination unit (To strengthen Singapore's patent regime)

The Patents Act has been amended to shift Singapore's patent system from a "self-assessment" patent system to a "positive grant" patent system. Under the new positive grant patent system, only patent applications that fully meet all the patentability requirements can proceed to grant. Under the previous self-assessment patent system, a patent could be granted even if the patent did not fully satisfy the criteria of being novel, inventive and industrially applicable.

1.1.2. Statutes (Miscellaneous Amendments) Act 2014: The Amendment Act effects changes to the Trade Marks Act, Patents Act and Registered Designs Act. The key amendments of the Patents Act relate to the definition of "related national phase application", the set of administrative conditions that must be complied with before patents are granted, and the appointment of IP Adjudicators at the Registry of Trade Marks, Registry of Patents and Registry of Registered Designs.

1.2. Important Case Law

1.2.1. *Genpharm International Inc. v. Lonza Biologics Tuas Pte Ltd.* [(2014) SGIPOS 9]

This case deals with an application to correct the specifications of Patent No. 51905 in the course of revocation proceedings. The statutory provisions dealing with corrections are set out in section 107 of the Patents Act and Rule 91 of the Patents Rules. It clearly endorses the two-step test for assessing corrections, which are as follows: a) it must be apparent on the face of the document that there is an error, and b) the proposed correction must be "immediately evident".

1.3. Practice Note/Update

1.3.1. New option for expert determination for patent disputes: A new option for patent disputes filed at a national IP office has been made which allows disputing parties to submit issues to an expert of their choice to make an assessment, instead of adjudication of all the disputes by Registrar of Patents.

1.3.2. IPOS appointed as ASEAN's first International Authority in Patent Search and Examination

1.3.3. PPH programme between IPOS and Mexican Institute of Industrial Property of the United Mexican States ("IMPI"): This PPH pilot programme allows patent applicants who have first filed a patent application in Singapore and who are looking to file a patent application for the same invention in Mexico, to take advantage of expedited examination at the IMPI and vice versa.

1.3.4. PPH Programme with the German Patent and Trademark Office: It provides an umbrella framework for future cooperative initiatives and work sharing between the two offices.

1.3.5. PPH Programme with Russian Federal Service for Intellectual Property ("Rospatent"): Under the MOU, key areas of cooperation include patent information exchange and the sharing of best practices in IP.

1.3.6. PPH Programme with European Patent Office ("EPO"): It provides for the accelerated treatment of patent applications with effect from January 2015.

1.3.7. Singapore to be part of a Global Patent Prosecution Highway network effective 1 November 2014: It will allow Singapore to share patent search and examination results amongst 17 participating IP offices around the world.

1.3.8. Singapore and China sign Agreement on Patent Data Exchange: It allows the patent examiners in both offices to perform more thorough searches of the prior article. This agreement and the recently implemented patent prosecution highway programme between both countries will help the IPOS improve the quality of the search and examination services. Businesses will also enjoy significant cost savings and shorter waiting time for their patents to be recognised in China.

1.3.9. IPOS signs MOU with Vietnam IP office to enhance cooperation (26 August 2014)

1.3.10 Renewal of Memorandum of Cooperation ("MoC") between the IPOS and the Japan Patent Office (26 August 2014)

2. Design

2.1. Major Changes and Implications

2.1.1. Registered Designs Act has been amended to bring about changes concerning the definition of the International Bureau of the World Intellectual Property Organisation ("WIPO") and prescribed fees.

2.2. Important Case Law

NA.

2.3. Practice Note/Update

There is a possibility to record express trusts and beneficiaries of express trusts on the Designs Register.

3. Trade Mark

3.1. Major Changes and Implications

3.1.1. Trademark Law has been amended to makes changes concerning the definitions of "International Bureau", "International trade mark (Singapore)" and "Madrid Protocol".

3.2. Important Case Law

3.2.1. Court of Appeal

***Staywell Hospitality Group Pty Ltd. v. Starwood Hotels & Resorts Worldwide Inc. & another appeal* [(2013) SGCA 65]**

The Court of Appeal provided clarification/ guidance in relation to the law of trade marks in Singapore:-

(1) Where opposition proceedings are concerned, the Court/Trade Mark Registrar must have regard to the full range of actual and notional uses of the marks (i.e. use in relation to the specification of goods / services as opposed to actual use in the marketplace).

(2) In considering whether a likelihood of confusion exists, it is not relevant to have regard to extraneous factors adopted by the parties to different their marks and goods (i.e. the actual way the mark has been used on the said goods, the trading strategies employed, price differentials and packaging).

(3) In considering whether a likelihood of confusion exists, it would however be permissible to take into account extraneous factors which (i) are intrinsic to the nature of the goods; or (ii) affect the impact that the similarity of marks / goods has on the consumer.

(4) With regards to establishing passing off in Singapore, goodwill would be established if the party is engaged in pre-trading activity which is directed at generating demand for its business and the party evinces an unequivocal intention to enter the Singapore market (which is able to attract custom when the business finally materialises).

3.2.2. Court of Appeal: NA.

High Courts/IP Special Courts/District Courts: High Court

***Guy Neale & Ors. v. Nine Squares Pty Ltd.* [(2013) SGHC 249]**

The Plaintiffs sought to determine whether (a) the registered marks are held on trust for the Plaintiffs; and (b) the registered marks should be invalidated. The Court determined that the Plaintiffs failed to discharge the burden of showing that the Defendant intended to hold the registered marks on trust for the Plaintiffs. The Plaintiffs also failed to establish that there was a constructive trust arising from a breach of fiduciary duties owed to the Plaintiffs' by one of the Defendant's shareholders.

Further, the Court did not invalidate the registered marks for, *inter alia*, the following reasons:

(a) The Plaintiffs failed to show that the registration of the marks was made in bad faith (i.e. the Defendant's behaviour was not shown to fall short of the normally accepted standards of commercial behaviour).

(b) The Plaintiffs were unable to establish goodwill in Singapore at the application date of the marks and could not succeed in proving that the registration of the said marks would be prohibited by the law of passing off.

3.2.3. Court of Appeal: NA.

High Courts/IP Special Courts/District Courts: Court of Registrar

***Lacoste v. Carolina Herrera Ltd.* [(2014) SGIPOS 3]**

The Assistant Registrar determined that the Opponent should not be granted a monopoly over the numerals "212" since it did not hold a registration solely for the numerals "212" and was unable to provide sufficient evidence to show that the average consumer would consider any mark bearing the numerals "212" as belonging to a "family" or "series" of registered marks belonging to the Opponent.

3.2.4. Court of Appeal: NA.

High Courts/IP Special Courts/District Courts: Court of Registrar

***Bacardi & Company Ltd. v. G3 Enterprises Inc.* [(2014) SGIPOS 6]**

Bacardi & Company Limited is the Registered Proprietor of the trade mark for MARTINI in Class 33 for "*Alcoholic beverages (except beer), including wines, spirits and liqueurs*" ("Registered Mark"). The Applicant is the proprietor of the Louis M. Martini winery in the USA and filed an application for the Registered Mark to be revoked/invalidated on the basis that it has become the name of a generic alcoholic drink. The Principal Assistant Registrar determined that the Registered Mark was devoid of distinctive character and descriptive of goods in Class 33 since the word "MARTINI" was, *inter alia*, recognised as the name of a cocktail. However, it also held that the Registered Mark had acquired a distinctive character in relation to "vermouth and sparkling wine" and the Registered Mark was partially invalidated in relation to the rest of the goods in Class 33.

3.2.5. Court of Appeal: NA.

High Courts/IP Special Courts/District Courts: Court of Registrar

***Bacardi & Company Limited v. G3 Enterprises, Inc* [(2014) SGIPOS 6]**

The Applicant applied to register the mark "SEIKI" in Class 9 in relation to, *inter alia*, "television sets and disc players". The Opponent is the owner of various registered marks in Class 9 for "SEIKO". The Principal Assistant Registrar dismissed the opposition on, *inter alia*, the grounds that:

(a) The average consumer of the said goods (i.e. televisions and disc players) would be likely to pay more attention to the goods he is purchasing and be more circumspect in ascertaining the origin of the same.

(b) The Opponent failed to discharge its burden of proof to show that there was dilution in an unfair manner of the distinctive character of its "SEIKO" mark.

3.2.6. Court of Appeal: NA.

High Courts/IP Special Courts/District Courts: Court of Registrar

***Kimanis Food Industries Sdn Bhd v. Rovio Entertainment Ltd.* [(2014) SGIPOS 10]**

The Principal Assistant Registrar determined that the opposition failed for, *inter alia*, the following reasons:

(a) There was no similarity of the marks as Singapore law required a comparison between the Applicant's mark would be *vis-à-vis* each individual trade mark (as opposed to a combination of both).

(b) The Opponent did not plead that the combination of the two separate trade mark registrations was an unregistered earlier trade mark/well-known trade mark in Singapore.

(c) No likelihood of confusion was to arise since the relevant average consumer would exercise a degree of care in selecting the food products it consumes.

3.2.7. Court of Appeal: NA.

High Courts/IP Special Courts/District Courts: Court of Registrar

***Taylors Wines Pty Ltd. v. Taylor, Fladgate & Yeatman Ltd.* [(2014) SGIPOS 11]**

The Assistant Registrar dismissed the opposition on, *inter alia,* the grounds that:-

(a) The Applicant's marks were not similar to the Opponent's registered mark and Opponent's trademark possessed little distinctive character as it was a common surname used by numerous traders in Singapore.

(b) There was no likelihood of confusion and the Opponent also failed to provide sufficient evidence to prove that its mark for "TAYLOR'S" was well known to the public at large in Singapore.

3.2.8. Court of Appeal: NA.

High Courts/IP Special Courts/District Courts: Court of Registrar

***OOO "TVM-TRADE" v. Societe Des Produits Nestle SA* [(2014) SGIPOS 12]**

This case addresses the issue of whether IPOS has the power to strike out a notice of opposition and considered the relevant provisions under UK and Australian law in order to affirm the same.

3.3. Practice Note/Update

IPOS collaborates with Office for Harmonisation in the Internal Market ("OHIM")

The IPOS signed an MOU with the OHIM to collaborate on quality management and training in trade mark examination. This is part of the IPOS' efforts to promote information sharing and IP cooperation, so as to ease Singapore businesses' entry into global markets.

4. Copyright

4.1. Major Changes and Implications

4.1.1. Copyright Law has been amended to introduce new measures aimed at tackling online copyright infringement as well as to introduce provisions to facilitate access to copyrighted works for individuals with reading disabilities. The key changes involve: a) facilitating access to copyrighted work for the disabled, and b) stopping online copyright infringement.

4.2. Important Case Law

4.2.1. Supreme Court: NA.

High Courts/IP Special Courts/District Courts: NA.

***Invenpro (M) Sdn Bhd v. JCS Automation Pte Ltd. & Anr.* [(2014) 2 SLR 1045]**

The Court dismissed the copyright infringement claim and found that there is insufficient proof that the Defendants had sight or access to the Plaintiff's copyright works (drawings, manuals, codes, etc.) and found further that the Defendants' batch scrubber was of independent creation and design. The Plaintiff's claim in respect of indirect copying rested on the basis that the Defendants copied the Plaintiff's 2006 Improved Komag Batch Scrubber (or

its component parts). Even though the batch scrubber as a whole and the component parts (e.g., the bearing housing) were not copyright works, they were said to be derived from and causally linked to the engineering drawings produced by the Plaintiff. Substantial similarity alone was insufficient as the Plaintiff had to go on and demonstrate a causal connection between its copyright documents and the Defendants' infringing article.

4.2.2. Supreme Court: NA.

High Courts/IP Special Courts/District Courts: District Court

***Wong Wan Chin (Huang Wanjun) v. Wang Choong Li (formerly t/a The Feline Bridal)* [(2014) SGDC 249]**

The Plaintiff is a singer and actress based in Hong Kong. The Plaintiff's claim is for copyright infringement arising from the Defendant's use of photographs taken on the occasion of the Plaintiff's wedding. The Court held that the Plaintiff had commissioned the photographs and therefore owned the copyright pursuant to section 30(5) of the Copyright Act.

4.2.3. Supreme Court: NA.

High Courts/IP Special Courts/District Courts: High Court

***Total English Learning Global Pte Ltd. & Anr. v. Kids Counsel Pte Ltd.* [(2013) SGHCR 22]**

The Registrar held that the term "communicate" and the phrase "to communicate the work to the public" are limited to communication via *electronic transmission* of the Copyright Material to the public to an extent that prejudicially affects the plaintiff. Thus, there can be no copyright infringement under sections 26(1)(a)(iv) and 26(1)(b)(iii) of the Copyright Act unless the defendant communicated the copyrighted work of the plaintiff in electronic form.

4.2.4. Supreme Court: NA.

High Courts/IP Special Courts/District Courts: District Court

***Public Prosecutor v. St. Hua Private School Pte Ltd., Song Chunwei* [(2014) SGDC 342]**

The first and second accused were prosecuted and held guilty for copyright offences under section 136(3A) of the Copyright Act (wilful infringement of copyright by reproducing in material form 7 copies of the NX software, and authorizing students attending NX software training courses to reproduce in material form 11 copies of the NX software in its computers) and 201B(4) of the Copyright Act (offences of a body corporate committed with the connivance of a director) respectively.

4.3. Practice Note/Update

NA.

C. Others (Geographical Indications/ Plant Variety/etc.)

1. Anti-counterfeiting

1.1. Important Cases

1.1.1. Supreme Court: NA.

High Courts/IP Special Courts/District Courts: High Court

***Converse Inc. v. Ramesh Ramchandani & Anr.*, [(2014) SGHCR 11]**

While awarding statutory damages under section 31(6) of the Trademark Act for infringement of trademark and passing off after the dealings of the defendant with shoes which were counterfeits of the plaintiff's canvass shoes, the Assistant Registrar took tangible and intangible factors into account when assessing the loss suffered by the Plaintiff. Such

tangible and intangible factors include loss of reputation, damage to the commercial value of the Plaintiff's trade mark and the Plaintiff's loss of potential profits.

1.1.2. Supreme Court: NA.

High Courts/IP Special Courts/District Courts: High Court

***Public Prosecutor v. Koh Peng Kiat & another Appeal*, [(2014) SGHC 174]**

In the absence of comprehensive submissions pertaining to section 49(ii) of the Trade Marks Act, and in light of the finding that a defence under section 49(i) of the Trade Marks Act is made out, the Court stated that it will not consider if the defence under section 49(ii) of the Trade Marks Act was made out.

D. Special Event Organised by Recognised Group

Intellectual Property Financing Scheme: On 8 April 2014, it was announced that S$100 million of funds will be made available for debt financing in the next few years under the IPOS Intellectual Property Financing Scheme ("IPFS"). Under it, eligible Singapore incorporated companies may apply through selected participating financial institutions to use their granted patents as collaterals in loan transactions.

IP101: IP101 is an integrated one-stop services centre which includes Advisory Service, Access to Information, Facilitating IP filing and Multidisciplinary education and training.

IPOS International Pte. Ltd.: The company markets IPOS's products and services to foreign entities and businesses, and engages in activities and collaborative arrangements with strategic partners to support Singapore and/or IPOS.

IP VALUELAB Pte. Ltd.: It was incorporated to promote and develop IP management and strategy, IP commercialisation and monetisation, and IP valuation in Singapore.

Law Society of Singapore, Association of Singapore Patent Agents and Institution of Engineers Singapore Partner IPOS to Develop IP Professionals: IPOS signed three agreements with the said industries respectively to oversee the progression and development of IP professionals and practitioners therein.

IP²SG: IP²SG is an all-new integrated e-services portal, to file patent, trade mark and design applications online.

Notification of Express Trust on IP Registers: With effect from 30 April 2014, it has become possible to record express trusts and beneficiaries of express trusts on the Trade Marks Register, Patents Register and Designs Register. The Trade Marks Act, Patents Act and Registered Designs Act were amended by the Statutes (Miscellaneous Amendments) Act 2014 to effect these changes.

E. International Events Attended on Behalf Of Recognised Group

NA.

F. Future Events Planned by Recognised Group

1. New Geographical Indications Act ("GI Act") To Be Enacted

It aims at providing a registration system for the protection of GIs which would be achieved through the following ways:

(a) Establishment of GI Registry

(b) Implementation of new GI Act

(c) Consequential amendments to the TM Act to be made

The subsequent provisions after the amendments will make it clear that a trade mark cannot be registered if there exists a prior identical or similar GI that has been applied for registration, or is registered in the GI register.

2. Public Consultation on the Review of the Registered Designs Regime in Singapore

The objective of the public consultation was to assist in the crafting of a designs regime relevant to stakeholders who would support and encourage the growth of designs-related industries, and one which is able to deal with the advent of new technologies and business models.

3. Public Consultation on Sound Recording Rights and Enhanced Border Measures relating to Infringing Goods

The consultation covers the following:

(a) Enhancing border enforcement measures

The proposed changes affords rights holders the avenue to lodge notices with Customs authorities to stop both the import and export of suspected IP-infringing goods.

(b) Remuneration for the broadcast, playing or performing of sound recordings in public

Under the proposed changes to the Copyright Act, a new right will be created for producers of commercial sound recordings, to collect royalties from any entity which broadcasts, plays or performs their sound recording to the public.

G. Contributed by

Woon Chooi YEW.

APAA 2014 GROUP REPORT OF SRI LANKA

A. IP Statistics Year 2013

1. Number of applications filed with the Patent Office 2013

Year	Patent/PCT	Utility Model	Design	Trademark	Madrid	GI/Plant Variety
2013	416	NA	233	6183	NA	NA

Of the accumulated pending trademark applications for examination the Director General has examined 20,000 files and 2,600 have been gazetted and 1,500 Certificates have been issued.

B. Legislative Changes and Policy Update

1. Patent

1.1. Major Changes and Implications

There has been no significant change in the laws relating to patents.

1.2. Important Case Law

NA.

1.3. Practice Note/Update

NA.

2. Trademarks

2.1. Major Changes and Implications

There has been no material legislative change in laws relating to trademarks.

2.2. Important Case Law

High Courts/District Courts

2.2.1. *Unilever v. Unilever Lipton Ceylon Ltd.,* and *Unilever PLC Instituted v. J.M.K.B. Jayasundera*

The sole proprietor of the business named and styled “Laji Tea” filed suit for the infringement of their trademark “LAOJEE” and succeeded in obtaining an interim injunction against the Defendant. The case is now proceeding to Trial.

2.1.2. *Arpico Finance Co. Plc. v. Richard Pieris Arpico Finance Ltd.*

Suit filed for the use of the word Arpico as a part of their name. The Arpico trademark is registered in other categories of goods and is a household name owned by the defendants. The Arpico Finance Co., has been in operation for 60 years and Richard Pieris did not object to same. The High Court issued interim injunction against the defendant company against the use of the word Arpico by Richard Pieris Arpico Finance Co. Ltd., and the defendant appealed to the Supreme Court and the Supreme Court affirmed the decision of the High Court.

2.3. Practice Note/Update

NA.

3. Designs

3.1. Major Changes and Implications

There has been no material legislative change in laws relating to designs.

3.2. Important Case Law

NA.

3.3. Practice Note/Update

NA.

4. Copyright

4.1. Major Changes and Implications

There has been no material legislative change in laws relating to copyright.

4.2. Important Case Law

NA.

4.3. Practice Note/Update

The Government is favourably considering the adoption of the Marrakesh Treaty in respect of visually handicapped and Beijing Treaty on Audio Visual Performances.

5. Geographical Indications

5.1. Major Changes and Implications

NA.

5.2. Important Case Law

NA.

5.3. Practice Note/Update

A new draft relating to the better enforcement of the geographical indications has been submitted to the Government for its approval.

C. Special Event Organised by Recognised Group

NA.

D. International Events Attended on Behalf Of Recognised Group

NA.

E. Future Events Planned by Recognised Group

NA.

F. Contributed by

J.M. Swaminathan.

APAA 2014 GROUP REPORT OF TAIWAN

A. IP Statistics Year 2013

1. Number of applications filed with the Patent Office 2013

Year	Patent	PCT	Utility Model	Trademark	Designs	Madrid	Plant Variety
2013	49,218	NA	25,025	74,031	8,968	NA	NA

2. Domestic–Foreign Breakdown 2013

	Patent	Utility Model	Design	Trademark	Plant Variety
Domestic	21,730	23,837	5,147	55,338	NA
Foreign	27,488	1,188	3,821	18,693	

B. Legislative Changes and Policy Update

1. Patent

1.1. Major Changes and Implications

1.1.1. To enhance patent protection, Taiwan Legislative Yuan gave its green light to the partial amendment of Taiwan Patent Act regarding border protection measures in January 2014 and the amended Patent Act (Article 97–1 to 97–4) has been in force since 24 March 2014. Under the new mechanism, a patent holder may make a request with the customs department to detain the suspected Patent – Infringing articles by furnishing a deposit or security when he/she has a suspicion of infringement upon his/her patent right. However, owner of the detained goods may also provide a deposit in an amount twice as much as that paid by the patent holder to have the detention repealed.

1.1.2. The TIPO-JPO Patent Prosecution Highway (PPH) pilot program has been extended for three years beginning on 1 May 2014 and modified to PPH Mottainai. As an enhanced version of the general PPH programs, the PPH Mottainai pilot program allows an applicant to make a request for PPH examination at the office of later examination by submitting the examination results of the office of earlier examination, whether or not such result is issued by the office of first filing as designated in the general PPH program.

1.2. Important Case Law

1.2.1. Supreme Court: NA.

High Courts/IP Special Courts/District Courts: IP Court

2013 Min Zhuan Su Zi No. 29 [Decided on 12 May 2013 by IP Court]

There had been a patent right ownership dispute between Phison Electronics Corp. (hereinafter "Phison") and Puu Jiuh Co., Ltd. (hereinafter "Puu Jiuh"). Puu Jiuh had commissioned Phison to develop the iController product. Phison Electronics Corp. had held and owned the intellectual property right ownership in the product and also had the copyright, trademark right, and patent right resulting from the said project. Somehow, Puu Jiuh could obtain a utility model patent (No. M406889) titled "remote control transmitter attached to portable touch-controlled communication device", which was however a result of the R&D belonging to Phison. The IP Court, in the said case, had granted Phison's demand for patent right transfer and ordered Puu Jiuh to transfer the said patent right to Phison based on the reason that "Phison has a tenable reason and sufficient basis to act upon the contract signed between the two companies to assert non-performance of contractual obligations, infringement, and unjustified enrichment".

1.3. Practice Note/Update

NA.

2. Design

NA.

3. Trade Mark

3.1. Major Changes and Implications

NA.

3.2. Important Case Law

3.2.1. Supreme Court: See below

High Courts/IP Special Courts/District Courts: NA.

2013 Xing Shang Geng (Yi) Zi No. 1 [Decided by IP Court]

The Japanese company, UCC Holdings Co. Ltd. (hereinafter "UCC Holdings") and Taiwan-based Universal Cement Corporation (hereinafter "Universal Cement") had been confronting with each other in the long-drawn-out lawsuit for the ucc trademark. Supreme Administrative Court had delivered its latest judgment in favor of UCC Holdings (by reversing the IP Court's erstwhile Judgment) that the subject mark is likely to dilute the distinctiveness of UCC Holdings' ucc mark, and also ordered Taiwan IPO to revoke the registration of subject mark.

3.3. Practice Note/Update

NA.

4. Copyright

4.1. Major Changes and Implications

4.1.1. Amendment to Article 53, Article 80-2, and Article 87-1: The amendment seeks to facilitate the fair use of and access to the information by people with disabilities and also to overcome the difficulties in producing and obtaining accessible format copies of published works. The goal is to assure opportunities to access the published works regardless of any disability.

4.1.2. Amendment to Article 65 and Article 87: This revision specifically prohibits parallel import of "genuine goods".

4.2. Important Case Law

NA.

4.3. Practice Note/Update

NA.

C. Others (Geographical Indications/ Plant Variety/etc.)

NA.

D. Special Event Organised by Recognised Group

NA.

E. International Events Attended on Behalf of Recognised Group

NA.

F. Future Events Planned by Recognised Group

NA.

G. Contributed by

Justin Wu and Grace W.T. Liao.

APAA 2014 GROUP REPORT OF THAILAND

A. IP Statistics Year 2013

1. Number of applications filed with the Patent Office 2013

Year	Patent	PCT	Utility Model	Trademark	Designs	Madrid	Plant Variety
2013	7,407	NA	1,609	46,097	3,802	NA	NA

2. Domestic–Foreign Breakdown 2013

	Patent	Utility Model	Design	Trademark	Plant Variety
Domestic	929	1,364	2,527	27,881	NA
Foreign	6,478	122	1,275	18,216	

B. Legislative Changes and Policy Update

1. Patent

NA.

2. Design

NA.

3. Trade Mark

3.1. Major Changes and Implications

NA.

3.2. Important Case Law

3.2.1.

High Courts/High Courts [21022/2013] ***Industrial Mineral Development v. Unimin*** [Better Right, Bad Faith]

"Bad Faith" – Civil Action by Industrial Mineral Development Co., Ltd (IMD) against the Board of Trademarks' Decision concerning Trademark CERASIL in international Class 1

The Intellectual Property and International Trade Court (IP&IT Court) considered that the Plaintiff had the better right to the mark CERASIL than the Co-Defendant which was later on reversed

by the Supreme Court on the ground, proved to the satisfaction of the court, that Co-Defendant had already been using the trademark "CERASIL" in various countries worldwide at the time the Plaintiff had started using the "CERASIL" trademark in Thailand. Further, the court had found itself satisfied of the fact that the Plaintiff was aware of or the knower of the Co-Defendant's trademark CERASIL in some manner on the basis of the exhibits produced before it by the co-defendant. Thus, it was concluded that plaintiff had filed for registration of the said trade mark in bad faith.

3.2.2. Supreme Court: See below.

High Courts/IP Special Courts/District Courts: High Courts [6623/2013]

'Distinctiveness" – Civil Action Appealing the Board of Trademarks' Decision Rejecting the Applications for registration for the Mark "CLUB 21" *Private Club v Department of Intellectual Property* [Distinctiveness, Registrability]

Plaintiff's trademark was an invented device, wherein the number "21" was larger than the word "CLUB" and the arrangement of the mark was in a square shape, in which the number "21" was over the word "CLUB". Defendant's trademark being "CLUB 21" was refused to be registered on the ground of similarity. The Supreme Court had revoked the order of the Trademark Registrar. Thus, an inference can be drawn from it that visual/pattern distinctiveness, if any, from the existent letters/words/characters/ numerals or any combination thereof would not amount to trademark infringement.

3.2.3. Supreme Court: NA.

High Courts/IP Special Courts/District Courts: IP Special Courts

"Well-known mark" – Civil Action against Board of Trademarks re Cancellation of the Decision on Registration of VALENTINO Trademark [*Valentino S.p.A. v. Department of Intellectual Property*] [well known mark, Registrability]

The IP&IT Court has rendered its decision in favour of the applicant, Valentino S.p.A., and ordered the DIP to continue the registration process of the "VALENTINO and V Device" for the goods in Class 3. The Court found that the Plaintiff sufficiently proved that the trademark "VALENTINO" of Valentino S.p.A. has been used and advertised in Thailand to the extent that it has become well-known to the public. Therefore, when the public sees the products bearing the trademark "VALENTINO," the public shall be reminded of the Plaintiff, rather than Mr. Rudolph Valentino, the famous actor, as the Registrar had claimed in rejecting the registration. In light of this finding, the decisions of the Trademark Registrar and the Board of Trademarks are to be cancelled, and the Defendant, the DIP, must continue its registration proceedings.

3.2.4. Supreme Court: NA.

High Courts/IP Special Courts/District Courts: High Courts [6938/2012]

"Confusingly similar mark" – Cancellation action against the registrations of ARON & AR logo and ARON marks *Avon Products Inc v. Re-x Products* [cancellation]

The Supreme Court agreed with Avon's appeal that the trademark registrations for  (ARON & AR LOGO) and  (ARON) were not registrable. In its decision, the Supreme Court found that the mark ARON was filed for registration 30 years after the AVON mark and has been used with the same type of goods. The Court was of the opinion that both parties' marks use the same three letters in the same position and the pronunciation sounds similar. The Supreme Court concluded that the trademarks for " for (ARON & AR LOGO) and (ARON) are confusingly similar to the prior registered mark "AVON" to the extent it may cause confusion to the consumer.

3.3. Practice Note/Update

NA.

4. Copyright

NA.

C. Proposed Legislative Changes

1. **Copyright Act:** The first set of amendments relates to copyright offenses, penalties for copyright infringement, and exemptions from copyright infringement for disabled people. The second set consists of a framework to account for technology changes, Rights Management Information, and Technological Protection Measures.
2. **Trademark Act:** The first amendment provides additional mark protection for sounds and smells, allows multiple class applications, and provides for a grace period. The second amendment allows Thailand to become a member of the Madrid Protocol and to implement the Madrid System's procedures and requirements.
3. **Trade Secret Act:** The main amendments relate to the Trade Secrets Board's composition, qualifications, terms of office, causes to vacate the position, methods to conduct meetings, and cancellations of prohibited conditions of being a Trade Secret Board member.

D. Others (Geographical Indications/ Plant Variety/etc.)

NA.

E. Special Event Organised by Recognised Group

NA.

F. International Events Attended on Behalf of Recognised Group

NA.

G. Future Events Planned by Recognised Group

NA.

H. Contributed by

Darani Vachanavuttivong.

APAA 2014 GROUP REPORT OF VIETNAM

A. IP Statistics Year 2013

1. Number of applications filed with the Patent Office 2013

Year	Patent/PCT	Utility Model	Design	Trademark	Madrid	GI
2013	4,169/NA	331	2,129	31,184	NA	4

2. Domestic–Foreign Breakdown 2013

	Patent	Utility Model	Design	Trademark	GI
Domestic	443	227	1366	24656	3
Foreign	3726	104	763	6528	1

B. Legislative Changes and Policy Updates

1. Patents

1.1. Major Legislative Changes

NA.

1.2. Important Case Law

NA.

1.3. Practice Note/Update

IMOST conducted inspections sessions on the alleged infringement of industrial property rights. With respect to patents, almost all infringements fall into the pharmaceutical sector with acts of importing, manufacturing and trading pharmaceuticals, comprising active compounds, which were the same or equivalent to those under protection.

2. Design

NA.

3. Trademark

3.1. Major Legislative Changes

NA.

3.2. Important Case Law

NA.

3.3. Practice Note/Update

IMOST conducted inspections sessions on the alleged infringement of industrial property rights. In the trademark segment, a majority of infringement was related to manufacturing and trading of counterfeits. Besides, IMOST also handled some cases of unfair competition, which were established by the use of commercial indications that are similar to well-known and reputable trademarks.

4. Copyright

4.1. Major Legislative Changes

Decree No. 131/2013/ND-CP dated 16 October 2013 on sanctioning administrative violations of copyright and related right

There has been differentiation of the maximum monetary fine applicable to individual and organisational infringers. In Decree 47, the maximum monetary fine applicable to administrative violations in the field of copyright and related right is VND 500 million (approx. US$ 25,000), regardless whether the infringer is an organization or individual. However, under Decree 131, the said maximum monetary fine is applicable to organisational infringer only, while for individual infringers, the highest fine is a half, i.e. VND 250 million (approx. US$ 12,500). Further the level of monetary fines is no longer subject to value of violating commodities, but based on types of acts of violation. Decree 131 also provides for the copyright and related right agents' failure to report its operations to the competent authorities as an act of administrative violations, and shall be sanctioned. Competence for sanctions against administrative violation in the field of copyright and related right is extended to the People's Committees at provincial levels, and the Police, besides the Inspectorate of Culture, Sports and Tourism as so provided for under Decree 47.

4.2. Important Case Law

NA.

4.3. Practice Note/Update

NA.

5. Others (Geographical Indications/ Plant Variety/etc.)

5.1. Major Legislative Changes

5.1.1. Decree No. 114/2013/ND-CP on Handling of Administrative Violations in the fields of New Plant Varieties and Plant Protection and Quarantine

On 3 October 2013, the Government of Vietnam issued Decree No. 114/2013/ND-CP on handling of administrative violations in the fields of new plant varieties and plant protection and quarantine ("Decree 114"). Decree 114 took effect as of 20 November 2013. Decree 114 replaced Decree No. 26/2003/ND-CP dated 3 June 2003 on handling of administrative violations in the field of plant protection and quarantine and Decree No. 57/2005-ND-CP dated 27 April 2005 on handling of administrative violations in the field of new plant varieties, and its revision in 2007. Noteworthy points under Decree 114 is the statute of limitations of two years for handling administrative violations in the field of new plant variety rights. Further Decree 114 also stipulates that with maximum fine levels to be imposed on organisational infringer are two times higher than those applicable to individuals for the same act of violation. Decree 114 also increases the maximum monetary fine applicable from VND30 million for both individual and organisational infringers to VND 50 million (approx. US$ 2,500) for individual infringers, and VND 100 million (approx. US$ 5,000) in case of organisational infringers.

5.1.2. Others

Apart from the above, there are a number of IP-related legislations in the course of being drafted. The law of the Civil Code 2005 and the Law on Technology Transfer 2006 are on revision. A circular guiding the implementation of secret patents in Decree No. 103/2006/ND-CP and its revision in 2010, the evaluation of intellectual property assets belonging to the State and on administration, exploitation of industrial property subject matters, of which creation is financed by the State is being drafted. Further, a circular on revision of Circular No. 22/2009/TT-BTC on industrial property fees and charges is also being drafted.

5.2. Important Case Law

NA.

5.3. Practice Note/Update

NA.

6. General IP

6.1. Major Legislative Changes

Decree 99/2013/ND-CP dated 29 August 2013 on sanctions against administrative violations in the intellectual property field

Similar to Decree 131, under Decree 99, the maximum monetary fine applicable to organisational infringer is VND500 million (approx. US$ 25,000), while for individual infringers, the highest fine is VND250 million (approx. US$ 12,500).

Under Decree 99, all administrative enforcement authorities, including Inspectorate of Science and Technology, Inspectorate of Information and Communications, Market Control Forces, Customs authorities, Police, and provincial and communal People's Committees, can, subject to severity of the infringement, impose sanctions at the aforesaid maximum monetary fine.

Further, regarding enforcement against acts of unfair competition, Decree 99 explicitly empowers Inspectorate of Science and Technology, Inspectorate of Information and Communications, Market Control Forces, Customs authorities, Police, and provincial and communal People's Committees for such enforcement. The Competition Management Bureau under Ministry of Trade and Industry is no longer competent for the mentioned action. Regarding the additional sanction of suspension of business license, Decree 99 explicitly prescribes for a period of 1–3 months for such a suspension.

In case of a sanction requiring a removal of infringing elements from a domain name or trade name, the holders of such a domain name or trade name shall make such a removal within 30–60 days.

6.2. Important Case Law

NA.

6.3. Practice Note /Update

6.3.1. Handling infringement of industrial property rights in Vietnam

During the first six months of 2014, the Inspectorate of the Ministry of Science and Technology ("IMOST") in coordination with relevant authorities conducted 35 inspections sessions on the alleged infringement of industrial property rights, out of which 25 were related to trade marks and 10 related to patents. IMOST proceeded with administrative sanctions against the infringers found by these inspections. Total monetary fines reach over VND1 billion (approx. US$50,000) to date.

6.3.2. Handling pending IP applications at the NOIP

In the practice before the NOIP, the number of applications for inventions, industrial designs and trademarks filed with the NOIP continued to increase considerably each year during the period from 2009 to 2013. However, the speed of handling the pending applications, despite some improvements, still does not meet the demands of practice.

C. Special Event Organised by Recognised Group

NA.

D. International Events Attended on Behalf of Recognised Group

NA.

E. Future Events Planned by Recognised Group

NA.

F. Contributed by

Pham Nghiem Xuan Bac.

APAA 2014 TRADEMARK COMMITTEE REPORT – AUSTRALIA

1. Australian Trademark Office Statistics 2013–2014

No. of Applications Filed	Approximately 60,000
No. of Applications Registered	Approximately 12,500

2. Changes to Australian Legislation

NA.

3. Practice Changes

3.1 Filling of Documents: All documents (including the lodging of applications, responses to official actions and official forms) are to be filed electronically using IP Australia's eServices or B2B system or by the Alternative Lodgment Service when eServices and B2B are unavailable due to maintenance.

3.2 Objective Connect: Electronic document management system also to be used for lodgment of evidences (including both audio and video) and other correspondence in opposition and non-use matters.

3.3 Fees: Although non-electronic fee payment mechanisms are available, customers are encouraged to lodge official fee electronically.

3.4 Publishing of New Trademark Applications: New Trademark applications are now published on the same day or within one business day of filing owing to the electronic documentation.

3.5 Declaration: No longer do the declarations, used in support of a pre-acceptance distinctiveness submission or in opposition/non-use proceedings, need to be sworn or otherwise witnessed/notarised.

4. Some Significant Court and Trademark Office Decisions

4.1 *Cantarella Bros Pty Ltd. v. Modena Trading Pty Ltd.* [(2014) HCA 48] (trade-mark infringement, validity)

Cantarella claimed that Modena had infringed its trademarks on the terms "Cinque Stelle" and "Oro" (meaning, "five stars" and "gold" respectively in Italian). The High Court of Australia is being asked to consider and clarify the criteria for assessing the registration of foreign words as trademarks, including those whose translation into English has a laudatory or descriptive connotation.

4.2 *Phone Directories Company Australia Pty Ltd. v. Telstra Corporation Ltd.* [(2014) FCA 373] (registrability, misleading and deceptive conduct/unfair competition)

The Federal Court in this case found that the mark YELLOW had no inherent capacity to distinguish Telstra's telephone directory related goods and services from those of other traders and thus could not be registered as a trade mark.

4.3 *Kosciuszko Thredbo Pty Ltd. v. ThredboNet Marketing Pty Ltd.* [(2013) FCA 563] (misleading and deceptive conduct/unfair competition)

This case concerns a dispute about the alleged unauthorised use of the term 'Thredbo' (a well-known ski area in Australia) as part of a domain name. In this case it was found that a word having a geographical connotation has taken on a secondary meaning to such an extent that its use has the capacity to be controlled.

4.4 *Mastronardi Produce Ltd. v. Registrar of Trade Marks* [(2014) FCA 1021] (registrability)

The case concerns an appeal to the Federal Court from a decision of the Registrar to refuse registration of the invented word "Zima" in relation to tomatoes. The contention here was whether the trademark ZIMA could distinguish the goods of Mastronardi from those of other traders, or whether it functions as the name of a variety, or generic type, of tomato. The court in this case focused on two questions:

– How would the word "Zima" be understood by ordinary Australians?

– How likely it is that other traders will think of the word "Zima" and not be improperly motivated to use it on golden-grape tomatoes in a manner that would otherwise infringe a registration for that word?

The court in this case found that the Applicant established that the use of the mark in itself did not source its tomatoes only from a single variety, and further that other traders had a range of other terms available to them to describe their orange-grape tomatoes. Thus 'Zima' could be used in Australia in regards to a trade mark.

4.5 *Bugatti GmbH v. Shine Forever Men Pty Ltd.* [(2013) FCA 1116] (trade-mark infringement and opposition to registration)

The applicant in this case is a registered owner of the trade mark for the word BUGATTI in several classes including in relation to clothing. The Respondent imported and sold clothing and accessories by reference to the trademarks BUGATCHI and BUGATCHI UOMO. The issue here regards to the deceptive similarity of the Respondent's mark with that of Applicant's registered mark. The Respondent was also found to be importing and selling goods in Australia under the mark BUGATCHI UOMO, thus corresponding to the use the words as a trade mark. The trial Judge found the marks to be deceptively similar leading to confusion of that the products bearing the mark represent the same source.

4.6 *Ironman 4x4 Pty Ltd. v. Australian Performance Development Pty Ltd.* [(2013) ATMO 107] (opposition to registration of a non-traditional mark)

This case concerns an opposition to the registration of the words SAFARI SNORKEL in combination with the three-dimensional shape of an air ram of an air intake snorkel in respect of air rams and air intake snorkels for vehicles. The respondent argued that the mark was indistinguishable and did not indicate the trade source of the goods. However, the Hearing Officer found the composite mark to be inherently capable of distinguishing the Applicant's goods, when taken as a whole. The combination of both the word and the device element amounted to distinctiveness of the Respondent's marks from that of the Applicant.

4.7 *Southcorp Brands Pty Ltd. v. CNA Industries Pty Ltd.* [(2014) ATMO 27] (opposition to registration)

This case concerned an opposition to registration of a trade mark containing the words "707 estate" for import-export agency services in Class 35 in view of the Opponent's prior registration of and reputation in the trade mark "BIN 707" in respect of wines. The Hearing Officer found the marks "707 estate" and "BIN 707" to be deceptively similar. It was further found that though the registration had been filed in respect for both wine labels and import-export agency services, the applicant had no intention of using it for import-export agency services.

4.8 *Lift Shop Pty Ltd. v. Easy Living Home Elevators Pty Ltd.* [(2014) FCAFC 75] (trade mark infringement, use of a trade mark)

This case was concerned with whether use of a competitor's trade mark as a keyword in search engine optimisation methods (SEO) would constitute infringement of that trade mark. The dispute in this case arose by Easy Living's designation of the words "lift shop" as a Google AdWord was used in online searches, its incorporation of the words "lift shop" in the title of its website and its inclusion of the words in the content of its home page. As a result of this, when "lift shop" was used in an Internet search, the website titles and URLs of Lift Shop and Easy Living were displayed in close proximity to each other. The case was heard by Full Federal Court, which based its decision largely on whether use of the trade mark amounts to use "as a trade mark" within the meaning of the Trade Marks Act 1995. The Full Court found that it did not amount to use "as a trade mark" and therefore did not constitute to infringement.

5. Contributed by

Saskia Jahn, Jennifer McEwan and Andrew Butler.

APAA 2014 TRADEMARK COMMITTEE REPORT – BANGLADESH

1. Trademarks Statistics Year 2013

No. of Applications Filed	11581
No. of Registration Certificates Issued	3021

2. Changes to Bangladesh's Legislation

2.1 Passing of the GI Act: The Geographical Indication (GI) Act 2013 was passed in the Parliament and the same has been effective from 10 November 2013.

2.2 Enactment of the Trademarks Act: The Trade Marks Act 2009 was enacted by repealing The Trade Marks Act 1940 which came into force on 1 July 2008. The said Act was duly amended in respect of opposition relating activities for registration shall be concluded within 360 working days (instead of 120 working days which was fixed earlier).

2.3 Key Procedural changes: The Trade Mark Rules in accordance with the Trade Marks Act 2009 is being prepared and the same is under consideration by the Ministry of Industries.

3. Practice Changes

3.1 GI Unit Establishment: A new wing in the name GI Unit (Geographical Indication Unit) has been established in the Department of Patents, Designs and Trade Marks who will register Geographically Indicative Marks.

4. Some Significant Court and Trademark Office Decisions

4.1 Injunction Suit: District Court

Learned District Court passed an order for injunction in a suit filed against Aristopharma, Bangladesh, relating to the trade mark CONTINE by Mundipharma AG, Switzerland on the basis of registered trade mark UNICONTIN & CONTIN. The said order is being stayed upon filing an Appeal in the Honorable High Court. However, the main suit will be proceeded further after disposal of appeal.

4.2 Opposition: Trademark Tribunal

Opposition against registration of trade mark HAVELLS FANS under no.120896 in class 11 was filed by QRG Enterprise Ltd., India on the basis of trade mark HAVELLS H Logo. The Trade Marks Tribunal allowed the opposition and refused registration of HAVELLS FAN on the ground of *mala fide* adoption as well as falls claiming to be a proprietor.

4.3 Opposition: Deputy Registrar

Trade mark GOLD COW & device under application no. 80144 in class 32 in the name of Chim Khime Lee Food Industries Pte Ltd., Singapore was published in *Journal No. 250* which was opposed by RED BULL AG of Switzerland by their registered trade

mark RED BULL. Upon hearing the case, the Deputy Registrar passed an order rejecting the opposition and allowing the application no. 80144 in class 32 for RED COW to proceed for registration.

4.4 Opposition: Trademark Registrar

Opposition against registration of trade mark TIPPER under application no. 76358 in class 34 in the name of Godfrey Phillips India Limited, India was filed by Flamagas S.A. of Spain on the basis of their registered trade mark CLIPIER. Upon completion of all formalities and hearing the case the Registrar passed an order allowing the application no. 76358 for TIPPER to proceed for registration by rejecting the opposition.

APAA 2014 TRADEMARK COMMITTEE REPORT – HONG KONG

1. Hong Kong Trademark Statistics Year 2013

No. of Trademark Applications Filed	39643
No. of Trademark Applications Registered	33721

2. Changes to Hong Kong's Legislations

NA.

3. Practice Changes

NA.

4. Some Significant Court and Trademark Office Decisions

4.1 *Shenzhen De Li Kang Electronics Technology Company Ltd. v. Joo-sik-Hoi-Sa LG (LG Corporation) & Anr.* [(2014) HKCFI 558]

In July 2008, the respondents ("LG") applied to the Registrar of the Trade Mark for a declaration of invalidity of the Suit Mark on various grounds including the registration of the Suit Mark being made in bad faith. In January 2013, the Registrar, after considering all the evidence, concluded that the application for registration of the Suit Mark was made in bad faith and subsequently revoked the registration. The court was of the view that the use of the Suit Mark is likely to cause confusion on the part of the public. In addition, the court ruled that LG's earlier trademarks qualified to be regarded as well-known marks in Hong Kong. The use of the Suit Mark would take unfair advantage of the distinctive character or repute of those earlier marks, hence the Suit Mark should be declared invalid.

4.2 *ABC Juicy Couture, LLC v. Bella International Ltd. t/a Juicy Girl & Ors.* [(2014) HKCFI 1623]

The action was initially instituted by a Californian corporation Juicy Couture Inc. ("JCI") against for infringement of its registered trademarks and passing-off. JCI later assigned its rights in this action to the Plaintiff. The first and fourth Defendants are companies incorporated in Hong Kong (collectively known as "BELLA") that are owned and operated by the second and third Defendants. The Plaintiff claims that the defendants in selling their ladies fashion wear and accessories under or in the brand name of "JUICY GIRL" have infringed the Plaintiff's trademarks and passed off their retail business and goods. The court held that since the Defendants had marketed garments in Hong Kong by retail under the Juicy Girl brand from 1998, to the extent that the Defendants' use of the Juicy Girl mark might have infringed the Plaintiff's registered trademarks, they can rely on the earlier use as their defence. Though the Defendants were entitled to use the Juicy Girl mark, they were not entitled to use the mark "Juicy" as that was one of the Plaintiff's

registered marks. The court concluded that the defendants have infringed the Plaintiff's registered trademarks in depicting the word "JUICY" in stylised script.

4.3 *Power Dekor (Hong Kong) Ltd. v. Power Dekor Group Co. Ltd.* [(2014) HKCFI 18]

This case concerns the creation and use of shadow companies. The plaintiff company is an established company in Hong Kong in the business of trading in building and decoration materials. Its major shareholder is Power Dekor Group Company Limited which is a company incorporated in the People's Republic of China ("PRC") and the registered proprietor of various trade marks in the PRC and elsewhere. The defendant company was incorporated in Hong Kong with a name very similar to the plaintiff company, but is not active in Hong Kong. It is believed that the defendant company will be used in the PRC to pass off as the plaintiff company and infringe its trade marks. Hence, the suit was filed. The court directed the Registrar of Companies to change the name of the defendant company. In addition, the Court commented that the existing law does not go far enough and that the Registrar of Companies should be empowered to refuse registration of a company name or to deregister a company with a name that is the "same as or too like" another.

4.4 Kabushiki Kaisha Yakult Honsha (Yakult Honsha Co. Ltd.): Applicant's "Bottle Device" was held not registrable under class 29.

4.5 Daiichi Sankyo Kabushiki Kaisha (Daiichi Sankyo Co. Ltd.): Applicant's mark "Passion for Innovation and Compassion for Patients" was held not registrable under classes 5 and 44.

4.6 Jusikhoisa Geo Medical (GEO Medical Co. Ltd.): Applicant's mark "GEOmedical" under class 9 was held similar to the goods and services protected by the cited marks "GEO". The court was of the opinion that, an average consumer would be confused into believing that the goods provided under the Subject Mark and the goods or services provided under each of the cited marks come from the same undertaking or economically-linked undertakings.

4.7 Dr. August Oetker Nahrungsmittel KG: Applicant's mark "Pizza Box Dr Oetker" under class 30 was held similar to the cited mark "Pizza Box" leading to confusion by an average consumer.

4.8 Registered Owner: Hong Kong Tai Fook Jewellery Ltd.; Applicant: Tai Fook Jewellery Group Ltd.

The Applicant filed an application for a declaration of invalidity of the registration of the trademark  registered under class 14 and 35 and succeeded on the grounds that the Subject Mark shall be precluded from being registered by virtue of the law of passing off based its claim on the applicant's mark 

4.9 Registered Owner: PAL Group Ltd.; Applicant: Lo Chih-Hsiang

The Applicant filed an application for a declaration of invalidity of the registration of the Subject Mark . The Registrar found in favour of the Applicant and held that the application was made in bad faith and its act of registration of the Subject Mark must have been tainted with the motive to free ride on the reputation associated with the Applicant's mark  and to derive economic benefits for itself.

4.10 Trademark Opposition

The Applicant "5 PRE VIEW W AB" sought to register the mark "5 PRE VIE W" in respect of "clothing" in class 25 ("the Subject Mark"). The Opponent is Peek & Cloppenburg Kg which is a fashion retailed founded in 1901. The Opponent has operated more than 60 retail stores across Europe. The Opponent has a registered trademark in Hong Kong "REVIEW" ("the Cited Mark") which was registered in December 1989

under Trade Mark No. 19911498AA in respect of certain goods in classes 18 and 25 which include, *inter alia*, articles of clothing. The Opposition failed because the Registrar did not consider the Subject Mark to be confusingly similar to the Opponent's mark.

4.11 Applicant: Gemology Headquarters International, LLC; Opponent: Gemological Institute of America Inc.

The Registrar found in favour of the Opponent and concluded that the risk that the consumer would mistake "GHI" for "GIA" is very high, hence, there is a likelihood of confusion.

4.12 Applicant: Munchy Food Industries SDN. BHD.; Opponent: Toyota Jidosha Kabushiki Kaisha (Toyota Motor Corporation) under class 30

The Opposition failed and the Registrar held that the public will regard an automaker and a food producer as entirely different business and do not usually associate one with the other. Therefore, the public will not be confused or misled into believing that the food items supplied by the Applicant are those of the Opponent.

4.13 Applicant: Kamal Khanbabaei General Trading Co., LLC; Opponent: Red Bull AG, under class 32

The Registrar held that although the word "BULZAI" in each of the Subject Marks has no meaning, it starts with the combination of letters "BUL" which is pronounced in the same way as "bull". Coupled with the device of a bull in an oval, the concept of "bull" is reinforced. There was therefore a high degree of conceptual similarity between the Subject Marks and the Opponent's Marks. The use of the Subject Marks on the Subject Goods would no doubt bring to the minds of the relevant public the Opponent's energy drink products sold under the Opponent's Marks, attracting customers to the Subject Goods. As such, the Applicant's decision to apply for registration of the Subject Marks was made in bad faith.

4.14 Applicant: Lam & Cerveira Ltd.; Opponent: MHCS, under class 33

The Registrar held in favour of the Opponent and considered that the Subject Mark is similar to the Opponent's Mark.

4.15 Applicant: Sjovik Ltd.; Opponent: Cofinluxe, under class 25

The Registrar held that the opposition failed because the Registrar considered that the Subject Mark and the Opponent's Mark would be read by the average consumer as a whole and when viewing the marks as wholes, the degree of similarity between the two marks is no more than moderate.

4.16 Applicant: Sino Link Far East Ltd.; Opponent: IIC-Intersport International Corporation GmbH, under class 25

The Registrar found in favour of the Applicant. Specifically, the Registrar considered that although the Subject Mark and the Opponent's Mark are both six-letter words starting with the letter "S" and contain "a", "f", "i" and "n" in the same order which may contribute a certain degree of visual similarity, the overall visual impression created by the Subject Mark is very different from that created by the Opponent's Mark. In relation to the aural and conceptual aspects of the marks, the Registrar considered they are only similar to a low degree.

4.17 Applicant: 3 Suisses International; Opponent: Swiss Federal Institute of Intellectual Property, under classes 14, 16, 18, 25, 35 & 38

The Opposition failed because there was no evidence to show that the mark could not be registered or that the application has been

made in bad faith or was aimed to deceive the pub.

4.18 Applicant: 3 Suisses International; Opponent: Swiss Federal Institute of Intellectual Property, under classes 14, 16, 18, 25, 35 & 38

The Registrar held that the opposition was not made out.

4.19 Applicant: New Yorker S.H.K. Jeans GmbH & Co. Kg; Opponent: Kabushiki Kaisha Daidoh (Daidoh Ltd.) under classes 25 and 35

The Opposition failed because the Registrar was of the opinion that when viewed as a whole, the marks were distinguishable.

5. Contributed by

Peggy Cheung.

APAA 2014 TRADEMARK COMMITTE REPORT – INDIA

1. Indian Trademark Office Statistics Year 2013

No. of Applications Filed	1,94,216
Indian Applicant Fillings v. Foreign Applicant Fillings	1,79,436
No. of Applications Examined	2,02,365
No. of Trade Marks Published in the Journal	74,871
No. of Trade Marks Registered	44,361

2. Changes to Indian Legislations

2.1 *Dynamic Trademark Utility* has been launched by CGPDTM, allowing the public to see on real time basis the details of Examination of trade mark applications, show cause hearings, publications in the trade marks journal, registrations of trademarks, otherwise disposal of applications done and other notices issued month/date wise.

2.2 Classification of goods and services under section 8(1) of Trade Marks Act, 1999, has been published.

2.3 CGPDTM published *"Guidelines for functioning under the Madrid Protocol"*.

2.4 Public Notice with respect to auto-emailing of QR Coded correspondences such as Cash Book Receipt, O-3 Notices and Renewal Intimations of Trade Marks, has been issued.

2.5 Online services including e-facility for filing forms of renewal, opposition, corrections, duplicate registration certificate, legal certificates etc. has also been launched by CGPDTM.

2.6 Public Notice regarding release of all TM Forms through comprehensive e-filing of Trade Marks has been issued by CGPDTM.

2.7 CGPDTM launched a Stock and Flow based Dynamic Trademark Utility which will provide the applicants/stakeholders with the facility to view the Trade Marks under different stocks and the flow of the trade mark applications among the various stocks.

2.8 Certain provisions in the Trademark Rules, 2002, have been amended by the government. As a result of the amendment, the basic trademark application fees in per class has been increased from Rs. 3,500 to Rs. 4000 and the fees for expedited examination of trademark has been increased from Rs. 12,500 to Rs. 20,000.

3. Practice Changes

3.1 The replies to examination reports and office actions along with the supporting document can be uploaded online through the *comprehensive e-filing services of trademark.*

4. Some Specific Court and Trademark Office Decisions

4.1 *Living Media India Ltd. & Anr. v. Alpha Dealcom Pvt. Ltd. & Ors.* [2014 (58) PTC 589 (Del) : 208 (2014) DLT 145]

In this case, the suit had been filed against the launch of news channel NATION TODAY, by the India Today Group (the Plaintiff). The Delhi HC in this case laid down the principle that "*an entity cannot monopolise use of a word for a business of which the said word is so descriptive*" and thus considered the word TODAY in this the present case to be an adoptive word, descriptive of the business of news and current affairs and thus not liable to be monopolised by any one entity.

4.2 *Jones Investment Inc. Co. v. Nagarajan Srinivasan* [MIPR 2014 (1) 377]

In this case the Intellectual Property Appellate Board held that a multinational company cannot claim infringement of trademark by a local Indian company purely based on international presence, unless they can expressly establish that their presence extends to India or precedes that of the Indian company.

4.3 *Sonu Nigam v. Amrik Singh (alias Mika Singh) & Anr.* [Suit No. 372/2013 decided on 26 April 2014]

The Bombay HC in this case recognised the personality rights of music composers and singers from Bollywood industry. The issue arose when Mika Singh, in order to promote himself displayed hoardings and posters, which were different from official hoardings and poster of Mirchi Awards, 2013, carrying huge picture of himself along with smaller pictures of other artists, including but not limited to, Sonu Nigam without their consent and permission. The Court vide its Order restrained the Defendants from displaying the pictures of the Plaintiff without consent and ordered the Defendant to pay INR 10 Lakhs as damages towards specified charities, as consented by the parties.

4.4 *GM Modular Pvt. Ltd. v. Havells India Ltd.* [2014 (59) PTC 628 (Del) : MIPR 2014 (2) 229]

The Delhi HC in this case, ordered the Defendant to refrain from telecasting, displaying and broadcasting its advertisement which was held to be deliberate and aimed at reducing the sales of the Plaintiff, while upholding the principle "*though a competitor can claim that its products are the best in the world but he cannot say that his products are good and that of his competitors' are bad*".

4.5 *Procter & Gamble Manufacturing Co. Ltd. v. Anchor Health & Beauty Care Pvt. Ltd*. [MIPR 2014 (2) 250 : 2014 (59) PTC 421 (Del)]

In the present case, the defendant themselves had applied for registration for trademark protection of "ALLROUNDER" and "ALL-AROUND PROTECTION" in the USA. The Court applied the legal principle of *approbate and reprobate* and held that defendant therefore cannot claim that the plaintiff's mark "ALLROUND" is descriptive. The court held that the tagline ALLROUND PROTECTION is not generally descriptive of toothpaste and further explained that taglines/ slogans are valid trademarks as they serve the purpose of trademark by enabling consumers to identify the goods and services provided by one from those provided by another.

4.6 *M/S Allied Blenders & Distillers Pvt. Ltd. v. Shree Nath Heritage Liquor Pvt. Ltd.* [2014 (59) PTC 42 (Del) : 211 (2014) DLT 346]

The case involved a dispute between the Plaintiff's trademark "Officer's Choice" and the Defendant's trademark "Collector's Choice". In the said case, the Court observed that the test of similarity/dissimilarity is to be applied

in the light of the product/goods or services in consideration and may be different for different category of products, goods or services, depending not only upon the nature and character of the product, its use by consumers but also the trade channels. The court further held that *prima facie* the customers are likely to mix "Officer" with "Collector" and thus there is a possibility of Plaintiff's trademark being confused with that of Defendant's.

4.7 *Techlegal Solutions Pvt. Ltd. v. Genelia Ritiesh Deshmukh* [2014 (59) PTC 10 (Bom) : 2014 (4) BomCR 822]

The dispute in the said case involved Marathi term ***Lai Bhaaari*** over which the Plaintiff claimed monopoly despite the fact that the term was not coined by it but is a very well-known, old, colloquial established Marathi phrase. The Court laid down the principle that "*the mandate of intellectual property rights should not unnecessarily extend to cover all uses of common/ colloquial phrases in use in India*".

4.8 *People Interactive (I) Pvt. Ltd. v. Gaurav Jerry* [MIPR 2014 (3) 101]

The dispute in the said case revolved around plaintiff's domain name *shaadi.com* and defendants' domain name *shaadihishaadi.com*. The Court while ruling in favour of the Plaintiff explained the term *meta-tagging* and observed *meta-tags are a special type of tag. They do not affect page display. Instead, they provide additional information: the author of the webpage, the frequency of updation, a general description of the contents, keywords, copyright notices and so on. They provide structured data (actually, meta-data) about the web page in question.*

4.9 *Precious Jewels v. Varun Gems* [(2015) 1 SCC 160 : 2014 (9) SCALE 146]

The SC in this case allows *bona fide* use of one's own family's name. The Apex Court in the said case held that *section 35 is a saving clause which provides that nothing in this Act shall entitle the proprietor or a registered user of a registered mark to interfere with any bona fide use by a person of his own name, address or description of goods or services*.

4.10 *Emcure Pharmaceuticals Ltd. v Corona Remedies Pvt. Ltd*. [2014 (60) PTC 332 (Bom) : 2015 (1) BomCR 197]

The Court while ruling in the case elaborated upon section 33 under which *the proprietor of an earlier trademark cannot contest the validity of registration of a subsequent trademark, if he has acquiesced in the use of the subsequent trademark for a continuous period of five years.* However, the Bombay HC in the present case ruled that mere delay would not defeat the rights of the registered proprietor and observed that the *essential to the doctrine of acquiescence is that it is accompanied by encouragement or inducement and that silence is not equivalent to acquiescence under section 33.*

In July 2014, CGPDTM made the following observation – *substantial amendment in the trademark, proprietor details, specification of goods/services (except deletion of some of the existing items), statement as to the use of mark shall not be permitted, however, request for amendment in the proprietorship of the trademark on the basis of valid assignment or transmission; amendment in address of the applicant or in the applicant's address for service; deletion or confinement of any item in the specification of goods/services, – confinement/limitation in the area of sale of goods/rendering of service may be allowed.*

APAA 2014 TRADEMARK COMMITTEE REPORT – INDONESIA

1. Indonesian Trademarks Statistics Year 2012

Number of Applications	62,455

2. Changes to Indonesian Legislation

New Government Regulation regarding Types and Tariffs of Non-Taxable State Income Applicable in Ministry of Justice and Human Rights (Directorate General of Intellectual Property of Rights) No. 45 year 2014 replacing the previous Government Regulation No. 38 year 2009 regarding the same subject, has stipulated as of 3 July 2014.

3. Practice changes

NA.

4. Some Significant Court and Trademark Office Decisions

4.1 *Yamato Sewing Machine Mfg. Co. Ltd. v. Ronny Wijaya* [Commercial Court]

The case deals with cancellation action against trademark *YAMADA v YAMATO* in similar Class of goods on grounds of well-known mark, similarity in essence, and bad faith.

The Commercial Court upheld the decision that all Indonesian legal entity who produce the goods or services are obligated to use trademark that clearly shows the national identity and as far as possible avoid using the trademarks like plagiarising especially with foreign trademarks. That the registration of a trademark which has similarities to other people's mark as the first user is an act of bad faith for the purpose to thae advantage on the notoriety of trademarks/trade names that already well-known.

4.2 *Toyota Jidosha Kabushiki Kaisa v. Hasan Haikal* [Commercial Court]

The case deals with cancellation action against trademark BRAND LEXUS vs LEXUS in different class of goods on grounds of well-known mark, similarity in essence and bad faith.

The Commercial Court served the decision which was in favor of the Plaintiff with the consideration that the LEXUS mark is well-known and the intention to register the mark BARND LEXUS was on bad faith with the purpose to make confusion amongst the public as well as to take an advantage from the notoriety of the LEXUS mark.

As stated in the Indonesian Trademark Law No. 15 of 2001 article 6 paragraph (2) the application of a trademark shall be rejected if it is similar with a well-known mark which are not in similar class of goods/services.

APAA 2014 TRADEMARK COMMITTEE REPORT – JAPAN

1. Japan Trademark Office Statistics 2013

No. of Trademark Applications Filed	117,674
No. of First Office Actions Issued	121,254
No. of Registrations Granted	106,885

2. Changes to Japan's Legislations

2.1 Additional Type of Protectable Trademarks: The revised act amends the definition of trademark to allow registration of sounds and colours as well as motion, hologram and position marks that were previously not permitted. The amendment thus enabled registration of such types of trademarks in Japan for protection through the Madrid Protocol system.

2.2 Increased Eligibility for "Regional Collective Trademarks": The revised act allows organisations such as commerce and industry associations, chambers of commerce and industry and NPOs, including those incorporated outside of Japan, to apply for protection of regional collective trademarks.

2.3 Exceptional Protection of Trademarks Similar to Marks Indicating International Organisations: In accordance with obligations under the Paris Convention, the Japan Trademark Act includes stipulations preventing third parties from registering marks indicating the United Nations or other recognised international organisations. However, actual practice allows for marks which are not confused with the marks of those organisations to be registered. The revised act clearly states that such exceptions are acceptable.

3. Practice Changes

NA.

4. Some Significant Court and Trademark Office Decisions

4.1 *LADY GAGA Case* [HEI 25 (Gyo-Ke) 10158, Supreme Court]

The case relates to distinctiveness of trademarks comprising of names of famous artists such as "Lady Gaga". The applicant, Ate My Heart Inc., is a company owned and controlled by the famous recording artist, Lady Gaga. They filed an application for the registration of a trademark comprised of the characters "LADY GAGA" under Class 9, which was rejected for registration. An appeal for the same was filed in JPO Appeal Board and consequently the IP High Court, which upheld the decision of rejection on grounds of lack of distinctiveness. An appeal was thus filed in the Supreme Court over the following issues:

– Whether "LADY GAGA" indicates the "source or origin" of the goods or the "quality" (content) of the goods? and

– Whether the "LADY GAGA" trademark should be rejected due to its lack of distinctiveness because it merely indicates the quality (content) of the goods?

However, the SC refused leave to hear the appeal leading to finalisation of IP High court decision which found that 'LADY GAGA' is not distinctive for the goods in Class 9.

4.2 *STELLA v. STELLA* [H25 (Gyo-Ke) 10251, IP High Court]

The court in this case looked into the following two issues:

- Whether the two marks are similar?
- Whether the subject mark is likely to cause confusion in connection with the goods pertaining to a business of the plaintiff or a person who has a relationship therewith?

Based on the difference in the phonetics, appearance and conception of the two marks, the court ruled that the marks were not similar and would not thus lead to any possibility of likelihood of confusion if they were to be used on the designated goods.

4.3 *LOGO v. Meiji* [HEI 25 (Gyo-Ke) 10127, IP High Court]

This case regards to the confusing similarity of one mark to the four previously registered marks on bases of their pronunciation. The IP high Court decided that the subject trademark is not confusingly similar to any of the four registered trademarks on the following grounds:

- The applied mark does not give rise to the pronunciation of "meiji".
- The applied mark gives rise to the pronunciation of "eiji", not "meiji".
- The applied mark comprises a device representing two ovals so as to look like a heart.
- Even though the registrant calls the subject trademark as "meiji", the sound should be determined in light of the view of the consumers and traders.

4.4 *Hérmes International v. DHS Corp*. [HEI 25 (Wa) 31446, Tokyo District Court]

In finding similarity between the 3D trademarks, the court stated as follows:

- The most characteristic part of the 3D mark viewed from a certain direction(s) should be compared with a 2D element of another 3D mark (TAKO Principle, Heisei 12 (Gyo-Ke) 234);
- Where there are two characteristic parts or more and any of them is close, the marks are generally considered similar; and
- The other parts do not form significant elements to be considered.

The court found the two marks to be deceptively similar amounting to trademark infringement on part of the defendant and also held that the use of the 3D mark led to likelihood of confusion also affirmed under Unfair Competition Act thus defendants were liable to pay damages.

5. Contributed by

Kazuhiro Nakata, Kozo Takeuchi, Daisaku Fujikura, Emi Ashihara, Sayaka Matsushima and Shunji Sato.

APAA 2014 TRADEMARK COMMITTEE REPORT – KOREA

1. Korea Trademark Office Statistics Year 2013

NA.

2. Changes to Korean Legislations

2.1 The amendment to TMA, lowers the standard required to be met by an applicant to show that the consumers would *easily* recognise the trademark as a source identifier, by deleting "easily" from the TMA, in order to respect the goodwill of trademarks that may already function as source identifiers in the marketplace.

2.2 The amendment prevents the registration of marks that may potentially dilute the distinctiveness and/or reputation of a famous mark.

2.3 The amendment also specifically denies registrations for applications filed for a mark which is identical or similar to a third party's mark in connection with identical or similar goods, despite knowledge that the third party is using or planning to use the mark pursuant to a partnership agreement, employment relationship, business transaction, or other relationship.

2.4 The amendment to the TMA prevents use of a registered mark by a registrant and/or licensee without consent of the third party, if use of the registered mark falls within the scope of the above UCPA "catch-all" provision. Further, the registered mark can be cancelled within five years from the registration date for violating the "catch-all" provision if a cancellation action is filed by the party whose economic interests are being infringed.

3. Practice Changes

NA.

4. Some Significant Court and Trademark Office Decisions

4.1 ***Ace 21 v. Continental Reifen Deutschland*** **[2012 Hu 2463, Supreme Court]** (Valid Use of an English/Korean Combination Mark Despite Use of One Version Only)

Reversing a long-held position, the Supreme Court of Korea *en banc* ruled that the use of only the English portion (or equally, only the Korean transliteration portion) of a registered English/Korean transliteration combination mark constituted use of the mark as registered. The Supreme Court justified its decision on the basis that Korean consumers are nowadays more accustomed to English words and can easily understand that the Korean portion of such combination marks are in fact a mere transliteration of the English portion, having the same meaning and pronunciation.

4.2 *New Balance Athletic Shoe v. Unistar* [2011 Hu 3698, Supreme Court] ("N" Means New Life for Non-Distinctive Portions)

In this case, New Balance filed a scope confirmation action before the Korean Intellectual Property Office, to determine whether the use of Unistar's mark on shoe products fell within the scope of protection of New Balance's trademark registration. The Supreme Court *en banc* ruled that a mark similar to an inherently non-distinctive portion of a registered mark, which had acquired secondary meaning in the Korean market place after registration, falls within the scope of protection of the registered mark.

4.3 *Mattel Inc. v. Dae-Yong Whang* [2013 Hu 1986, Supreme Court] and *Lous Vuitton Malletier v. Si-Eun HA* [2014 Hu 2484, Supreme Court] (No Goods Left Behind: Invalidating Bad Faith Filings)

The Supreme Court overturned two decisions by the Patent Court, which only partially invalidated bad faith registrations similar to well-known marks. In both cases, the Patent Court invalidated the registrations only as to goods/services economically related to goods/services covered by the well-known marks, while leaving them valid for goods/services that had no such economic relationship. The Supreme Court's decisions in the case (Case No. 2013Hu1986 rendered on January 23, 2014) and case (Case No. 2013Hu2484 rendered on 27 February 2014) send a strong signal to lower level courts that similar registrations which are found to have been filed with unfair competitive purposes should be invalidated in their entirety, not only for goods/services specifically related to the famous mark and even if some of the designated goods/services for the challenged registration are not economically linked to the goods/services sold in connection with the other party's source identifier.

4.4 *Pfizer v. Hanmi*, [Case No. 2013 Na 26816, Seoul High Court] (3D Mark for "Viagra" Blue Tablet Form Recognised as a Source Identifier)

The Seoul High Court overturned a District Court ruling regarding trademark infringement and unfair competition. Pfizer's Viagra, an erectile dysfunction medication, had been extremely popular in Korea for many years. In 2012, Pfizer's patent expired and the Korean market was flooded with generic versions. Hanmi's generic pill "PalPal" not only used the same ingredient, sildenafil, but also copied Viagra's distinctive blue diamond shape and colour. The District Court found no infringement on part of the defendant owing to the distinctive packaging and requirement of doctor's prescription. The High Court however focused on the actual distribution of the drug. The High Court reasoned that in this loose distribution environment, and the way that Hanmi had intentionally copied the well-known three-dimensional trademark with blue diamond shape and colour to produce a highly similar pill, there was a possibility of confusion by end-users regarding which pills they had intended to ask their doctor for a prescription, or which pills they were actually receiving from their pharmacists, thus amounting to bad faith intent.

5. Contributed by

Se-Joong Oh, Seo-Young Im and Kyoung-Sun Lee.

APAA 2014 TRADEMARK COMMITTEE REPORT – MALAYSIA

1. Malaysian Trademarks Office Statistics

No. of Applications Filed	22,480
No. of Applications Registered	17,667

2. Changes to Malaysian Legislations

2.1 IP Agents Good Conduct Guidelines were laid down.

3. Practice Changes:

3.1 ASEAN IP Portal was launched to serve as the gateway to access all ASEAN IP information.

3.2 IPR Marketplace Portal was launched.

4. Some Significant Court and Trademark Office Decisions

4.1 *Wieland Electric GmbH v. Industrial Automation (M) Sdn Bhd & Anr.* [(2014) 7 CLJ 970]

The court held that it is the Plaintiff who is at all material times the rightful proprietor of the subject trade mark. The first Defendant was merely the distributor and/or agent of the Wieland products has no sufficient cause to register the Wieland trademarks.

4.2 *Cargill Incorporated v. Pendaftar Cap Dagangan* [(2013) 10 CLJ 144]

The Plaintiff brought an appeal against the decision of the Registrar to register the trade mark "POULTRY FOCUS" ("the mark") in Class 31 in respect of "non-medicated animal feeds". The Court allowed the appeal stating that the mark was an invented word within the meaning of section 10(1)(c) of the Act. The combination of the words "POULTRY" and "FOCUS" might allude to the product sold by the plaintiff, but by themselves these words together could not per se be said to describe the said product as the word "FOCUS" had no real connection to the said product.

4.3 *Xiamen King Long United Automotive Industry Co. Ltd. v. KLM Motor Sdn Bhd* [(2013) 4 CLJ 746]

The Respondent's mark was identical to the device component of the "King Long & Device" mark belonging to the Applicant. There would inevitably be confusion and/or deception between the marks as a result of the obvious similarity between the two marks. There was high likelihood that existing and potential customers might be diverted from the Applicant to the Respondent resulting in loss and damage to the applicant.

4.4 *Syarikat Conweld Sdn Bhd v. Anta Industrial Parts Sdn Bhd & Anr.* [Civil Appeal No. W-02(IPCV)(W)-919-04/2013]

There was a dispute between the Plaintiff and the Defendants regarding the ownership of the PONY trade mark. Based on the evaluation of the evidence, the High Court held that the Plaintiff is the true owner of the PONY trade mark and the second Defendant is merely the Plaintiff's contract manufacturer for the PONY PVC hoses under the arrangement of original equipment manufacturer (OEM). The Defendants' counterclaim for expunging the Plaintiff's registration of the PONY trade mark on the ground of fraud was dismissed by the High Court. Accordingly, the Plaintiff succeeded in its claim for trade mark infringement and passing-off. The Defendants appealed to the Court of Appeal and it was dismissed with costs.

4.5 *Chua Cheng Kiat Iwn. v. Chua Cheng Ho* [(2014) 1 LNS 502]

This case concerns trade-mark infringement. The plaintiff and the defendant are brothers. The issue is whether the registration of the trade mark "BAN LEE SIANG" is exclusively owned by the plaintiff. Based on the facts of the case, the High Court held that the trade mark "BAN LEE SIANG" was not only sold to the Plaintiff but also to the Defendant and their mother. The Defendant is also an honest concurrent user under section 20 of the Trade Marks Act 1976 and is entitled to be a joint proprietor of the mark.

5. Contributed by

Benjamin J. Thompson and Su Siew Ling.

APAA 2014 TRADEMARK COMMITTEE REPORT – MYANMAR

1. Myanmar Trademark Office Statistics Year 2014

Total No. of Trademark Registrations	5980
No. of Domestic Registrations	2062
No. of Foreign Registrations	3918

2. Changes to Myanmar's Legislations

2.1 Money Laundering Combating Law (Union Hluttaw Law no.11/2014) was enacted on 14 March 2014 under which IP infringed offences are defined as the money laundering offences.

2.2 Ministry of Science and Technology (MOST) completed its final drafts. All these drafted IP laws (Trademark Law, Patent Law, Industrial Design Law and Copyright Law) were sent up to the Union Attorney-General Office for scrutiny in June 2014 to be able to submit to the Parliament via the Cabinet. Intellectual Property Office of Myanmar (IPOM) is to be established after enacting the IP laws, under which there will be four main departments such as Policy and Strategic Planning Department, IP Department, Education and Awareness Department, and Financial and Administrative Department.

2.3 Intellectual Property Proprietors' Association of Myanmar (IPPAM) aiming at protecting and promoting IPRs of the public in cooperation with Myanmar government and foreign IP Associations/Organisations was established in December 2013 and officially recognized by the Ministry of National Planning and Economic Development in June 2014.

2.4 IP Awareness Activities co-organized by MOST, IPPAM, APAA Myanmar Recognised Group, APAA Korean Recognised Group, INTA, JETRO, JPO, JICA.

3. Practice Changes

NA.

4. Some Significant Court and Trademark Office Decisions

NA.

5. Contributed by

NA.

APAA 2014 TRADEMARK COMMITTEE REPORT – NEW ZEALAND

1. New Zealand Trademark Office Statistics 2013–2014

NA.

2. Changes to New Zealand's Legislation

The Madrid Protocol and The Singapore Treaty came into force in New Zealand on 10 December 2012. There have been no subsequent legislative developments.

3. Practice Changes

3.1 New Case Management System: The new system has made it easier for users to search, apply for and maintain trade-mark registrations and proceedings cases through a simple user interface. This system has some advantages: users can update and maintain their cases themselves and all communication is electronic; the system provides users with a record of transactions and a task list includes due dates.

4. Some Significant Court and Trademark Office Decisions

4.1 *Disney Enterprises Inc. v. Monster Energy Co.* [Decided on 2 September 2014, Assistant Commissioner Glover] (Evidential requirements)

In New Zealand, evidence filed with the Trademarks Office must be in the form of an affidavit (a sworn statement) or statutory declaration (an unsworn statement). The law prescribes a form for declarations made in New Zealand but not for declarations made overseas.

This case decided that the declaration made in California before a notary public in accordance with the law of California complied sufficiently with New Zealand law. The case also confirmed that exhibits to the declaration were admissible even if they did not comply with either the High Court rules or the Trademarks Office guidelines since neither was binding on parties before this particular tribunal. Some of the evidence was nonetheless ruled inadmissible as opinion, hearsay or irrelevant.

4.2 ***The Chartered Institute of Management Accountants v. New Zealand Institute of Chartered Accountants*** **[Decided on 3 September 2014, Assistant Commissioner Alley]** (Relevance of cross-examination for evidence)

The case considered interlocutory applications by the applicant for production of documents by the opponent and, in order that one of the opponent's witnesses be made available for oral cross examination. The Trademarks Act requires evidence to be given in written form, but gives the Commissioner discretion as to given leave to cross-examine. Leave will grant only where compelling reasons are presented which establish that there is good reason for cross examination and that the evidence could not have been otherwise provided in writing. The official view is that cross examination would be permitted only if the office was satisfied there was genuine concern as to the credibility of a witness or the veracity of written evidence or whether is a contradiction in written evidence which cannot be resolved other than by cross examination.

4.3 ***Fujian Quanzhou Peak Sports Products Co. Ltd.*** **[Decided on 19 September 2014, Assistant Commissioner Walden]** (Evidential requirement)

The case reiterates the importance of evidence of use being detailed, cogent and comprehensive and related to use of the trademark in New Zealand.

4.4 ***Novartis AG v. Abbott Biologicals BV*** **[25 September 2014, Assistant Commissioner Alley]** (Opposition to International Application)

The case contains a useful discussion of the factors relied on in determining whether marks are confusingly similar.

4.5 ***Bayer Consumer Care AG v. DBC, LLC*** **[(2013) NZHC 3203]** (Confusingly similar marks)

The High Court took the view that the ELEVIT and ELEVIV trademarks had a marked similarity in spelling, in their stylisation, in the selection of font and in their pronunciation and that those similarities were to a degree and extent that gave rise to a real risk of consumer confusion and deception. On comparison, the goods covered by each opposed mark were the same or similar, that the marks were visually, aurally and conceptually similar and that there was accordingly a likelihood of confusion on the part of consumers.

4.6 ***Tasman Insulation New Zealand Ltd. v. Knauf Insulation Ltd.*** **[(2014) NZHC 960]** (Passing-off action)

The High Court considered whether the defendant's use of the term "by bats" in relation to insulation products infringed the plaintiff's registered trademark, amounted to passing off and was in breach of the Fair Trading Act (which prohibits conduct in trade that is misleading or deceptive or likely to be so). The Court found out that it is common ground that beyond New Zealand the word "batt" is not the subject of trade mark protection for insulation materials. Besides, the court rejected the allegation made by the defendant that the registered trade mark BATTS had become generic in New Zealand and found that the registration of Trade Mark 105507 for the sign "BATTS" was infringed.

4.7 ***Metalman New Zealand Ltd. v. Scrapman BOP Ltd.*** **[(2014) NZHC 2028]** (Revocation of a trademark registration on the ground of non-use)

The Court ruled that once an application for revocation of a trade mark for non-use under section 66(1)(a) has been filed, the owner of the trade mark is required to provide proof that the trade

mark in question was used during the three-year period ending one month before the application was filed. Merely publishing a single newspaper advertisement featuring the trade mark without any evidence with respect to the circulation or readership of the relevant newspaper, whether it was distributed free of charge, whether it was published weekly or monthly, or anything else did not amount to genuine use of the trademark.

4.8 *Fast Future Brands Proprietary Ltd. (formerly Valleygirl Fashions Proprietary Ltd.) v. Valleygirl New Zealand Ltd.* [(2013) NZCA 615]

The central issue in this appeal was whether the respondents were entitled to the ownership and use in New Zealand of certain trademarks associated with women's clothing and accessories. Both the High Court and Court of Appeal were satisfied that none of the subsequent arrangements involved respondent being required to relinquish his trademarks in New Zealand despite Jim's knowledge that they had been registered in Michael's name.

4.9 *ICE SA (formerly TKS s.a.) v. Swatch AG (Swatch SA) (Swatch Ltd.)* [Decided on 16 December 2013, Court of Appeal] (Evidential Requirement)

It was an application by the appellant (Ice-Watch) for leave to adduce further evidence on its appeal to the Court of Appeal. The appeal was from a High Court judgment which largely upheld the decision of the Assistant Commissioner to decline Ice-Watch's application to register Ice-Watch as a trade mark in New Zealand. The respondent (Swatch) had opposed registration.

The Court of Appeal dismissed the appeal because the further evidence sought to be adduced could and therefore should have been adduced in the High Court, if not before the Commissioner. Evidence which is not fresh should only be admitted in exceptional and compelling circumstances and will also need to pass the tests of credibility and cogency.

Section 172 of the New Zealand Trademarks Act provides that appeals must be heard only on the materials stated by the Commissioner unless a party, either in the manner prescribed or by special leave of the court, brings forward further material for the consideration of the court. The key is whether the evidence could have been filed earlier because litigants have a duty to produce at trial all their evidence that is reasonably discoverable.

5. Contributed by

NA.

APAA 2014 TRADEMARK COMMITTEE REPORT – PAKISTAN

1. Pakistan's Trademark Office Statistics 2013

No. of Trademark Applications Filed 20,822

2. Changes to Pakistan's Legislation

NA.

3. Practice Change

3.1 Upgradation of Industrial Property Automation System (IP AS) from old technology (Centura) to latest technology (Java) in IPO-Pakistan offices.

3.2 Deployment of WIPO Scan+ in Registries for scanning and indexing of IP Applications.

3.3 Implementation of Electronic Document Management System (EDMS) for storing and access of paper documents of IP Applications in digital form.

3.4 Integration of all three systems (IPAS-Java, WIPO Scan+ and EDMS) to work together with each other.

3.5 Digitisation of IP applications records under Trade Related Technical Assistance.

3.6 (TRTA-II) program of European Commission [will soon be completed].

3.7 This is first step on the way to paperless environment which will lead toward the goal of online filing (e-filing) of IP applications in coming years.

4. Some Significant Court and Trademark Office Decisions

4.1 Suit No. 712 of 2009 [High Court of Sindh] (Bad Faith)

The *bona fide* intention of the plaintiff to use the mark and the honest concurrent use of the defendant was considered in this case by the court. Further, the registration of plaintiff's mark beyond the scope of the memorandum of association was looked into and the court held that a company cannot go beyond its memorandum of association and that a company has the legal capacity to only engage in the businesses and ventures that are provided for in the memorandum and anything beyond it would be extraneous and void.

5. Contributed by

Seema S. Mansoor, Farzana Rustom and M. Yawar Irfan Khan.

APAA 2014 TRADEMARK COMMITTEE REPORT – PHILLIPINES

1. Philippines Trademark Office Statistics 2013–2014

No. of Applications Filed	32074
No. of Applications Registered	19864

2. Changes to Philippines' Legislation

2.1 Amendment of the Provisions of the Declaration of Actual Use of the Trademark Regulation.

2.2 Use of the Documents Codes for all documents filed with the Intellectual Property Office.

2.3 Amendment of the Trademark Regulations related to Trademark Applications with Priority Right Claim and Implementation Guidelines regarding Trademark Applications with Priority Right Claim.

3. Practice Changes

NA.

4. Some Significant Court and Trademark Office Decisions

4.1 ***Starwood Hotels and Resorts Worldwide Inc. v. W Land Holdings Inc.*** **[IPO Appeal No. 14-2012-0025, Office of Director General]**

It has ruled that interactive websites, hotel bookings and advertisements indicate actual use of the mark in the Philippines.

4.2 ***Fun Ranch Mega Development Inc. v. Director of the Bureau of Trademarks*** **[IPO Appeal No. 04-2012-0002 to 05, Office of Director General]**

It was emphasised that only a visible sign capable of distinguishing an enterprise is entitled to trademark registration.

4.3 ***Therapharma Inc. v. D.B. Manix International Inc.*** **[Office of Director General]**

The decision in the said case highlights the importance of filling the Declaration of Actual Use and illustrates the consequence of the failure to file it.

4.4 *Enrico Perez v. Araneta Center* [IPO Appeal No. 10-2011-0002, Office of Director General]

The case discussed that when a domain name is used for the promotion of certain interests and commercial activities, the same functions as a trademark and that the person using a domain name which causes a likelihood of confusion or deception may be held guilty of violating section 169 of the IP Code, on False Designation of Origin.

4.5 *Shang Properties Realty Corporation (formerly Shang Grand Tower Corporation) & Shang Properties Inc. (formerly Edsa Properties Holding Inc.) v. St. Francis Development* [Supreme Court]

The Supreme Court discussed the true test of unfair competition. Further, the Court discussed the specific requirements to be met in order to conclude that a geographically-descriptive mark has acquired secondary meaning.

4.6 *Brikenstone Orthopaedie GmbH and Co., KG (formerly Brikenstone Orthopaedia GmbH) v. Philippine Shoe Expo Marketing Corporation* [Supreme Court]

The case where the former Supreme Court, discussed the effects of failure to file the required tenth year Declaration of Actual Use and discussed the means by which ownership of a trademark is acquired.

5. Contributed by

NA.

APAA 2014 TRADEMARK COMMITTEE REPORT – SINGAPORE

1. Singapore Trademark Office Statistics 2013

No. of Applications Filed:	21,245
No. of Applications Registered:	12,920

2. Changes to Singapore's Legislation

NA.

3. Practice Changes

3.1 Upcoming changes to processes, forms and fees pursuant to the implementation of IPSG for trademarks.

3.2 Entering of particulars of express trusts and beneficiaries in the Register of Trade Marks.

4. Some Significant Court and Trademark Office Decisions

4.1 *Staywell Hospitality Group Pty Ltd. v. Starwood Hotels & Resorts Worldwide Inc. & another appeal* [(2013) SGCA 65]

Court of Appeal overturned an earlier decision by the High Court and held that the mark "PARKREGIS" was not registrable as it was similar to the earlier "ST. REGIS" mark. Court of Appeal also determined that where services covered by the marks were similar, "registration in the same specification within a class establish a *prima facie* case for identity".

4.2 *Guy Neale & Ors. v. Nine Squares Pty Ltd.* [(2013) SGHC 249]

The Plaintiffs sought to determine whether (a) the registered marks are held on trust for the Plaintiffs; and (b) the registered marks should be invalidated. The Court determined that the Plaintiffs failed to discharge the burden of showing that the Defendant intended to hold the registered marks on trust for the Plaintiffs. The High Court also did not invalidate the registered marks.

4.3 *Lacoste v. Carolina Herrera Ltd.* [(2014) SGIPOS 3]

Opposition against the registration of mark "L.12.12" in, inter alia, Class 3 for perfume-related products.

4.4 *Bacardi & Company Ltd. v. G3 Enterprises Inc.* [(2014) SGIPOS 6]

Application for the revocation/invalidation of the mark "MARTINI" to be on the basis that it has become the name of a generic alcoholic drink.

4.5 *Choice Fortune Holdings Ltd. v. Seiko Holdings Kabushiki Kaisha* [(2014) SGIPOS 8]

Opposition against the registration of mark "SEIKI" in Class 9.

4.6 *Kimanis Food Industries Sdn Bhd v. Rovio Entertainment Ltd.* [(2014) SGIPOS 10]

Opposition against the registration of mark for "ANGRY BITE" in Class 30.

4.7 *Taylors Wines Pty Ltd. v. Taylor, Fladgate & Yeatman Ltd.* [(2014) SGIPOS 11]

The case regards dismissal of opposition on grounds of no similarity between the marks and lack of likelihood of confusion between the two marks. The opponent also failed to establish popularity of the mark in Singapore.

4.8 *OOO "TVM-TRADE" v. Societe Des Produits Nestle SA* [(2014) SGIPOS 12]

It is a case regarding whether IPOS has the power to strike out an opposition. It was decided that such a power was not conferred upon the Registrar under the relevant laws in Singapore as there was no right to appeal provided for in the legislation after such a striking out action.

5. Contributed by

May Tan Hui Teng and Renee Xavier.

APAA 2014 TRADEMARK COMMITTEE REPORT – SRI LANKA

1. Sri Lankan Trademark Office Statistics 2013

No. of Applications Filed	6,183
No. of Applications Examined	20,000
No. of Applications published in the *Gazette*	2,600

2. Changes to Sri Lankan Legislation

NA.

3. Practice Changes

There have been no amendments to the Intellectual Property Act No. 36 of 2003 (Act) during the course of the year. Under the auspices of WIPO several workshops were held in relation to geographic indications and the possibility of Sri Lanka entering into the Madrid Treaty.

It is now possible to register trademarks with the Sri Lanka Customs. Registrations with the Customs does not safeguard IP rights but is treated as an initiative of the rightful holders notifying Sri Lanka Customs of any impending violation of the IP rights as provided for in terms of section 125 (b) of the Customs Ordinance.

4. Some Significant Court and Trademark Office Decisions

4.1 *Unilever Lipton Ceylon Ltd. and Unilever PLC v. J M K B Jayasundera*

Unilever Lipton Ceylon Limited and Unilever PLC instituted action against J M K B Jayasundera (the sole proprietor of the business named and styled "Laji Tea") for the infringement of their trademark "LAOJEE" and succeeded in obtaining an interim injunction against the Defendant. The case is now proceeding to Trial.



Plaintiff's product



Defendant's product

4.2 *Arpico Finance Co. PLC v. Richard Pieris Arpico Finance Ltd*.

Arpico Finance Co PLC filed action against Richard Pieris Arpico Finance Ltd for the use of the word Arpico as a part of their name. Arpico trademark is registered in other categories of goods and is a household name owned by the defendants. Arpico Finance Co has been in operation for 60 years and Richard Pieris did not object to same. The High Court

issued Interim Injunction against the defendant company against the use of the word Arpico by Richard Pieris Arpico Finance Co. Ltd and the Defendant appealed to the Supreme Court and the Supreme Court affirmed the decision of the High Court.

4.3 *Infringement of Holiday Inn*

M/s InterContinental Hotels Group, owners of the famous "Holiday Inn" brand sent a Cease & Desist Letter to the offending party for use of the mark "Holiday Inn". The offending party agreed to change their name to Nathashiya Inn.



MHG mark



Offending party mark

4.4 *Infringement of Pure Life & Family Device*

Societe des Produits Nestle S A sent a Cease & Desist Letter to the offending party for use of Pure Life and Family device marks. The offending party undertook to change the label.



Nestle Mark



Mark of the offending party



Amended Label

5. Contributed by

Anomi Wanigasekera.

APAA 2014 TRADEMARK COMMITTEE REPORT – TAIWAN

1. Taiwan Trademark Office Statistics 2013

No. of Applications Filed	21,245

2. Changes to Taiwan's Legislation

According to Article 5, as implemented on 1 July 2012, the following behaviour is explicitly listed as trademark use: possessing, displaying, sale, exportation, or importation of the goods.

Under Article 30, paragraph 1, sub-section 12, the Examiner of the TIPO can, *ex officio* or by request of a third party, examine whether the trademark application is filed in bad faith.

3. Practice Changes

NA.

4. Some Significant Court and Trademark Office Decisions

4.1 Non-traditional trademark application

A company selling soft drinks applied for a 3D shape trademark in Class 32 (beers, soft drinks, apple juice, etc.). The IP court ruled that the three-dimensional shape trademark application lacked (1) inherent distinctiveness for that it was a simple alternation of common product container, and (2) acquired distinctiveness for that the 3D trademark application was always used with the applicant's other trademarks.

4.2 Infringement of Trademark

The registered trademark is "Hei Jin Gang" but the actual use of the trademark is "Hei Jin Gang Liao Li Mi Jiu", in which the words "Hei Jin Gang" are larger than "Liao Li Mi Jiu". If actual use of a registered trademark is in a form differing in elements which do not substantially change the distinctive character of the trademark, the identity of the trademark is not affected.

4.3 Infringement of Trademark

The trademarks  were regarded as the alteration of a registered trademark . The proprietor changed the registered trademark in different words, device and colour. In this way, the identity was affected.

5. Contributed by

Julia Y.M. Hung, Albert W.H. Lee and Jui-Hsien Huang.

APAA 2014 TRADEMARK COMMITTEE REPORT – THAILAND

1. Thailand Trademark Office Statistics 2013–2014

No. of Trademark Applications Received	46,097
No. of Trademark Registered	19,563

2. Changes to Thailand's Legislation

2.1 Update on Amendments to the Thai Trademark Act (the "Act")

The first set of draft amendment was reviewed by the Senate early 2013 and is now at the National Legislative Assembly for consideration and final approval.

2.2 The second set of the draft amendment (accommodate implementation of the regulations and procedures of the Madrid system) was reviewed by the Council of State and is being forwarded to the Cabinet for consideration and approval.

3. Practice Changes

3.1 E-Filing: The Department of Intellectual Property (the "DIP") has developed the trademark and patent e-filing registration systems.

4. Some Significant Court and Trademark Office Decisions

4.1 *The Societe BIC v. The DIP Thailand* [Judgment No. 773-776/255, Supreme Court] (Related to 3D mark)

The plaintiff applied for a shape of lights and pens as 3D marks. The 3D marks were rejected by the Registrar and the TMB on the grounds that they lack of distinctiveness. The IP/IT Court reversed the decision of the TMB and order registration of the 3D marks. The DIP filed an appeal with the Supreme Court. The Court decided that the shape of lights were not distinct enough to prove that it is distinguish from other lights and the shape of the pens are the same as those of other pens sold in the market. The shapes of both lights and pens have not been designed or decorated to the extent that the public will perceive that the 3D of lights and pens are not related to the goods. The evidence of use submitted to support the applications were not sufficient to prove that the 3D marks have acquired distinctiveness from use.

4.2 *Shell Brands International AG v. The DIP Thailand* [Judgment No. 2183-2184/ 2553, Supreme Court] (Related to combination of colors)

The Plaintiff applied for a combination of colours  (consisting of a red stripe, a yellow stripe and a grey stripe) for goods in Class 4. The application was rejected by the Registrar and TMB on the grounds that the mark lack of distinctiveness and the plaintiff failed to create the special characteristics of the colours. The plaintiff filed an appeal with the IP/IT Court. The IP/IT Court reversed the TMB decision and ordered registration of the mark. The DIP filed an appeal with the Supreme Court. The Court affirmed the IP/IT Court judgement.

The Court viewed that such composition of colours was not merely the formed of normal lines, frames or geometry shapes in a general manner, or merely a part of the packaging that no one can perceive as a trademark, but the combination of colours and the composition of elements were deliberately created in order to form its special characteristic, thus made it distinctive. The public can identify this combination of colours as a trademark and this trademark can distinguish the Plaintiff's trademark from others.

5. Contributed by

Prasantaya Bantadtan.

APAA 2014 PATENT COMMITTEE REPORT – VIETNAM

1. Vietnam Patent Statistics 2013–2014

No. of Applications Filed in Vietnam	4169 (3726 foreign)
No. of Patents Granted	1262 (1203 foreign)

2. Changes to Vietnam's Legislations

There have been no substantial changes in the patent law in Vietnam.

3. Practice Change

There have been no substantial changes in the regulations or patent practice in Vietnam.

4. Some Significant Court and Office Decisions

There have been no patent-related court decisions of particular interest in the last year.

5. Contributed by

NA.

APAA 2014 PATENT COMMITTEE REPORT – AUSTRALIA

1. Patent Statistics Year 2013

No. of Applications Filed	NA.
No. of Registration Certificates Issued	NA.

2. Changes to Australia's Legislation

The Australian Government introduced the Intellectual Property Laws Amendment Bill 2014 into the Parliament in March 2014. The Bill proposes to amend the Patents Act 1990 to implement the protocol amending the World Trade Organization Agreement on Trade-Related Aspects of Intellectual Property (TRIPS Protocol) enabling Australian medicine producers to manufacture and export patented pharmaceuticals to countries experiencing health crises, under a compulsory license from the Federal Court. The amendment further allows for a single trans-Tasman patent attorney regime and single patent application and examination processes for Australia and New Zealand, as part of the broader Single Economic Market agenda for the two countries. The bill also proposes to amend the compulsory licence provisions to enable Federal Court to grant compulsory licences to make an export patented pharmaceuticals to developing countries. It involves a single governance body being responsible for attorney registration, training and disciplinary standards across Australia and New Zealand. A Trans-Tasman IP Attorneys Board and Trans-Tasman Discipline Tribunal will also be established under Australian law and recognised under NZ law.

3. Practice changes

NA.

4. Some Significant Court and Trademark Office Decisions

4.1. ***D'Arcy v. Myriad Genetics Inc.*** **[(2014) FCAFC 115]** (Isolation Gene Sequences Patentable)

On 5 September 2014 the Full Federal Court, consisting of five Justices, at first instance, affirmed the decision of Nicholas J that isolated DNA and RNA are patentable subject matter. The Court had to determine whether a patent may be granted for a claim that covers naturally occurring nucleic acid that has been isolated from all cellular components. It was challenged solely on the basis that the claims are not for a manner of manufacture, as required by Australian law. Nicholas J, applying the broad construction given to the term "manner of manufacture" by the High Court in *National Research and Development Corporation v Commissioner of Patents (NRDC Case)* [(1959) HCA 67 : (1959) 102 CLR 252], found, at first instance, that each of the challenged claims were to an artificially created state of affairs with economic utility. Nicholas J differentiated between nucleic acid as it is found inside the cell, and its form when isolated. The Full Federal Court applying the NRDC principles affirmed the decision of Nicholas J. This conclusion contrasts with the US Supreme Court findings

in *Association for Molecular Pathology v. Myriad Genetics Inc*. [569 US 2013] where it was held that a naturally occurring DNA segment is a product of nature and is therefore not patentable, even if isolated. The reasoning in this case however focused on the information contained in the nucleic acid sequence, rather than the product itself.

4.2. ***Apotex Pty Ltd. v. Sanofi-Aventis Australia Pty Ltd. & Ors.*** **[(2013) HCA 50]** (Methods of Medical Treatment Patentable)

On 4 December 2013, the High Court, by a 4:1 majority, held that methods of medical treatment of the human body can be patentable inventions within the meaning of section 18(1) of the Patents Act 1990 (Cth). This is the first time in which the High Court has had to consider this issue.

4.3. ***Biogen Idec MA Inc.*** **[(2014) APO 25]** (Grace Period Used to Overcome "Whole of Contents" Objection)

In a decision of the Deputy Commissioner of Patents, the grace period provisions of section 24 were successfully relied upon to overcome a "whole of contents" novelty objection based on an earlier published patent application containing information derived from the applicant. This decision confirms that the grace period may be used to overcome a "whole of contents" novelty objection where the cited application is filed by the same applicant, or contains information derived from the applicant, and published in the 12 months preceding the Australian filing date of the application under consideration. While this decision relates to the prior art effect of an earlier application filed by a third party containing information derived from the applicant and published without the applicant's consent, it follows from the Deputy Commissioner's analysis that the grace period would also apply in circumstances where the earlier Australian complete specification or PCT application representing the "whole of contents" citation is filed by or with the consent of the applicant.

5. Contributed by

Michael Brown, Laura Hollingsworth and Catherine Edmonds.

APAA 2014 PATENT COMMITTEE REPORT – INDIA

1. Indian Patent Statistics Year 2013

NA.

2. Changes to Indian Legislations

2.1. Patent Rules Amended

The new rules primarily consist of revision in the existing fee structure across all actions. The amendments have also led to a revised official fee schedule with a general substantial increase in fees. In an attempt to encourage applicants to use the electronic filing mode available on the Patent Office website, the amendment has introduced a 10% additional surcharge on manual mode of submitting documents under each activity, thereby making paper filing of documents a bit costlier than the electronic filing mode.

3. Practice Changes

3.1. Indian Patent Office starts functioning as International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA).

3.2. Guidelines for Examination of Patent Applications

Till now, such guidelines have been issued and made public for biotechnology-related inventions as well as traditional knowledge and biological materials. In the previous year, draft guidelines have been made available for examination of Computer Related Inventions (CRI) and pharmaceutical inventions. Stakeholder meetings have been held and the final versions will be issued shortly.

4. Some Significant Court Decisions

4.1. *NTT DoCoMo Inc. v. Controller of Patents & Design* [OA/39/2011/PT/CH]

(Proof of right mandatory for all patent applicants)

Intellectual Property Appellate Board (IPAB) passed an order making it mandatory for the applicant, who is not the true and first inventor of the invention, to file a "proof of right" while applying for the patent. It took into cognizance the scope of section 7(2) of the Indian Patents Act 1970, which requires an applicant, other than the true and first inventor, to establish "proof of the right" to file a patent application. It nullified the 2004 notification issued by the Controller General of Patents that had waived the requirement to submit such proof in cases where the patent applicant was the same in the priority country and in India. The order is, however, silent as to whether this requirement is applicable only to cases which are currently pending or even those cases which have been granted in the last decade without the proof of right document on record.

4.2. *Dr. Aloys Wobben & Ors. v. Yogesh Mehra & Ors.* [AIR 2014 SC 2210 : 2014 (7) SCALE 536]

In the instant case, the Supreme Court ruled out that:

(a) If prior to the infringement suit, a defendant has filed revocation under section 64(1) before the IPAB, then the defendant would be disentitled to file a counter claim;

(b) If the defendant counter claims for revocation in a suit, he cannot thereafter file revocation under section 64(1) before the IPAB; and

(c) If any interested person has filed a post-grant opposition under section 25(2), he is barred from filing revocation before the IPAB under section 64(1) or filing a counter claim as a defendant in an infringement suit.

4.3. *Bayer Corporation v. Union of India (NATCO Case)* [AIR 2014 Bom 178 : 2014 (60) PTC 277 (Bom)]

The Bombay High Court, while agreeing with IPAB decision on granting compulsory licensing to NATCO for a drug patented by Bayer Corporation, held that the grant of compulsory licenses is to be considered on a case-to-case basis. Further, importation is considered as working so long as the patentee can justify the same.

4.4. *Chemtura v. Union of India* [2009 (41) PTC 260 (Del) : MIPR 2009 (3) 287]
(Section 8 requirements)

In 2009, the Delhi High Court, in the case of *Chemtura v. Union of India,* emphasised on the need to comply with the obligations enshrined under section 8 of the Patent Act 1970 while determining the validity of the patent.

4.5. *Koninklijke Philips Electronics N.V. v. Maj. (Retd.) Sukesh Behl & Anr.* [2013 (56) PTC 570 (Del) : [2013 (205) DLT 680]
(Section 8 requirements)

The defendant (Maj. Behl) had filed an application under Order XII rule 6 of CPC on the ground that the plaintiff (Phillips) admittedly did not disclose information in compliance of Section 8 of the Indian Patent Act, therefore, on this basis the Patent should be revoked. While delivering the Judgement the Hon'ble court held that if the information that was withheld was material to the grant of Patent itself it might proceed to revoke the patent. Therefore the application was dismissed at that stage leaving open the question urged to be decided at the conclusion of trial.

However subsequent thereto in the appeal filed by Maj. Behl the DB 1 of Delhi High Court held the following:

> "revocation is not automatic under Section 64(1)(m), but it is always open to the Court to examine the question whether the omission to furnish the information was deliberate or intentional. The revocation would follow only if the Court is of the view that the omission to furnish the information was deliberate. Therefore, it cannot be held that there is any unequivocal admission by the plaintiff and consequently, it is not a matter for granting a decree even before the evidence is let in by the parties as provided under Order XII Rule 6 of CPC."

The Court only passed a prima facie opinion and the ratio of this judgment is:

> "it cannot be held that there is any unequivocal admission by the plaintiff and consequently, it is not a matter for granting a decree even before the evidence is let in by the parties as provided under Order XII Rule 6 of CPC."

This is unrelated to Section 8 and no order in fact has been passed in relation to Section 8 of the Patents Act. The order relates to whether the admission by the plaintiff was unequivocal or not and therefore can the suit be dismissed even before evidence.

The Court said that it would have to be seen if the matter not disclosed was material to the grant of patent. Conversely, it also held that it is imperative to take into cognizance whether the aforesaid information was wilfully suppressed or not.

4.6. *XU Dejun & Ors. v. Vringo Infrastructure Inc. & Anr.* [FAO (OS) 573/2013]

A Division Bench of the Delhi High Court reversed the trend of setting interim arrangements in the form of royalty rates in favour of a plaintiff, where the plaintiff alleges infringement of Standard Essential Patents (SEPs) and claims FRAND (fair, reasonable and non-discriminatory) negotiations. Recognising the time sensitivity of patent litigation matters, the Court, *inter alia*, ordered an expedited trial of the suit.

4.7. *Novartis A.G. v. Ranbaxy Laboratories Ltd.* [MIPR 2014 (3) 142] (Interim injunctions granted in Novartis patent suits in Vildagliptin)

In a move to enforce its Indian Patent No. 212815 for Type 2 Diabetes Mellitus (Type2DM) compound Vildagliptin, Novartis initiated a series of suits as *quia timet* action before the Delhi High Court against various pharmaceutical companies. It contended that since the defendants had been granted the permission to manufacture Vildagliptin pharmaceutical products, it was established that the defendants intent to launch such product which would constitute infringement of the suit patent. The High Court favoured injunctions in favour of Novartis in some of the suits while passing restraining orders in others.

4.8. *La Renon Healthcare Pvt. Ltd. v. Kibow Biotech Inc* [2014 (59) PTC 546 : MIPR 2014 (1) 70] (Positive news for bio-nutraceuticals)

The IPAB upheld a product patent relating to a dietary supplement comprising a probiotic composition that reduced the need for kidney patients to undergo dialysis. While rejecting the ground of obviousness, the IPAB noted that mere speculation of a hypothesis was not enough to defeat the claimed invention on the ground of obviousness. Besides, it stated that the claimed composition was indeed a synergistic composition having unexpected benefits and was not a mere admixture. It was, thus, held that the petitioner had deliberately misconstrued the scope and ambit of the invention. Based on the above analysis, the IPAB dismissed the revocation petition and imposed costs of INR 20,000 (approximately US$ 320) on the petitioner.

4.9. *Teijin Ltd. v. Union of India* [AIR 2014 Bom 68 : 2014 (4) BomCR 208] (Restoration of Patent)

The Bombay High Court restored a patent that had ceased due to procedural lapses on the part of the Patent Office. In the writ, the plaintiff claimed that the Patent Office violated the principles of natural justice by cancelling its registered patent without intimation or granting a hearing. The evidence highlighted that the petitioner had paid all annuities due for renewal of its patent within the prescribed time period and that it was the Patent Office which had failed to rectify the register or promptly intimate Teijin to rectify any errors

4.10. *Nitto Denko Corp v. Union of India* [W.P. (C) 3756/2013]

The Delhi High Court issued an order directing the Indian patent office to file an affidavit indicating the state of affairs in the patents office regarding issuance of First Examination Report (FER) and to disclose the year-wise pendency of patent matters. Upon the court's direction, a committee has been constituted to look into expediting examination of patent applications, recruitment of examiners, compensatory measures for applicants whose examination is delayed and so on.

5. Contributed by

Calab Gabriel and Hari Subramaniam.

APAA 2014 PATENT COMMITTEE REPORT – JAPAN

1. Japan Patent Statistics Year 2013

No. of Applications Filed 328,436/43,075 (Patent/ PCT)

2. Changes to Japan's Legislations

2.1 Patent Law has been amended to re-introduce a post-grant opposition system.

2.2 Patent Law has been amended to expand relief in respect of time limits and etc. in accordance with PLT provisions.

3. Practice Changes

NA.

4. Some Significant Court Decisions

4.1. *Apple Inc. v. Samsung Electronics Co. Ltd.* [Heisei 25 (Ne) 10043, Heisei 25 (Ra) 10007, and Heisei 25 (Ra) 10008, decided on 26 May 2014 by IP High Court (Grand Panel)]

The cases mainly relate to a damage claim in case of FRAND licensing declaration. Samsung made a FRAND licensing declaration regarding a patent. Samsung brought the preliminary injunction action against Apple. Apple brought the declaratory judgement action to determine the non-existence of the right to claim damages. The court found that seeking an injunctive relief is "an abuse of right" because Samsung made a FRAND licensing declaration and Apple had an intention to be licensed with Samsung on the FRAND terms and conditions. The court found that seeking damages can be "an abuse of right" if the amount of damages exceeds an amount equivalent to the FRAND license fee, but cannot be "an abuse of right" if the amount of damages falls within a range of the amount equivalent to the FRAND license fee. Incidentally, for the first time, the IP High Court invited public opinion on the following issue.

4.2. *Genentech Inc. v. Commissioner of JPO.* [Heisei 25 (Gyo-ke) 10195, Heisei 25 (Gyo-ke) 10196, Heisei 25 (Gyo-ke) 10197, and Heisei 25 (Gyo-ke) 10198, decided on 30 May 2014 by IP High Court (Grand Panel)]

The cases relate to a patent term extension. The court held that a request for a patent term extension should be rejected in accordance with Article 67-3 (1)(i) if either one of the following conditions is met:

First condition: A ban of practice of the patent was not lifted by the "disposition designated by Cabinet Order" (=market approval);

Second condition: An unbanned product by the "disposition designated by Cabinet Order" does not fall within the patented invention.

The court concluded that the patent term extension request based on the second approval meets neither of the first and the second condition required by Article 67-3 (1)(i) and cancelled the JPO decision.

5. Contributed by

Shigeru Inaba.

APAA 2014 PATENT COMMITTEE REPORT – KOREA

1. Korea Patent Office Statistics 2013–2014

No. of Applications Filed	204,589
No. of Applications Registered	NA

2. Changes to Korean Legislation

2.1. Filing in English

Filing in English will be possible with effect from 1 January 2015.

2.2. Extending deadline for filing translation of PCT applications

One more month shall be given for the filing of the Korean translation.

2.3. Allowing amendments based on the original application

Amendments or corrections made to the patent applications filed on or after 1 January 2015 can be made based on the specifications filed on the PCT filing date in foreign language. The specifications in foreign language will be considered the original specifications supporting the amendments and corrections.

3. Practice Changes

NA.

4. Some Significant Court and Designs Office Decisions

4.1. Case No. 2012 Hu 4162 [Decided on 20 March 2014 by Korean Supreme Court *en banc*]

It was held that confirmation trial cannot review the non-obviousness issue on the validity. Validity of a patent can be ruled invalid only by the Invalidity Trial. According to the Korean Patent Act, once a patent is registered, unless there is a final decision that the patent is invalidated by the patent invalidation trial procedure, other procedures cannot presume its invalidity.

5. Contributed by

Min Cheol KIM.

APAA 2014 PATENT COMMITTEE REPORT – MALAYSIA

1. Malaysian Patent Statistics 2013–2014

No. of Patent Applications Received	7,350 in 2013 7,760 in 2014
No. of Patents Granted	2,691 in 2013 2,762 in 2014
No. of PCT Applications	272 in 2013 289 in 2014

2. Changes to Malaysian Legislations

NA.

3. Practice Change

3.1 PCT Electronic Filing – ePCT: With effect from 1 October 2014, ePCT has been made available for filing new international applications from Malaysia.

3.2 Patent Prosecution Highway (PPH) Pilot Program: With effect from 1 October 2014, MyIPO and JPO have commenced a PPH pilot program lasting for a period of three years. This program is an initiative for providing accelerated examination procedures by sharing information between both patent offices.

4. Some Significant Court and Office Decisions

4.1. *Seng Kong Shutter Industries Sdn Bhd & Tan Kooi Lim v. SKB Shutters Manufacturing Sdn Bhd* [(2014) 4 CLJ 1037]

This case is an appeal by Seng Kong Shutter Industries & Tan Kooi Lim (together, "the Appellants") against the High Court decision in a patent infringement action whereby the Patent No. MY-128431-A entitled "Rolling Door" owned by SKB Shutters Manufacturing ("the Respondent") as registered proprietor was held to be valid and enforceable.

In 2008, the Respondent instituted a claim for patent infringement against the Appellants in the High Court. It was alleged that the Appellants made, sold or offered to sell or use, without a licence or consent, products incorporating the patent's features while the patent was valid and subsisting. The Appellant however challenged the validity of the patent on grounds of novelty and lack of inventive steps. The High Court decided in favour of the Respondent; however, the Court of Appeal held that the High Court applied the

wrong approach towards determining novelty and inventiveness. According to the Court of Appeal, the correct approach would be that the invention described in the patent claims is to be compared with the prior art when comparing novelty and inventiveness of an invention. Thus, while deciding for the Appellants, it was held that the patent was invalid as it was not novel, was anticipated by prior art and did not involve an inventive step. As the patent was held to be invalid, the Court did not feel it necessary to proceed with a determination as to the patent's obviousness, but noted that this would cover "practically every case of lack of novelty". The High Court's judgement was thus set aside and the claim for patent infringement failed.

5. Contributed by

Chuah Jern Ern.

APAA 2014 PATENT COMMITTEE REPORT – NEW ZEALAND

1. New Zealand Patent Office Statistics 2013–2014

No. of Applications Filed	6,000
No. of Applications Registered	NA

2. Changes to New Zealand's Legislation

The Patents Act, 2013, includes the changes relating to subject matter exclusion from patentability; a higher examination standard; third party changes and time periods and fees. The new Act also includes some specific exclusions from patentability such as computer programs; human beings and biological processes for their generation; methods of treatment of human beings by surgery or therapy; methods of diagnosis practiced on human beings and plant varieties. Some of the key features are as follows:

2.1. A request for examination is now required. The deadline is five years from the filing date or within two months of receiving a direction to request examination.

2.2. Absolute novelty replaces local novelty.

2.3. Patent applications will be examined for novelty and inventive step. Under the old Act, applications were not examined for inventive step.

2.4. A utility provision has been introduced requiring that the invention has a specific, credible and substantial utility.

2.5. Maintenance/renewal fees are now payable annually after the completion of four years from the filing date.

2.6. Publication will occur at 18 months from the priority date. Under the old Act, official publication did not occur until acceptance of the application.

2.7. A provision relating to contributory infringement has been introduced.

2.8. An experimental use exemption to infringement has been introduced.

2.9. A Māori Advisory Committee is to be appointed; its function is to advise the Commissioner of Patents whether an invention claimed in a patent application is derived from Māori traditional knowledge or from indigenous plants or animals and whether the commercial exploitation of that invention is likely to be contrary to Māori values.

2.10. The examination standard is now based on the balance of probabilities, rather than the benefit of the doubt favouring the applicant.

2.11. Divisional applications could previously be filed at any time before acceptance of the parent application. Now all divisional

applications must be filed within five years of the international filing date.

2.12. The options for challenge by third parties now include pre- and post-grant re-examination and post-grant revocation (at any time), in addition to pre-grant opposition (within three months of acceptance).

3. Practice Changes

NA.

4. Some Significant Court and Designs Office Decisions

NA.

5. Contributed by

Greg Lynch.

APAA 2014 PATENT COMMITTEE REPORT – PAKISTAN

1. Pakistan's Patent Statistics 2013–2014

No. of Applications Filed 934 (679 in 2014)

2. Changes to Pakistan's Legislations

NA.

3. Practice Change

NA.

4. Some Significant Court and Office Decisions

NA.

5. Contributed by

Ali Kabir Shah and Khawja Shoaib Mansoor.

APAA 2014 PATENT COMMITTEE REPORT – PHILLIPINES

1. Patents Statistics Year 2013

No. of Applications Filed	NA.
No. of Registration Certificates Issued	NA.

*Patent filings increased by 2.67% from 2,994 in 2012 to 3,074 applications in 2013. Invention Patent Granted substantially increased by 71.57% from 1,115 in 2012 to 1,913 in 2013. Utility Model Filings decreased by 5.87% from 715 in year 2012 to 673 in year 2013. Utility Model Registrations on the other hand increased by 15.88% from 422 registrations in 2012 to 489 registrations in 2013. Industrial design applications increased by 9.14% from 1,225 in 2012 to 1,337 in 2013. Industrial design registrations increased by 26.58% from 1,061 registrations in 2012 to 1,343 registrations in 2013.

2. Changes to Philippines' Legislation

No new law or amendment was passed last year.

3. Practice Changes

3.1. Annuity Payments for Divisional Applications

Memorandum Circular No. 14-002 issued by the Bureau of Patents established a uniform procedure in the payment of annuity fees for granted or published divisional patent applications. Under the uniform procedure, the first annual fee shall be due and payable upon the expiration of four years from the date of the publication of the parent application, and on each subsequent anniversary of such date. The procedure further clarified that for a *direct route divisional application*, the first annuity payment shall commence upon the expiration of four years from the publication date of the direct route parent application. In the case of a PCT national phase divisional application, the first annuity payment shall commence upon the expiration of four years from the international publication date of the parent international application. In cases where the divisional application was filed more than four years after the date of the parent application, the annuity payment of the divisional application shall commence on the following year from the last annuity payment date of the parent application and on each subsequent anniversary of such date. In such a case, the annuity for the parent application shall be reduced to the remaining claims covering the subject matter of the parent application. In order to re-align the current payment practice, Memorandum Circular No.14-003 was issued to clarify that the full implementation of Memorandum Circular No. 14-002 would commence on 3 March 2015.

4. Some Significant Court and Trademark Office Decisions

There were no interesting or significant patent cases decided by the Philippine Supreme Court during the current year as of this writing.

5. Contributed by

Atty. Eduardo C. Escaño and Engr. Mari-len Montoya Capisanan.

APAA 2014 PATENT COMMITTEE REPORT – SINGAPORE

1. Singapore Patent Office Statistics 2013–2014

No. of Applications Filed	9,722 in 2013 10,312 in 2014
No. of Applications Registered	5,575 in 2013 5,538 in 2014

2. Changes to Singapore's Legislation

2.1. Effective from 14 February 2014, the Patents Act has been amended to shift Singapore's patent system from a "self-assessment" patent system to a "positive grant" patent system. Under the new positive grant patent system, only patent applications that fully meet all the patentability requirements can proceed to grant.

2.2. The Statutes (Miscellaneous Amendments) Act 2014 (the "**Amendment Act**") came into operation on 10 March 2014. The Amendment Act effects changes to the Trade Marks Act, Patents Act and Registered Designs Act. The key amendments relate to the definition of "related national phase application" in the Patents Act, the set of administrative conditions that must be complied with before patents are granted, and the appointment of IP Adjudicators at the Registry of Trade Marks, Registry of Patents and Registry of Registered Designs.

2.3. As part of the IPOS efforts to be more business-friendly and improve the transparency of information relating to interests in registered IP, the recording of express trusts and beneficiaries of express trusts on the Trade Marks Register, Patents Register and Registered Designs Register has been made available from 30 April 2014.

3. Practice Changes

3.1. The IPOS and the Mexican Institute of Industrial Property have signed a memorandum of understanding (the "MOU") to strengthen bilateral cooperation between the two offices on IP matters. Under the agreement, both offices will work together to develop mechanisms that improve the quality and efficiency of patent application procedures. Other key areas of collaboration include sharing of knowledge to assist industry partners such as Small-and-Medium-Enterprises (SMEs) to better manage their IP, and pooling of best practices in raising public awareness of IP.

3.2. On 29 October 2013, the IPOS and the State Intellectual Property Office of the People's Republic of China entered into an agreement to exchange intellectual property ("IP") information and patent data.

3.3. The IPOS and the German Patent and Trademark Office have signed a Memorandum of Understanding (the "MOU") that provides an umbrella framework for future cooperative initiatives and work sharing between the two offices. The agreement will allow both offices to work together to develop a patent prosecution highway (PPH) program.

3.4. Since 19 February 2014, applicants and businesses alike can use the simpler, faster and more cost effective IP2SG, an all-new integrated e-services portal, to file patent applications online. IP2 is the acronym for Integrated Platform for Intellectual Property.

3.5. With effect from 1 April 2014, there is a new option for patent disputes filed at a national IP office which allows disputing parties to submit issues to an expert of their choice to make an assessment.

3.6. From 14 April 2014, the IPOS has commenced a two-year Patent Prosecution Highway ("PPH") pilot program with the Mexican Institute of Industrial Property of the United Mexican States (the "IMPI"). This PPH pilot program allows patent applicants who have first filed a patent application in Singapore and who are looking to file a patent application for the same invention in Mexico, to take advantage of expedited examination at the IMPI.

3.7. The IPOS signed a Memorandum of Understanding (the "MOU") with the National Office of Intellectual Property of Vietnam to enhance cooperation between the two IP offices.

3.8. This MOU provides a framework for cooperative initiatives between the two offices. Under the MOU, both offices look to further cooperation on exchanges to engender greater mutual trade flow and understanding of each office's best practices in substantive examination, human resource development, IP systems and quality management.

3.9. On 23 September 2014, the Intellectual Property Office of Singapore (the "IPOS") announced that it will launch a comprehensive Patent Prosecution Highway (the "PPH") pilot program together with the European Patent Office (the "EPO") for the accelerated treatment of patent applications with effect from January 2015.

3.10. From 1 November 2014, Singapore will be part of a Global Patent Prosecution Highway ("GPPH") network, which allows for the sharing of patent search and examination results amongst 17 participating IP offices around the world.

3.11. From 1 October 2014, the Intellectual Property Office of Singapore (IPOS) has commenced a two-year Patent Prosecution Highway (PPH) pilot programme with the German Patent and Trade Mark Office (DPMA).

3.12. Singapore has become an intellectual property hub of Asia with the official appointment of the IPOS as an International Authority in Patent Search and Examination, specifically as an International Searching Authority ("ISA"), and International Preliminary Examining Authority ("IPEA") under the Patent Cooperation Treaty (the "PCT"). The PCT is an international patent filing system, administered by the WIPO. The PCT system assists businesses and inventors to seek patent protection amongst the 148 countries through a single international patent application.

3.13. The IPOS also signed a series of bilateral agreements with the European Patent Office ("EPO"), the German Patent and Trade Mark Office ("DPMA"), and the Russian Federal Service for Intellectual Property ("Rospatent") to enhance patent connectivity, on the sidelines of the WIPO Assemblies.

3.14. The IPOS signed an MOU with the OHIM to collaborate on quality management and training in trademark examination. This is part of the IPOS' efforts to promote information sharing and IP cooperation, so as to ease Singapore businesses' entry into global markets.

3.15. S$100 million IP Financing Scheme has been launched under which patents can now be taken as a collateral for bank loans.

3.16. Law Society of Singapore, Association of Singapore Patent Agents and Institution of

Engineers Singapore have partnered with IPOS to develop IP professionals.

3.17. Productivity and Innovation Credit ("PIC") Scheme has been introduced. PIC Scheme will be extended for three years till Year of Assessment ("YA"), 2018.

3.18. IP ValueLab has been launched which would be Singapore's new intellectual property (IP) management and strategy lab.

4. Some Significant Court and Designs Office Decisions

4.1. *Genpharm International Inc. v. Lonza Biologics Tuas Pte Ltd.* [(2014) SGIPOS 9]

Correction is the alteration of a document so that it may better express the intention the drafter had at the time of drafting. In contrast to amendments, a correction may result in the document disclosing new matter or extending the scope of the patent (*Rock Shing Industrial Ltd v. Braun,* BLO/138/94). Once a correction is made the document is considered to have always been in the state in which it is after correction. This means that a correction could result in something becoming an infringement which was not previously an infringement. However, Rule 91 requires that it must be immediately evident that nothing else would have been intended than what is offered as the correction, so that the skilled person reading the document would immediately ascertain that there was an error and correct it. In the instant case, the evidence established that certain errors were obvious and therefore they could be allowed. However, in relation to some of the other corrections sought, the evidence did not establish that there was an obvious error, or where there was an obvious error, the evidence showed that there was more than one feasible correction. These corrections were thus refused.

5. Contributed by

Low Pei Lin.

APAA 2014 PATENTS COMMITTEE REPORT – SRI LANKA

1. Sri Lanka Patent Statistics 2013–2014

No. of Applications Filed	516 (406 in 2014)
No. of Patents Granted	236 (178 in 2014)

2. Changes to Sri Lanka's Legislations

NA.

3. Practice Change

There have been changes in the practice of the Court Registry pertaining which it is no longer possible for a person/lawyer other than a party/lawyer to a case to obtain certified copies of pending case records so we are unable to update this report at present.

4. Some Significant Court and Office Decisions

Unreported Cases:

4.1. *Lignocell Ltd. v. Cocos Lanka Exports (Pvt.) Ltd.* [HCC 30/2001(3)]

The suit in this case was filed on grounds of inventive step and obviousness challenging the validity of patents. The interim injunction sought was refused on the ground that the patent of the Plaintiff in respect of a 'Squeezer Machine' prima facie lacked an inventive step. The case was settled.

4.2. *K.H. Amarasiri v. Clipsal Lanka (Pvt.) Ltd.* [HCC 31/2003(3)]

The Plaintiff in a patent involving "meter boxes" relied on the commercial success of the invention as a measure of evaluating the assertion of the inventive step. Even though the case was eventually settled, the Order delivered on the objections raised to the issues framed by the Defendant stated that "it is necessary for the Plaintiff to prove the ingredients mentioned in sections 63 to 65 in the Act in establishing that he has a valid patent". Sections 63 to 65 of the Intellectual Property Act discuss the aspects of "patentable inventions", "novelty" and "inventive step" respectively.

4.3. *Nikini Automation Services (Pvt.) Ltd. v. Jinasena Engineering Technologies (Pvt.) Ltd*. [HC Civil 35/2000]

The Plaintiff sued the Defendant alleging infringement of its patent in respect of a "Pneumatic Tea Roller".

4.4. *Nikini Automation Services (Pvt.) Ltd. v. Frank Warnakulasooriya* [HC Civil 33/2001]

The Plaintiff sought a declaration that the Defendant's patent in respect of an "Isothermal Tea Roller" is null and void. The said patent had been assigned to Jinasena Engineering Technologies (Pvt.) Ltd. ("the added Defendant") who sought to have the Plaintiff's action dismissed on grounds that the Defendant who was the registered owner of the patent assigned his rights in the same to the added Defendant by way of Deed of Assignment, thus the Plaintiff was not entitled to a declaration of nullity as prayed for, in that, *inter alia*. It was held that the registered patent assigned to the added Defendant did not violate the purported patent of the Plaintiff. The case has been settled.

4.5. *Michael Laurents Cyrille Caderamanpulle v. Quikpak (Pvt.) Ltd.* [HC Civil 38/2000(03)]

The Plaintiff in this case sued the Defendant alleging infringement of its patent in respect of a "Rigid T Sack (Valve Type)" and sought *inter alia* a permanent injunction restraining the Defendant exploiting the patent registered to him. However, the Defendant argued on grounds of section 68(3) of the Act, alleging that the plaintiff had had kept the method of construction as a trade secret. However, the injunction was granted and it was held that the Plaintiff was not on bound to disclose every minute detail of his invention.

4.6. *Michael Laurents Cyrille Caderamanpulle v. Mohamad Haniffa Mohamad Ajmal, Quikpak (Pvt.) Ltd.* [HC Civil 33/2004(03)]

The Plaintiff sought *inter alia* a declaration that the Defendant's patent in respect of a "Recyclable Eco Friendly Tea Sack" is null and void. The interim injunction sought was refused on the grounds that the Court lacked the necessary evidence to make the right decision and as such it is the duty of the Court to make an order that will maintain the status quo.

Pending Cases:

4.7. *TVS Motor Company Ltd. v.Bajaj Auto Ltd. & DGIP* [HC Civil 22/2012]

The Plaintiff initiated proceedings seeking a declaration that the Defendant's patent in respect to an "Improved Internal Combustion Engine Working on Four Stroke Principle" is null and void on the basis that it is not novel.

5. Contributed by

John Wilson.

APAA 2014 PATENT COMMITTEE REPORT – TAIWAN

1. Patent Statistics Year 2013 (Sep. 2013–Aug. 2014)

No. of Applications Filed	83,211 (Inventions: 49, 218 & Utility Model: 25,025)
No. of Registration Certificates Issued	NA.

PPH Applications between TIPO and USPTO in 2014:

No. of domestic applications	13
No. of foreign applications	279
Total	292

*Compared to 2012, overall patent applications in 2013 by Taiwan nationals (50,714) and non-nationals (32,497) slumped 3.43% and 0.19%, respectively. Among top three patent filing countries, Japan (14,013) topped the chart, the U.S. (8,432) came second and the Republic of Korea (2,336) reclaimed its third position by outnumbering Mainland China.

In the last one year, there has been an 8.14% drop in overall patenting activities, brought down mainly by decrease in both domestic and foreign invention patent applications. Hon Hai Precision Industry Co., Ltd., the all-time leader in domestic invention filing, saw a 73.03% plunge. This is because of a 10.81% decrease in invention applications (10,462), the greatest drop since Q3 2009. Domestic filings (4,435; –16.43%) were down mainly by a 23.74% slump in corporate applications (3,006); an increase in applications filed by non-corporate nationals (772; +16.27%), however, did little to break this downward spiral. Likewise, decrease in the number of foreign corporate applications (5,814; –5.91%) also brought down overall foreign applications (6,027; –6.17%).

2. Changes to Taiwan's Legislation

2.1. Patent Law Amendment Concerning Border Protection Measures for Patents effective on 24 March 2014:

Legislative Yuan in Taiwan passed Patent Law Amendment concerning border protection measures for patents in January, 2014. The amendment includes addition of four border protection provisions (Article 97-1 to 97-4) and a wording revision in Paragraph 2 of Article 143. The amendment came into force on 24 March 2014. The purpose of the amendment is to strengthen the protection of patentees. Having consulted relevant foreign legislations, Taiwan's Trademark Act and Copyright Act, a mechanism of "request to detain" has been introduced to the Patent Act according to which, a patentee may provide security and request the customs to detain importing goods suspected of infringing the patent right.

2.2. TIPO and JPO to modify current PPH and pilot run PPH Mottainai for three extended years starting 1 May 2014

TIPO-JPO Patent Prosecution Highway (PPH) pilot program currently underway has been modified to PPH Mottainai and extended for three years starting 1 May 2014. This modified pilot will allow for greater conveniences to applicants and further accelerate patent examination at both offices. Considering the success of this program, which expires by the end of April 2014, both offices have agreed to modify the current program into PPH Mottainai and continue its pilot run for three more years starting 1 May 2014. Under this new pilot, the examination result of the office of first filing (OFF) no longer has primacy over that of the office of second filing (OSF). The new pilot not only will facilitate greater conveniences to applicants but also spur patent examination at both offices.

2.3. Amendment of Intellectual Property Cases Trial Law effective on 6 June 2014

An amendment of the Intellectual Property Cases Trial has been effective since 6 June 2014. It adds duties which shall be performed by a technical examination officer in accordance with a court order (Article 4). It further provides for judicial proceedings of trade secrets infringement cases. Also, the amendment specifies that an appeal against a ruling of first instance regarding an intellectual property case shall be filed in the competent Intellectual Property Court. It further specifies that the prosecution of criminal cases stipulated under the former part of sub-paragraphs 2 and 4 of Article 3 of Organic Act for Intellectual Property Court shall be filed in the competent district court. Lastly, the amendment states that administrative litigation cases stipulated under sub-paragraphs 3 and 4 of Article 3 of Organic Act for Intellectual Property Court shall be under the jurisdiction of Intellectual Property Court.

3. Practice Changes

3.1. Accelerated Examination available for Green Tech Patent Application since 1 January 2014

On 1 January 2014, TIPO added a condition – Condition 4 – for the inventions relating to green tech under the Accelerated Examination Program (AEP) and began accepting requests in order to encourage the development of the green industry and enhance patent predominance of green technology in Taiwan. The green technology, in Condition 4 of AEP, is defined in a broad sense for encouraging the green technology-related applicants to utilise the AEP in case of applications related to technical field involving energy conservation, new energy, or new-energy vehicles, etc. or invention involving carbon reduction or resource-saving. When an applicant employs Condition 4 to request for AEP, only relevant documents of the applied green technology need to be attached and compared with the first OA pendency of 29 months for general applications, a faster OA will be issued by TIPO within nine months for Condition 4 applications.

4. Some Significant Court and Trademark Office Decisions

NA.

5. Contributed by

Shen-Yee Tu.

APAA 2014 PATENT COMMITTEE REPORT – VIETNAM

1. Vietnam Patent Statistics 2013–2014

No. of Applications Filed	4169 (3726 foreign)
No. of Patents Granted	1262 (1203 foreign)

2. Changes to Vietnam's Legislations

There have been no substantial changes in the patent law in Vietnam

3. Practice Changes

There have been no substantial changes in the regulations or patent practice in Vietnam

4. Some Significant Court and Office Decisions

There have been no patent-related court decisions of particular interest in the last year.

5. Contributed by

NA.

APAA 2014 COPYRIGHT COMMITTEEE REPORT – AUSTRALIA

1. Copyright Statistics Year 2013

No. of Applications Filed	NA.
No. of Registration Certificates Issued	NA.

2. Changes to Australia's Legislation

2.1. Amendments to the Copyright Act 1968

Minor revisions to the Copyright Act 1968 were made by The Statute Law Revision Act (No. 1) 2014. Example: removal of redundant definitions. No substantive changes expected before mid 2015 since IP legislation is not high priority for the new Federal Government currently.

2.2. Australian Law Reform Commission (ALRC)

On 13 February 2014, the ALRC published a significant report on "Copyright and the Digital Economy" that was tabled in Federal Parliament by the Attorney-General. It recommended repealing of the "fair dealing" concept and introduction of "fair use exception" (against infringement) and that "fair dealing" exceptions apply only for following purposes of research or study, criticism or review; parody or satire; reporting news; or professional advice. Further, the ALRC published that "fair use" exception shall only be applied if the use is fair; fairness factors being purpose and character of the use, nature of the copyright material, amount and substantiality of the part used and effect of the use upon the potential market. Further, ALRC proposed a second-best position, where the existing fair dealing exception would be confined to a set of prescribed purposes only. A Court considering whether the use of copyright material fell under the fair dealing exception would have to consider the use for the prescribed purposes and the fairness factors.

2.3. Other Recommendations Include

The ALRC concluded that there should not be statutory limitations on parties' ability to contract out of the proposed fair use exception; retaining and reforming some specific exceptions to copyright infringement; and adding new exceptions such as a public use exception and a library and archives exception; reforming the statutory licensing schemes for education and the Crown, to streamline them and make them less rigid and prescriptive; reforming the broadcasting exceptions; and Limitation of remedies e.g. to promote the use of orphan works. The Attorney-General has indicated the Government will provide its response in the first quarter of 2015.

3. Practice changes

NA.

4. Some Significant Court and Trademark Office Decisions

4.1. *Vaysman v. Deckers Outdoor Corporation Inc.* [(2014) FCAFC 60]

Vaysman was a repeat copyright and trademark infringer in respect to the use of various UGG marks; and the manufacture and sale of counterfeit UGG boots. Vaysman appealed against a sentence of three years, and varying sentences of between seven days and six months, to all be served concurrently, issued in April 2010, for contempt of Court. He had moved overseas and declared bankruptcy before the sentences were handed down; and was imprisoned on his return to Australia in mid-2013. The Full Court allowed the leave to appeal, although filed out of time; and reduced the three-year sentence to two years. The Court decided that, while comparable sentences of not more than 12 months had been imposed, the various serious nature of Vayman's conduct, the three-year sentence should only be reduced to two years.

4.2. *Tyler v. Sevin* [(2014) FCCA 445]

Tyler is a US-based photographer who sells and licences his works as stock photographs; and Sevin is a travel agent whose business is conducted over the Internet. She used one of Tyler's photographs without obtaining a licence from him, and would not take down the photograph. Sevin did not file a defence or otherwise participate in the proceedings. The copyright infringement claim was straightforward, and Tyler was awarded US$1,850 (reflecting his usual licence fee). In relation to Tyler's claim for additional damages, his Honour felt the flagrancy of infringement was at the lower end of the scale; but decided the Court should made clear that this type of conduct cannot continue. Tyler was awarded a further $12,500 in additional damages and costs of $9,500 – both much greater than the general damages awarded.

4.3. *Seafolly Pty Ltd. v. Fewstone Pty Ltd.* [(2014) FCA 321]

Seafolly took copyright infringement action against Fewstone (trading as City Beach) for allegedly copying its top bikini designs – the English Rose print bikini, Covent Garden floral design and Senorita prints. The Federal Court found that City Beach had copied the designs and sold the bikinis through over 50 stores nationwide. The Court found that City Beach had taken the design elements of layout, selection, arrangement and style; even though there were many differences between the visual elements in the competing designs. The Court has made it clear that designs must be original, and should not rise on the coat tails of others' successful designs. The Court awarded total damages.

5. Contributed by

Grant Adams.

APAA 2014 COPYRIGHT COMMITTEEE REPORT – HONG KONG

1. Copyright Statistics Year 2013

No. of Applications Filed	NA.
No. of Registration Certificates Issued	NA.

2. Changes to Hong Kong's Legislation

2.1. Copyright Amendment Bill 2014 ("2014 Bill")

The Hong Kong Government attempted to re-introduce the Copyright (Amendment) Bill 2011 that was withdrawn in June 2012. It addressed the same issues from the 2011 Bill, main concern being to maintain balance between copyright protection and the right to freedom of expression.

2.2. Technology-Neutral Exclusive Right

The above mentioned amendment introduces a form of communication right that enables law to protect existing and future modes of communication of copyright works. Further, it introduces criminal liability against unauthorised communication of copyrighted works to the public and potentially impacts the free flow of information across the Internet. It further provides that court can examine circumstances of a case. It also offers guidance as to the meaning of causing prejudice to the copyright owner.

2.3. Expand Scope of Fair Dealing Exceptions and Copyright Exceptions

There was a public concern that the 2011 Bill may curtail use of parody and freedom of speech. To balance between this, the said Bill proposes to include the following acts wherein individuals are exempted from criminal and civil liabilities when they use copyrighted works for these purposes of parody, satire, caricature and pastiche; commenting on current events; quotations and online Service Providers (OSPs) caching data.

2.4. Safe Harbour for OSPs

Further, the 2014 Bill introduces a mandatory "safe harbour" for OSPs. This provides shelter to OSPs from infringement on their platform if the OSPs meet certain conditions.

2.5. New Factors for Assessing Additional Damages

Lastly, the amendment proposes that the court may, apart from normal damages for losses suffered by copyright owners due to infringement, award additional damages under the Copyright Ordinance in certain cases.

3. Practice Changes

NA.

4. Some Significant Court and Trademark Office Decisions

4.1. *MGX Asia Ltd. & Anr. v. China Way Global Company Ltd. & Ors.* [(2014) KEC 246]

An application for interlocutory injunction by Plaintiffs to restrain Defendants from infringing former's copyright over several product drawings of motorcycle locks, which were sold by the Plaintiffs under the trademark "Xena". Defendants used to be business partners with the Plaintiffs and sold almost identical product under the registered trademark "Kovix". The issue was to determine who the author of these lock design drawings was and who owned copyright in them. The Court refused the application due to the absence of a properly pleaded case in relation to the copyright claim and the risk that the Defendants would not have the opportunity to respond to the newly pleaded case. The Court ordered both parties to agree on a set of directions set by court and the undertaking signed by Defendant to not engage in trademark infringement activities and to keep proper sales records.

4.2. *Tong Wai Man & Ors. T/A Islam Food* 清真牛肉館 *v. Tam Lun Sang T/A* 北京清真牛肉館 [(2013) HKCU 2787]

Plaintiff's restaurant business 清真牛肉館 Halal Beef Shop is well-known for its gravy-exploding "beef bun". The Defendant, who was a former employee of the Plaintiff opened a restaurant called 北京清真牛肉館 [Beijing Halal Beef Shop] without the Plaintiff's authorisation that sold similar dishes as that of the Plaintiff. The court found that the Plaintiff had ownership of copyright over both the literary and graphical elements of the menu and that the Defendant had infringed several registered trademarks of the Plaintiff by opening a restaurant of a similar name, and also infringed its copyright by using a substantially identical menu without the Plaintiff's consent. The Court therefore held that the Plaintiff was entitled to compensation for trademark infringement and passing off. A separate award of damages for the copyright infringement was rejected to avoid the risk of double recovery.

4.3. *MGA Entertainment v. Toys & Trends (Hong Kong) Ltd.* [(2014) HKCU 293]

This judgement concerned the enforcement of a cross-undertaking of damages in a copyright infringement action. Plaintiff, the copyright owner of a fashion doll, Bratz Dolls, alleged that the defendants infringed its copyright by marketing a range of dolls, named Funky Tweenz dolls. An interim injunction against the defendants was granted by the court. On the first day of the trial, the Plaintiffs applied to discontinue the action and discharge the injunction. It further sought to enforce cross-undertaking of damages to recover damages due to the enforcement of the injunction. The Court of First Instance and Court of Appeal held that there was limited evidence available regarding the Funky Tweenz dolls which were marketed for only half a year before the injunction was granted, due to which it was reasonable to make a comparison with other businesses in the same trade in order to assess the losses of Plaintiff. The court held that a ten-year product lifespan for the dolls was inappropriate and the normal product cycle for the dolls is approximately two years, especially because Plaintiff had no feasible plan to expand the lifespan of its product. Accordingly, the Court held that loss should be based on a two-year product cycle, totalling US$450,000 only

5. Contributed by

Tan Loke-khoon.

APAA 2014 COPYRIGHT COMMITTEE REPORT 2014 – INDIA

1. Copyright Statistics Year 2013

No. of Applications Filed	NA.
No. of Registration Certificates Issued	NA.

2. Changes to India's Legislation

There were no legislative developments this year.

3. Practice Changes

3.1. E-Filing of Copyright Applications – The system of electronic filing has been introduced and electronic filings of Copyright Applications have begun.

3.2. Digitisation of Data & Online Search Facility – The data relating to copyright applications and registrations is now available online and open to public search.

4. Some Significant Court and Trademark Office Decisions

4.1. *Multi Screen Media Pvt. Ltd. v. Sunit Singh & Ors.* [CS (OS) 1860/2014]

A significant case seeking John Doe orders ("Ashok Kumar" orders) and reliefs. The Plaintiff, having the sole and exclusive right to the broadcast reproduction rights in the 2014 FIFA World Cup filed suit for permanent injunction against the world at large from hosting, streaming, broadcasting, rebroadcasting, retransmitting, exhibiting, making available for viewing and downloading etc., channels of Plaintiff in relation to 2014 FIFA World Cup in any manner or do any other thing which infringes the Plaintiff's broadcast reproduction rights. The Plaintiff also filed a suit for permanent injunction against 473 websites stating that they were infringing the exclusive rights of the Plaintiff. One of the Defendant ISPs, Bharti Airtel submitted that not all websites were rogue websites. As a result, Plaintiff amended the list to 219 rogue websites. An *ex-parte* injunction was granted by the Hon'ble Court. The said case is relevant as it was the first case in which the Court gave a direction to the Department of Telecommunications and the Department of Electronics and Information Technology to ensure and secure compliance of the said order by blocking access to websites identified by the Plaintiff.

4.2. *Institute for Inner Studies & Ors. v. Charlotte Anderson & Ors.* [2014 (57) PTC 228 (Del) : MIPR 2014 (1) 129]

Hon'ble Delhi High Court discussed scope of Copyright Law w.r.t. literary works and laid distinction between realms of Copyright protection as opposed to Patent protection.

The Plaintiffs filed suit praying for injunction against Defendants to restrain Defendants from spreading Pranic Healing teachings, techniques, practices, courses invented by Master Choa

Kok Sui ("Master") and organising workshops without authorisation from plaintiffs. They claimed copyright on Books written by master, trade literature, CD Roms etc., material stated in the books and panic Healing techniques and exercises under "dramatic works". The Court observed that copyright subsist over manner of description of the art principles, in language and arrangement employed and not over the art or its performance itself, for example: asanas. Further, the Court held that rights asserted over asanas would be available under Patent laws and not Copyright law. Lastly, the Court held that arguments regarding yoga are not patentable and therefore rejection of claim of copyright would render the Plaintiffs remediless. Asanas of Pranic Healing could not be brought under definition of "dramatic work" under Copyright Law.

4.3. *Tech Plus Media Pvt. Ltd. v. Jyoti Nanda & Ors.* [2014 (60) PTC 121 (Del)]

Hon'ble Delhi High Court dismissed suit by Plaintiff against its ex-employee which claimed copyright infringement of its database of users holding that the database was just a collection of e-mail addresses and Plaintiff could not have "authored" such database. Although databases are included within the definition of literary work, Hon'ble High court relied upon the landmark decision of the Supreme Court in *Eastern Book Company v D.B. Modak* [AIR 2008 SC 809 : (2008) 1 SCC 1].

4.4. *M/s. Jagdamba Impex v. M/s. Tristar Products Pvt. Ltd.* [2014 (59) PTC 149 (Del) : MIPR 2014 (2) 164]

This case clearly lays down that section 14 does not have overriding effect over section 15(2) of the Copyright Act. Therefore, even though Copyright Act confers on the owner of copyright in an "artistic work", right to depict the same in two and three dimensions, if the artistic work comes within the definition of "design" and has been produced over 50 times, copyright can no longer be enforced.

4.5. *Ramesh Sippy v. Shaan Ranjeet Uttamsingh & Ors.* [MIPR 2014 (1) 32]

Appellant claimed to be "author" and "first owner of copyright" in the cinematograph film *Sholay* and thereby was entitled to "author's special rights". Appellant claimed to be solely responsible for the making of the film, except for financing. Appellant contended that Sippy Films provided finance for film, but he alone took initiative and responsibility for the film and authored it and thereby was the owner of copyright of the film *Sholay*. Accordingly, the Appellant prayed to restrain Respondents from releasing 3D version of the film as he entrusted to Sippy Films distribution and exhibition rights in 2D format only. Respondents contended that the Appellant's father was responsible for the making film, not the Appellant. Court observed that the Appellant's conduct after release of the film is crucial in deciding the case. The Appellant was aware of a 3D version prior to filing the suit and had no objection to the same. Since the film's release, the Appellant never defended his rights and when others asserted these very rights, the Appellant now contends.

The Court agreed that authorship of a work comes into existence only when work is complete and film was completed only post retirement of appellant from the partnership firm. Held that appellant could not make out a *prima facie* case of copyright infringement and dismissed the infringement suit.

4.6. *Paragon Rubber Industries v. Pragati Rubber Mills & Ors.* [2014 (57) PTC 1 (SC) : 2013 (14) SCALE 273]

This case settled the law relating to jurisdiction in the case of composite suits. The issue was whether a composite suit would be maintainable wherein the Court has jurisdiction

to grant relief prayed for under the Copyright Act, 1957 but not for the relief prayed for under Trade & Merchandise Act, 1958. Plaintiff filed a composite suit under The Copyright Act, 1957 Act and The Copyright Act, 1958 Act. Although the Court had jurisdiction under 1957 Act, the Court lacked jurisdiction under 1958 act as neither were the Defendants goods available within the jurisdiction of the Court, nor did the Defendants carry on business and reside within the jurisdiction of the Court. The Supreme Court held that such suit is not maintainable unless court has jurisdiction to entertain the suit in relation to entire cause of action and relief.

4.7. *Tekla Corporation & Anr. v. Survo Ghosh & Anr.* [AIR 2014 Delhi 121 : MIPR 2014 (2) 264 : 2014 (59) PTC 323 (Del)]

Hon'ble Delhi High Court refused to recognise defence of "copyright misuse" holding that nothing outside section 52 which provides exhaustive list of defenses to copyright infringement could constitute a valid defense. The court rejected this defense and held that this would "*tantamount to allowing a person to unilaterally decide that the owner has lost the copyright for the reason of misuse thereof and to thereby usurp the rights otherwise exclusively vested in the owner*".

4.8. *King.com Limited v. Apeejay Surrendra Park Hotels Ltd.* [Suit No. 576 of 2014]

Hon'ble Bombay High Court granted an order of injunction restraining the defendant from using the images of "Candy Crush Saga" game in relation to its online advertisements for a live music gig.

4.9. *Pepsico Inc. v. PSI Ganesh Marketing & Anr.* [MIPR 2014 (2) 240 : 2014 (59) PTC 275 (Del)]

Hon'ble Delhi High Court awarded punitive damages of about US$ 8000 against the Defendant for infringing Copyrights in the artistic label "AQUAFINA" of the Plaintiff, who chose to remain *ex-parte*. Similar orders as to punitive damages were passed in *Atlantic Industries & Ors. v. Simron Food Processors (P) Ltd.* [MIPR 2014 (2) 344]

5. Contributed by

Gaurav Miglani, Sudeep Chatterjee and Chetan Chadha.

APAA 2014 COPYRIGHT COMMITTEEE REPORT – INDONESIA

1. Copyright Statistics Year 2013

No. of Applications Filed	NA.
No. of Registration Certificates Issued	NA.

2. Changes to Indonesian Legislation

On 16 September 2014, Ministry of Justice and Human Rights Republic of Indonesia ("**Ministry**") introduced a new Copyright Law replacing the existing Copyright Law No. 19 of 2002. In the meantime, the approval draft is waiting for the President signature for its legal enactment.

The new Copyright Law has revised and introduced certain amendments and issues. Certain revision can be recognised in Article 1 which introducing new definition among others as "fixation; phonogram; duplication; royalty; CMO; piracy; 'commercial use'; and claim damage". Remarkable points under the new Copyright Law:

2.1. Provides a longer validity protection period from 50 years to 70 years after Author's death. The validity of protection are defined into two categories, namely, Validity on Morale Right and Validity on Economic Right.

2.2. Provides a better protection on economic right for the Creators and/or the owners of related rights, including the limitation on transferring of economic right in the form of sold flat/final selling agreement.

2.3. Efficient settlement on legal dispute through mediation, arbitration or court as well as implementation of filing complaint for criminal suit.

2.4. The Commercial Court may issue a preliminary injunction, upon a request of the parties who experience loss due to the implementation of copyright or its related rights, for the purpose of preventing the trading route from the entrance of pirated goods; withdrawing from the goods from its distribution and seizing them as well as storing them used as an evidence; securing all the evidences and/or preventing its vanishing (the evidences) by the infringer; and/or stopping the infringement actions in order to prevent a more extensive loss.

2.5. Criminal Sanction and/or Fine in case of infringement of economic rights as set out of publishing, copying, distribution of the work for commercial purposes, maximum imprisonment of four years or fine of at most Rp. 1,000,000,000/- (one billion Rupiah). Piracy can lead to a maximum imprisonment of at most 10 years and/or fine of at most Rp. 4,000,000,000 (four billion Rupiah) and a criminal fine of Rp. 100,000,000 (one hundred million Rupiah) for the management of a trade centre who recognises and deliberately allows the sale and/or reproduction of goods resulting from violation of copyright and/or related right within their trade centre. Managements of trade center responsible for their trading area.

2.6. Copyrights as unmovable and intangible goods can be used as a fiducia security object.

2.7. Ministry is authorised to delete a recorded Copyrights IF the respective copyright is contradicting with the religion norm, social norm, public order, state defense and security as well as prevailing rules and regulation.

2.8. CMO has an operational permit and compliance.

2.9. The using of copyright and related right in the multimedia facility to response the development on information technology and communication, Government is authorised to:

(a) supervise creating and distribution of infringing copy right content and related rights;

(b) domestic and international cooperation and coordination with other party, to prevent creating and distribution of infringing content; and

(c) supervise recording actions by the use of any media against a work and product related right product in the performance site.

3. Practice Changes

Implementation of National Collective Management Organization ("NCMO") in Indonesia in the future.

The NCMO is expected to be an independent and professional agency. The agency should be led by members with integrity and competence, and authority. This agency will hopefully set the standards in Indonesia on procedures for royalty collection, minimum royalty collection, and the distribution of royalties among the Creator, the Copyright Holder, Holder of Related Rights (Performers, Producers of Sound Recordings and Broadcasting Agency) through one door.

In the future, the NCMO is expected to be able to accommodate the interests of creators and copyright holders. Both parties are parties that are often disadvantaged because Indonesian people as copyright users have not realized the importance of intellectual property rights, in this case a person's work that should be rewarded more. Moreover, the government should be able to provide clearer instructions to the CMOs about the procedures of Calculation and imposition of royalties, because the provisions of Article 80, paragraph 5, together with its elucidation, can still be interpreted widely by each party.

4. Some Significant Court and Trademark Office Decisions

4.1. *Soekarno Movie Case*

The Plaintiff, the author of the movie script sued the producer and the director requested the court for preliminary injunction by way of non-screening, material damages in the amount of IDR 100 (around US$ 0.0001) and immaterial damages in the amount of IDR 100 and confirmation on the existing copyright infringements made by the Defendants on the movie script or copyright work. The Commercial Court confirmed the Plaintiff's request to punish the Defendants for material and immaterial damages as requested but eliminated the request to confirm the existing copyright infringements made by the Defendants on the movie script or copyright work.

Against the Commercial Court decision, the Defendants filed a cassation to the Supreme Court and the Supreme Court issued their decision on 19 August 2014 in favour of the Defendants and cancelling the decision of the Commercial Court as the first instance court. At present, the Plaintiff considers to file a petition for review to the Supreme Court.

5. Contributed by

Frans Hendra Winarta and Rahajeng Handayani.

APAA 2014 COPYRIGHT COMMITTEE REPORT 2014 – JAPAN

1. Copyright Statistics Year 2013

No. of Applications Filed	NA.
No. of Registration Certificates Issued	NA.

2. Changes to Japan's Legislation

2.1. The Copyright Act

The Act was amended in June 2014, and came into effect on 1 January 2015. The right of publication which was previously intended only for paper media is now also intended for electronic books, in favour of a person who undertakes either the act of publishing the work in a document or picture or an act of transmitting the work via the Internet using a duplication of a copyrighted material recorded in a recording medium.

The right of duplicating the work as a document/ picture can be for the purpose of distribution or for transmitting the work via the Internet.

3. Practice Changes

NA.

4. Some Significant Court and Trademark Office Decisions

4.4. *PACHINKO "Great Magistrate KIN-san" Case* (Tokyo Dist. Ct. Hei 24 (Wa) 964)

The Plaintiff owns copyrights of his cinematographic works, a TV series which has the basic structure in common wherein Magistrate TOYAMA does undercover investigation on an affair as playboy KIN-san. PACHINKO is a game originating in Japan like KARAOKE and is used frequently as a gambling device comparable to a slot machine in Western gaming. The object of the game is to capture as many balls as possible that are exchanged for prizes. The Defendant manufactures and sells the modern PACHINKO as "Great Magistrate KIN-san" with the display of Defendant's Video, which has been taken by the Defendant according to the above basic structure similar to that of the Plaintiff. The issue is whether the Defendant's video is a reproduction/ adaptation of the Plaintiff's cinematographic works. The Court ordered the Defendant to pay to the Plaintiff damages for infringement of the reproduction right and distribution right. The Court ruled that if the same part is not an expression but an idea; or lacks creativity in expression, no reproduction and adaptation may be found. Further, for evaluation of creativity in expression of cinematographic works as derivative works, creative elements in pre-existing works such as scenarios shall be exclude. Lastly, the Court ruled that it is not necessary to exclude the act by an actor from evaluation of creativity in expression of cinematographic works. The Court found that two scenes are respectively a reproduction of the corresponding scenes of the Plaintiff's cinematographic works although other scenes are not.

4.5. Shin Umeda City Garden Case (Osaka Dist. Ct. Hei 25 (Yo) Z0003)
(The Court analogically applied the rules on architectural works to a modification performed on a garden and decided that it did not infringe the moral rights of the author)

Sekisui House, a homebuilder, constructed a garden designed by Motoo Yoshimura, a garden designer. Subsequently, Sekisui House attempted to add an additional structure to the garden, which architect Tadao Ando designed, called *Kibo no Kabe* (the "Wall of Hope"). This is a case where the garden designer (Motoo Yoshimura) requested that a provisional disposition be given to prevent the installation of said additional structure on the grounds that it would infringe the moral rights of the author. The court applied the rules on modifications to an architectural work (Article 20 (2) (ii) of the Copyright Act) analogically to this case and denied Yoshimura's motion to stop the installation of the Wall of Hope. However, the Court did grant the motions of the garden designer requesting that the garden be considered a copyrighted work, the garden designer be viewed as the author of the work, and that the installation of the Wall be recognised as an act against the will of the author. This case was the first judicial precedent in Japan, in which a garden that stood independently of the adjoining structures was considered a copyrighted work.

5. Contributed by

Takao KOHNO, Kei IIDA and Takahito HATAZOE.

APAA 2014 COPYRIGHT COMMITTEEE REPORT – KOREA

1. Copyright Statistics Year 2013–2014

No. of Applications Filed	NA.
No. of Registration Certificates Issued	NA.

2. Changes to Korean Legislation

None.

3. Practice Changes

NA.

4. Some Significant Court and Trademark Office Decisions

4.1. *Michael Kenna v. Korean Air* (2013 GaHap 527718)

A well-known British photographer, Kim Michael Kenna, took a photograph of Solseom – a small island in Korea in 2007. After the photograph's release, the island became a popular tourist place. "Korean Air" held a Travel Photography Competition and one Mr. Kim won with a photograph of Solseom, which was later used in Korean Air's TV and Internet commercials. The photographer filed a lawsuit for damages against Korean Air for copyright infringement arguing that it used the allegedly duplicated copy of his prize-winning photograph. The Court ruled that the photograph used by Korean Air did not infringe the Plaintiff's copyright although the overall impression is similar since both pictures were taken from the same point. The impression itself cannot be a subject for copyright protection and choosing how to take a picture of the same natural view is an idea and, hence, does not qualify as a copyrighted matter.

When this case was brought before the Court, many photographers had diverse opinions and many believed that copyright infringement should not be recognised just because a natural view which anybody can take a picture is shot in a similar composition. Before this lawsuit, an advertising firm sought to use Michael Kenna's photograph for a commercial of Samsung Electronics mobile products by using a colour picture from an image selling website as Kenna's photograph is black-and-white. However, the firm withdrew its plan not to use the photograph in the commercial when Kenna tried to take legal action against the firm. Arguing copyright for a photograph and preventing even the opportunity of access to the picture that may have a similar result can be harsh from the user's standpoint. It seemed that volume of content that users could buy would increase when copyright law strengthened, but instead, afraid of plagiarism, content volume decreased. Those who use photographs want to buy works of not only renowned photographers but also amateurs. Considering this, it is expected that the ruling, partially recognising the scope of a patent of photographic work will have positive impact for diverse and quantitative expansion to satisfy the consumers' demand for diverse works.

5. Contributed by

Luke Jong Wong Hong, Jong-Sun Kim and Ji-Hyun Kim.

APAA 2014 COPYRIGHT COMMITTEEE REPORT – MACAU

1. Copyright Statistics Year 2013

No. of Applications Filed	NA.
No. of Registration Certificates Issued	NA.

2. Changes to Macau's Legislation

The copyright legislation in Macau SAR has been compliant with international standards, especially after it became a member of the World Trade Organization in 1995. It complies with the TRIPS Agreement with respect to the concept of Neighbouring Rights.

Macau SAR possesses comprehensive laws, which ensure protection of IP through local legislations and international treaties such as:

- The Berne Convention for the Protection of Literary and Artistic Works (Berne Union);
- The Geneva Universal Copyright Convention;
- The Agreement on Industrial Property Rights in Relation to Trade (TRIPS).

Macau did not ratify the WIPO Copyright Treaty (WCT) and the WIPO Performances and Phonograms Treaty (WPPT), both signed in 1996, which entered into force in Mainland China on 9 June 2007 and in Hong Kong on 1 October 2008. The application of the WCT and WPPT in the Macau SAR will not imply the need of further changes in the applicable legal frame and regulations since the necessary updates were already introduced in the 1999 Copyright law which is fully harmonised with the said treaties. Important changes in Copyright and Related Rights Code aiming to strengthen copyright protection in the digital environment and strengthen the legal framework and enforcement of Intellectual Property Rights, in compliance with international standards, were introduced. These amendments provide additional protection for technological measures (PTM) and electronic information for copyright management (RMI), as well as criminal penalties in respect of copyright violations as a result of dissemination by means of the Internet. The Macau SAR Government is aware of the importance of the protection of IP rights and attraction of foreign investment. The administrative authorities are active and responsive to requests related to the infringement of copyrights and courts are sensitive to intellectual property issues.

3. Practice Changes

NA.

4. Some Significant Court and Trademark Office Decisions

There are no significant case law updates.

5. Contributed by

Nuno Sardinha da Mata.

APAA 2014 COPYRIGHT COMMITTEEE REPORT – MALAYSIA

1. Copyright Statistics Year 2013

No. of Applications Filed	NA.
No. of Registration Certificates Issued	NA.

2. Changes to Malaysia's Legislation

NA.

3. Practice Changes

NA.

4. Some Significant Court and Trademark Office Decisions

4.1. *Microsoft Corporation v. Conquest Computer Centre Sdn Bhd* [(2014) 6 CLJ 876]

The Plaintiff was involved in designing, producing, marketing and supporting a wide range of company-related products and was the copyright owner of a wide range of computer-related products, including software and programs. The Defendant carried out the business of trading in and service of computers, computer software and their related products. Dispute ensued when the Defendant sold a personal computer, which the Plaintiff claimed were pre-installed with the Plaintiff's software ('the work"), without the Plaintiff's licence or consent and without providing the paraphernalia that must be given to the purchaser upon any PC pre-installed with the Plaintiff's software being sold. The Plaintiff submitted that the Defendant had infringed the Plaintiff's copyright in the work and further works by re-producing and marketing pirated copies of the Plaintiff's computer software. In defence, the Defendant denied infringing the Plaintiff's copyright and argued that there was a "trial version" of the work where there was a period of time when the software could be used for free. The issues were whether the Plaintiff was the owner of the copyright in the work, whether the Defendant infringed the Plaintiff's copyright by selling the PC without the authority, licence or consent of the Plaintiff and whether the work installed into the PC was a trial version. The Court held that by virtue of section 26(4)(a) of the Copyright Act 1987 ("the Act"), the name on a work purporting to be the name of its author shall be considered as such, unless the contrary is proven. As the Plaintiff's name "Microsoft" was clearly stated on the original CD-ROMs and on the screen of the computer downloaded with the work and as the Defendant failed to prove the contrary, the copyright in the work is vested in the Plaintiff. Further, it was held that the Plaintiff had established the infringement with the help of an invoice issued by the defendant. The Court dismissed the Defendant's contention of using a free trial version of the work since the work installed into the PC was not a trial version. The Defendant had infringed and will continue to infringe the Plaintiff's copyright and will cause irreparable and incalculable loss and damage to the Plaintiff's business, reputation and goodwill and standing in the computer business in Malaysia. Therefore, the Court allowed injunctive relief sought by the Plaintiff.

4.2. *Vision Cast Sdn Bhd & Anr v. Dynacast (Melaka) Sdn Bhd* [(2014) 1 LNS 557 (CA)]

The second defendant, an ex-employee of the Plaintiff incorporated the first defendant after 15 months of being released from the service of the Plaintiff, in consonance with the Deed of Restrictive Covenant that provides for a restriction of 12 months to do so. The Court had to mainly consider whether the second defendant is in breach of his confidential obligations when he approached Dynacast's customers in respect of ongoing projects at the time he left Dynacast, whether the Defendants had infringed the Plaintiff's copyright by "uplifting" and (reproducing) the Plaintiff's promotional material on the cover of the Defendants' brochure and whether it amounts to "passing off" since defendants were representing to the public that those products were not manufactured by the Defendants but by Plaintiff. The court allowed the Defendant's appeal. It held that firstly, there was no similarity between the Plaintiff's promotional material and the Defendants' brochure, in so far as its layout, its title or its content was concerned. Secondly, images/photographs in question were of products belonging to entities like Motorola, Compaq, General Electric etc., as attributed in the Plaintiff's promotional material itself and not to the plaintiff. Lastly, court held that the ownership of the images was not with the Plaintiff but with photographers.

4.3. PP *v. Chan Chun Tat* [(2013) 1 LNS 966]

This is an appeal against the High Court's decision that acquitted the Respondent from charges under section 41(1) Copyright Act 1987. The Respondent's premise was raided by a raid team together with the sole agent appointed in Malaysia to give cybercafe licence to use a game software. The witness from the raid team confirmed that there were customers who went to the counter to make payment to the Defendant as there was a computer for "billing system". He also confirmed that there were around ten customers during the raid and some were using the computers at that time. Upon inspection on the 44 computers in the premise, it was found that all the computers were installed with the software Warcraft III: Reign of Chaos and Warcraft III: The Frozen Throne ("the work"). However, the High Court held that the prosecution has failed to prove a *prima facie* case against the Respondent and the Respondent was acquitted. The prosecution appealed to set aside the decision. The Issues dealt with the Court were whether the elements of the charge are successfully proved by the prosecution at the *prima facie* stage; whether the Statutory Declaration ("SD") under section 42 of the Act can be accepted as documentary evidence due to the failure of the deponent to testify in the court; and whether the deponent as the director of Sendi Mutiara has authority to depose the SD under section 42 of the Act. The Court held that when all the requirements under section 42 of the Act are fulfilled, an affidavit is a *prima facie* evidence and admissible in evidence in any proceedings under the Act.

5. Contributed by

Cindy Goh Joo Seong.

APAA 2014 COPYRIGHT COMMITTEEE REPORT – NEW ZEALAND

1. Copyright Statistics Year 2013

No. of Applications Filed NA.

No. of Registration Certificates Issued NA.

2. Changes to New Zealand's Legislation

NA.

3. Practice Changes

NA.

4. Some Significant Court and Trademark Office Decisions

4.1. *Karum Group LLC v. Fisher & Paykel Financial Services Ltd.* [(2014) NZCA 389]

The Court of Appeal upheld the judgement of the High Court that the Defendant in modifying its own credit software had not infringed any copyright in the Plaintiff's software. The underlying factor in deciding whether copyright protection could extend to something beyond program code was observed by the Court to be the principle that copyright did not protect ideas, but rather protected the expression of ideas. Because non-literal software elements might extend into the idea spectrum and because non-literal infringement had not previously been considered by New Zealand Courts, the Court used English and United States court decisions on non-literal software copyright infringement to guide the Court on the distinction between literal and non-literal elements of computer software and thus whether copyright could subsist in the latter as claimed by the Plaintiff.

4.2. *G-Star Raw CV v. JeansWest Corporation (New Zealand) Ltd.* [(2013) NZHC 2679]

G-Star successfully sued JeansWest for infringement of copyright in design drawings used to manufacture G-Star's "Elwood" jeans. JeansWest had been selling a style of jeans that was a copy, or a copy of a substantial part, of the Elwood jeans. The Elwood jeans were said to have five distinctive features: (1) oval-shaped knee pads, (2) horizontal stitching running across the back of each knee, (3) a straight line of double stitching coming from the hip to the crotch diagonally across the front of the thigh of each leg, (4) circle shaped stitching on the back of the jeans (the saddle pad) and (5) heel guards at the rear of each leg. The Judge found that the similarity in appearance of the copyright drawings of the original Elwood jeans and JeansWest's jeans was significant. Coupled with the telling similarity between the jeans, JeansWest was held to have copied a substantial part of G-Star's copyright works. G-Star was granted an injunction with minimal damages.

4.3. *New Dawn International Ltd. v. Quakeproof Chimneys NZ Ltd.* [(2014) NZIPOTM 6]

Quakeproof Chimneys successfully applied to invalidate the trade mark, arguing that it owned the copyright in the trade mark. On the facts, the Assistant Commissioner held that the owner of the registration was not the sole owner of the copyright and it was likely that both parties were joint owners. The registration was therefore found invalid. The Assistant Commissioner recognised that, as joint owners, this may ultimately mean that neither party would be able to deal with the artwork without the consent of the other, so it may be that neither could register the trade mark.

4.4. Copyright Tribunal

There were four decisions in the last year relating to the "3-strikes" file-sharing legislation. The Copyright Act requires the Copyright Tribunal to order an account holder to pay a sum to the rights holder if the Tribunal is satisfied that there have been three infringements of the right owner's copyright, that three infringement notices have been issued in accordance with the Act and that the infringements occurred at the IP address of the account holder. There is an exception if an order to pay money would be manifestly unjust. We haven't summarised each case separately as they are all similar. In each case, there had been infringements and notices had been sent out in accordance with the Act. The sum of damages awarded was roughly in the $400–550 range in each case.

5. Contributed by

Michael Brown, Laura Hollingsworth and Catherine Edmonds.

APAA 2014 COPYRIGHT COMMITTEEE REPORT – PAKISTAN

1. Copyright Statistics Year 2013

No. of Applications Filed	NA.
No. of Registration Certificates Issued	NA.

2. Changes to Pakistan's Legislation

After reconstitution of the Copyright Board in the year 2010, a significant number of Opposition and Rectification matters were disposed of. However, since April 2013 not only the Copyright Board is inactive, as it is under the process of reconstitution by the Federal Government but the post of Registrar is also lying vacant after the Registrar of Copyright has proceeded on retirement.

3. Practice Changes

NA.

4. Some Significant Court and Trademark Office Decisions

4.1. *Bayer Ag v. Bayhealth Care (Pvt.) Ltd.* [2013 CLD 2087]

The court held that nothing can be further added to the definition and criteria determining infringement or passing off and the company name/trade name/service mark/ trademark "Bayer", the trademark "BAYER HEALTHCARE", the prefix "Bay", the "Bay" Formative Marks, belonging to and owned by the plaintiffs, are deleted/removed from the name of defendant.

The Defendant infringed the Plaintiff's trademark, copyright or trade name, it is to be gauged as to whether or not the products of the Plaintiff and the Defendant are identical, or to what extent they are similar.

If the customer/consumer gets deceived or becomes doubtful or confused after looking at or comparing the products of the plaintiff and the Defendant, the Plaintiff will be justified in bringing an action against the Defendant.

The Court also observed that in the case of infringement or passing off, the person indulged in or responsible for the infringement or passing off not only commits illegal acts, but he also commits moral and ethical wrongs.

5. Contributed by

Saira Osman Bhatty and Syed Saeeduddin Nasir.

APAA 2014 COPYRIGHT COMMITTEEE REPORT – PHILIPPINES

1. Philippines Copryright Office Statistics 2013–2014

No. of Applications Filed	714 (491 from January 2014 to July 2014)
No. of Applications Registered	648 (488 from January 2014 to July 2014)

2. Changes to Philippines' Legislation

NA.

3. Practice Changes

On 19 September 2013, the IPOPHL Director General signed several Office Orders establishing the rules and regulations for some of the provisions of Republic Act No. 10372. Following are the orders:

3.1. Office Order No. 13–169 Series of 2013, Rules and Regulations on Resolution of Disputes Relating to the Terms of a License Involving an Author's Right to Public Performance or Other Communications of His Work.

3.2. Office Order No. 13–171 lays down the requirements and procedures for the registration and deposit of copyrighted works with the IPOPHL through Intellectual Property Satellite Offices (IPSOs), which may be adopted by the National Library of the Philippines (NLP). The IPSOs shall transmit the deposited works to the *Bureau of Copyright and Other Related Rights of the IPO* (BCRR) on a monthly basis.

3.3. Office Order No. 13–173, series of 2013, Rules and Regulations on the Accreditation of collective Management Organisation. This order has a set of rules, namely Rule I, Rule II and Rule VI. Rule I (section 2) talks about the coverage. Section 2 shall apply to any CMO, which refers to a group of artists, writers, composers and other creators, or copyright/ related rights holders whose primary purpose is to collectively manage copyright and/or related rights. It shall also apply to any CMO established before the effectivity of these Guidelines. Such CMO shall, within three months from effectivity hereof, apply for accreditation. Rule II (section 1) sets out the minimum requirements for CMO accreditation. Rule II (section 2) deals with documentary requirements. If granted, the accreditation shall be valid for three years from resolution granting the same, with an option to renew the accreditation at least 30 days prior to expiration. Rule II (section 6) deals with denial of accreditation. Order No. 13–173 also provides for the effect of Non-accreditation of a CMO and Rule VI (section 3) talks about effect of non-accreditation, denial or suspension of Accreditation.

4. Some Significant Court and Designs Office Decisions

NA.

5. Contributed by

Attys. Risel Castillo-Taleon and Ma. Theresa Trinidad.

APAA 2014 COPYRIGHT COMMITTEEE REPORT – SINGAPORE

1. Copyright Office Statistics 2013–2014

No. of Applications Filed	NA.
No. of Applications Registered	NA.

2. Changes to Singapore's Legislation

The Copyright Amendment Bill 2014 was passed by Parliament on 8 July 2014. The amendments are expected to take effect in the latter half of 2014. The amendments are as follows:

2.1. Facilitating access to copyrighted work for the disabled.

2.2. Stopping Online Copyright Infringement. The amendment will allow the copyright owners to apply for injunctions disabling access to "flagrantly infringing sites" without issuing a "take down" notice to Network Service Provider (NSP).

3. Practice Changes

NA.

4. Some Significant Court and Designs Office Decisions

4.1. *Invenpro (M) Sdn Bhd v. JCS Automation Pte Ltd. & Anr.* [(2014) 2 SLR 1045 : (2014) SGHC 38]

The Defendants had produced a batch scrubber of its own. The Plaintiff had alleged that these batch scrubbers embodied many of the alleged confidential features of the Plaintiff's own batch scrubber. The court found that there is insufficient proof that the Defendants had a sight or access to the Plaintiff's Copyright works (drawings, manuals, codes, etc.) and found further that Defendants' batch scrubber was of independent creation and design. The key point that was established was that substantial similarity alone was insufficient as the Plaintiff had to go on and demonstrate a casual connection between its copyright documents and Defendants' infringing article.

4.2. *Wong Wan Chin (Huang Wanjun) v. Wang Choong Li (formerly t/a The Feline Bridal)* [(2014) SGDC 249]

The Plaintiff is a singer and actress based in Hong Kong. The Plaintiff's claim is for copyright infringement arising from the Defendant's use of photographs taken on the occasion of the Plaintiff's wedding. The Defendant's principal defences are that the Plaintiff does not own the copyright to the photographs and/or has granted the Defendant a license to use some of the photographs pursuant to an alleged sponsorship agreement. Preliminary issue was whether the pre-wedding photographs and the Actual Day Photographs each constituted a "collective work". The Court held that the 29 pre-wedding photographs had not been assembled into a "collective whole" so as to form a single collective work. Hence, in respect of the 29 pre-wedding photographs, there were 29 instances of copyright infringement by the defendant in relation to the pre-wedding photographs.

4.3. *Total English Learning Global Pte Ltd. & Anr. v. Kids Counsel Pte Ltd.* [(2013) SGHCR 22]

In this case it was established that the term "communicate" and the phrase "to communicate the work to the public" are limited to communication via electronic transmission.

4.4. *Public Prosecutor v. St. Hua Private School Pte Ltd., Song Chunwei* [(2014) SGDC 342]

The plaintiff/complainant is Siemens PLMS, the owner of some NX software and the first accused is St. Hua Private School Pte. Ltd (St Hua PSPL), a private school which provides training courses to students for the use of NX Software. The second accused is Song Chunwei (Ms Song) the sole director and shareholder of the first accused. St Hua PSPL was alleged to have willfully infringed copyright of the complainant/plaintiff. St. Hua PSPL was guilty of willful infringement because copyright had subsisted in the NX software at the time of the offence. Further, NX software was found to be installed on certain number of computers when St. Hua PL was no longer authorised to use the software. Furthermore, the second accused was aware that her related companies did not have the right to use the NX software for training or maintenance. St Hua PL continued to represent itself to be Siemens channel partner and training provider on its website and lastly St. Hua PSPL was offering the training course on NX software on a commercial basis to obtain a commercial advantage in the form of course fees.

5. Contributed by

Boo Yee Swan and Lam Chung Nian.

APAA 2014 COPYRIGHT COMMITTEEE REPORT – SRI LANKA

1. Copyright Statistics Year 2013

No. of Applications Filed	NA.
No. of Registration Certificates Issued	NA.

2. Changes to Sri Lanka's Legislation

The law on copyright is governed by the Intellectual Property Act No. 36 of 2003 and has undergone no amendments.

3. Practice Changes

3.1. Although Sri Lanka has yet not signed the Marrakesh Treaty (Marrakesh, Morocco – 2013) which is to facilitate persons who are blind, visually impaired or otherwise print disabled, moves are underway for Sri Lanka too to accede to this treaty.

3.2. Regulations have also been made under the Customs Ordinance and the Intellectual Property Act permitting the owner or holder of a copyright to notify the Director-General of Customs to suspend the clearance of imported goods that are suspected of being counterfeit or pirated. Upon the detention being made, initially for 14 days but extendable, the owner/ holder could thereupon apply to Court for the Court to suspend the release of these goods in to the market. The Customs could also on its own initiative cause the suspension of goods being released into the market. [Vide *Gazette Extraordinary* No. 1523/22 of 15.11.2007].

4. Some Significant Court and Trademark Office Decisions

4.1. The Director General has so far heard around eight complaints made to it for relief under the Act. Some of these inquiries have gone *ex-parte*. Recently, there has been an interesting case of allegation of infringement of old songs being sung by a new vocalist. Issues such as the copyright in the song having been previously assigned during the lifetime of the original singer and other legal issues are being argued. The matter is pending. Similarly, unauthorised televising of tele-dramas has also been the subject of a court action and compensation has been paid by way of a settlement.

5. Contributed by

Nithi Murugesu.

APAA 2014 COPYRIGHT COMMITTEEE REPORT – TAIWAN

1. Copyright Office Statistics 2013–2014

No. of Applications Filed	NA.
No. of Applications Registered	NA.

2. Changes to Taiwan's Legislation

In April 2014, TIPO finally proposed the newest comprehensive amendment draft of the copyright law in which following have been proposed to be amended:

2.1. Amendment of certain definitions like public broadcast, public transmission, right of public presentation, right of public retransmission;

2.2. Provisions regarding the assignment of authorship of works produced in a course of duty and works which are audiovisual in nature;

2.3. Provisions for moral rights;

2.4. Distribution rights;

2.5. Modifying the protection for performers and sound recordings;

2.6. Copyright (economic right) limitations and exceptions;

2.7. Compulsory licensing (adopting) when the copyright holder is unknown;

2.8. Border protection measures; and

2.9. Criminal responsibility provisions and the defining the term of economic rights and restoration of copyright registration.

3. Practice Changes

NA.

4. Some Significant Court and Designs Office Decisions

NA.

5. Contributed by

Yvonne Lin.

APAA 2014 COPYRIGHT COMMITTEEE REPORT – THAILAND

1. Copyright Office Statistics 2013–2014

No. of Applications recorded	14,785 (16,081 for 2014)
Quantities seized	256,545 (August 2013 to July 2014)
Confiscated products destroyed	24,93,574
Civil Copyright infringement	89 (113 of 2014)
Criminal Copyright cases	1,130 (487 of 2014)

2. Changes to Thailand's Legislation

No legislative changes have taken place. There are two pending draft copyright legislations:

2.1. The rights management information, technological protection measures and exceptions to the Inter service provider; and

2.2. The exemptions to copyright infringement for disabled people and copyright offences relating to recording movies in theater.

3. Practice Changes

NA.

4. Some Significant Court/Major Cases and Designs Office Decisions

4.1. 19 November 2013

The Royal Thai Customs had seized pirated good (loudspeakers, earphones, glasses, ladies bag, wallets, and luggage and sport shoes). The value of the seizure was 10 million TBH (approx.)

4.2. 8 July 2014

The Economic Crime Suppression Division arrested 371 offenders for violation of IPR with 31,622 items and the pirated products worth 81,69,997 THB.

4.3. 5 August 2014

The Department of Special Investigation raided manufacturing factories and warehouses for counterfeit sport clothing around Bangkok. The seized goods had a value of over 20 million TBH.

4.4. September 2014

INTERPOL seized nearly 1 million fake or illicit products including alcohol, cigarettes, cosmetics, clothing and electrical goods.

5. Contributed by

Pawarisa Suwannachote.

APAA 2014 COPYRIGHT COMMITTEEE REPORT – VIETNAM

1. Copyright Statistics Year 2013

No. of Applications Filed:	NA.
No. of Registration Certificates Issued:	5000*

According to the statistics published by the Copyright Office of Vietnam

*32.73%	Applied fine art works
25.75%	Literary works
20.92%	Musical works
9.15%	Computer program and database collection.

2. Changes to Vietnamese Legislation

On 16 October 2013, Government issued a new regulation concerning copyright, namely, Decree No. 131/ND-CP/2013 on sanctions against administrative violations of copyright and related rights in substitution to existing Decrees, amending and supplementing some articles of Decree No. 47/2009/ND-CP on the same issues. The new Decree introduced more severe administrative remedies against copyright violations, especially in the field of cinematography and television. The maximum administrative fine applied to copyright violations under this Decree is up to VND 500,000,000 (approx. US$ 24,000). The new Decree became effective on 15 December 2013.

3. Practice Changes

3.1. Trans-Pacific Partnership Agreement

Vietnam has been attending actively in the process of negotiation for the Trans-Pacific Partnership Agreement with Australia, Brunei Darussalam, Canada, Chile, Japan, Malaysia, Mexico, New Zealand, Peru, Singapore and the US. It is expected that the system for IP right protection, generally, and copyright protection, in particular, will be improved significantly in the upcoming year

3.2. Collective Management

The Copyright and Related rights collective management system in Vietnam has been established with four organizations, including the Vietnam Literary Copyright Center (VLCC), the Recording Industry Association of Vietnam (RIAV), the Vietnam Center for Protection of Music Copyright (VCPMC), and the Vietnam Reproduction Rights Organization (VIETPRO). The VCPMC has been the most active collective management organisation. In 2013, it has collected an amount of VND 57 billion (approx. US$2,715,000). The highest rate is collected from telephone music, music downloadable websites, performance, TV and Radio broadcasting. In the first six months of 2014, it has collected an amount of more than VND 25.7 billion (approx. US$ 1,224,000). By June 2014, VCPMC already had 2943 members.

3.3. End-user Piracy Enforcement

On 16 June 2013, Inspectors from the Ministry of Culture, Sports and Tourism and the Ministry of Public Security raided Long John Dong Nai International – a footwear manufacturer in Dong Nai. They found unlicensed software from Lac Viet and Microsoft on 69 computers, valued up to VND1 billion (US$ 45,000). Microsoft and Lac Viet then sent a Cease & Desist letter requesting Long John to make public apology, buy licence and pay damages. However, they received no co-operation from Long John in settling the case. They then filed a lawsuit against Long John at Dong Nai's People's Court where the defendant is located. In March 2014, the parties had settled the case. According to news reported on newspapers, Long John agreed to make public apology and pay a compensation equivalent to 100% of the value of the pirated software (i.e. approx. US$ 45,000).

This is reported to be the first case of end user software piracy that has been brought to a People's Court in Vietnam.

4. Some Significant Court and Trademark Office Decisions

NA.

5. Contributed by:

Nguyen Thu Anh.

APAA 2014 DESIGN COMMITTEE REPORT – AUSTRALIA

1. Australian Designs Office Statistics 2013–2014

No. of Applications Filed	6,737 (6,630 for 2014)
No. of Applications Registered	6,386 (6,716 for 2014)

2. Changes to Australian Legislation

NA.

3. Practice Changes

NA.

4. Some Significant Court and Designs Office Decisions

4.1. *Seafolly Pty Ltd. v. Fewstone Pty Ltd.* [(2014) FCA 321]

Seafolly Pty Ltd. was trading as Seafolly and Fewstone Pty Ltd. was trading as City Beach Australia. Both companies were manufacturing swimwear. City Beach copied the pictures and samples (artistic work) of Seafolly's swimwear. Seafolly's artwork was known as Senorita artwork (3D design). Defendant took the defense that section 77 of Copyright Act 1968 removes the right to sue for copyright infringement of an artistic work in cases where a "corresponding design" has been industrially applied. City Beach sought to rely on this defense on the basis of the picture being a 3D embodiment, thereby making such artwork a "corresponding design". Her honor concluded that senorita embroidery design was not a corresponding design. Hence, the defense taken by City beach fell by the wayside.

4.2. *Removerite Incorporated* [(2013) ADO 7]

Removerite had filed an application for design registration containing two sets of screws which were alleged as not new and distinctive by the Examiner being substantially similar in overall impression to prior art, earlier Design Patent D585, 731. That patent also belonged to Removerite. Removerite requested the design to get registered on the grounds that screws have enlarged flanges and there is a taper of the shanks, both being new and distinctive features. The Delegate held that the Designs were not substantially similar in overall impression to the Prior Art on the following grounds:

1. Unlike quantitative terms, in terms of quality the distinctive features of the Designs differed from the Prior Art.
2. The registration of both Designs carried a Statement of Newness and Distinctiveness (SOND).
3. The flange of Designs was considerably thicker than the flange of the prior art.
4. The informed user would be at least equally aware of the subtleties in screws, and the differing visual impact of the flange and the taper of the shank of the Designs compared to Prior Art.

5. Contributed By

Scott Walker, Ross Clark and Paul Massey.

APAA 2014 DESIGN COMMITTEE REPORT – HONG KONG

1. Designs Office Statistics 2013–2014

No. of Applications Filed	1,594
No. of Applications Registered	1,437

2. Changes to Hong Kong's Legislation

NA.

3. Practice Changes

NA.

4. Some Significant Court and Designs Office Decisions

NA.

5. Contributed by

Ted Chwu, Mena Lo and Laurence Thoo.

APAA 2014 DESIGN COMMITTEE REPORT – INDIA

1. India Office Statistics 2013–2014

No. of Applications Filed	8,337
No. of Applications Registered	7,252

2. Changes to Indian Legislation

NA.

3. Practice Changes

NA.

4. Some Significant Court and Designs Office Decisions

4.1. *Steelbird Hi-Tech India Ltd. v. S.P.S Gambhir & Ors.* [2014 (58) PTC 428 (Del) : MIPR 2014 (1) 277]

The Plaintiff was a manufacturer of wide variety of open face and full face motorcycle helmets in different sizes catering to different consumer segments. The Plaintiff was using the helmets bearing the said registered design since 2012 under a trade mark STEELBIRD (Beak shaped design). Defendant contended that there lies no novelty in the beak shaped design. Case was held in favour (Plaintiff's application for interim injunction was dismissed) of the Defendant on the basis that Defendant had led sufficient prima facie evidence to show that similar designs were already available in the marker prior to the design registration of the Plaintiff. The Plaintiff had not taken any action against the companies who were marketing the products bearing the similar designs. On the basis of the documents/ material filed by the Defendants, there were various manufacturers who had already been making designs with "Beak Shape", marketed throughout the world. Prima facie, therefore, the Plaintiff's design did not appear to be new or original and was thus not entitled to protection/ interim injunction.

4.2. *Whirlpool of India Ltd. v. Videocon Industries Ltd.* [2014 (60) PTC 155 (Bom) : 2015 (1) BomCR 137]

1. Suit for infringement under section 22 is maintainable against subsequent registered proprietor.
2. For defence of functionality the only consideration to determine functional requirements of the said product should be the design.
3. If the Defendant itself had registered a design identical to the Plaintiff's, it cannot be contended that the Plaintiff's design is not novel or original.
4. If minor differences between the two designs were such that the latter can be regarded as novel then the Defendant's product must also be regarded novel.
5. Issue of *Passing Off*: If the class of consumers is such that may get confused between two similar goods, it amounts to passing off.

4.3. *Standard Corporation India Ltd. v. Tractors and Farm Equipment Ltd*. [MIPR 2014 (2) 23]

The Division Bench of the Madras High Court confirmed that the right to seek reliefs before a Court of law cannot be curbed at the outset without having proper reasons to do so.

4.4. *M.C. Jayasingh. v. Mishra Dhatu Nigam Ltd. & Ors*. [Suit No. 562 of 2007, decided on 23 January 2014 by Madras High Court]

The suit was a combined action for infringement of patents and designs in respect of a wide range of Prosthesis for Limb Salvage surgery, for different parts of the human anatomy, called "Custom Mega Prosthesis" (CMP). The novelty of the Plaintiff's relevant design lied in its shape and configuration and it was designed in such a way to be a perfect replacement for the bone which was to be removed. The Plaintiff alleged that the Defendant's product amounted to infringement of the Plaintiff's patent and design. The following issues got raised:

1. Whether the court can be called on to record a finding on the validity of the Plaintiff's design especially when the Defendants have not raised any substantial pleadings to that affect?

   Section 22(3) of Indian Designs Act enables the Defendants to raise, as a defence, any of the grounds available under section 19 of the Act. Once the defendants had chosen not to challenge the validity of the registered design of the Plaintiff (in the Written Statement to the suit) the validity of the Plaintiff's design was not under challenge.

2. Whether there was any infringement, assuming that the Plaintiff's design was valid?

   No evidence on record to show that the shape and configuration adopted by the Plaintiff in his designs has been copied by the Defendants very prosthesis takes its shape and configuration only from the human anatomy. There is another shape that a distal prosthesis could actually take.

5. Contributed by

Himanshu Kane, Sharad Vadhera and Essenesse Obhan.

APAA 2014 DESIGN COMMITTEE REPORT – INDONESIA

1. Indonesia Designs Office Statistics 2013–2014

No. of Applications Filed	4,258
No. of Applications Registered	NA

2. Changes to Indonesian Legislation

NA.

3. Practice Changes

NA.

4. Some Significant Court and Designs Office Decisions and Others

4.1. Overview of the Indonesian Legal Framework for IPR Protection especially on Industrial Design

Indonesia became a member of WTO (ratified through the law No. 7 of 1995). As a member, Indonesia was required to meet the minimum requirements in the WTO agreements. Indonesia had to frame a system of legal protection of Industrial Designs in pursuance with Article 25 and Article 26 of the WTO's Agreement Indonesia formed a Law No. 31 of 2000 on Industrial Designs (ratified on 20 December 2014). From June 2000 to 2013, 47,256 applications have been filed in the DGIPR office.

4.2. Substance of Protection Law of Industrial Design Rights in Indonesia

The legal basis for the specific regulation for the protection of industrial design rights is Law No. 31 of 2000. Furthermore, the implementation of its regulation is the government regulation No. 1 of 2005 on the implementation of Law No. 31 of 2000 on Industrial Design. In addition, it is related to the protection system of industrial design, there are also the International treaties that have been ratified by Indonesian, i.e. Paris Convention and WTO agreement 1994.

4.3. Industrial Design Litigation

The Indonesian legal system was influenced by the continental system, and judges in the first instance courts or highest-level courts (Supreme Court judges) have the right to make decisions based on the legal conscience of the judge even though similar cases may have been handled previously. There is no obligation for district court judges or high court judges to follow such previous decision or verdicts of judges in same level, highest level, or Supreme Court judges.

4.4. Commercial Court

The commercial court has exclusive jurisdiction to hear suits for industrial design cancellation (vide Article 38 of Industrial Design Law No. 31

of 2000) and suits for damages for industrial design infringement (vide Article 46 of Industrial Design Law No. 31 of 2000). In Indonesia, most IP lawsuits filed through the Commercial Court are for cancellation and these amounts are around 150 cases per year, such as industrial design and copyright about 70 cases, trademark about 70 cases, and patent about 10 cases.

4.5. One kind of cancellation case on the industrial design right "Boiler Machine" in 2010

Case No. 06/DESAIN INDUSTRI/2006/ PN.NIAGA/JKT. PST dated 26 April 2006. Plaintiff is PT HITACHI Construction and Machinery Indonesia and Defendant is PT Basuki Pratama Engineering and Co-Defendant is Ministry of Law and Human Rights R.I. *cq.* Directorate General of IP Rights *qq.* Directorate of Industrial Design. The Plaintiff had filed a lawsuit on the cancellation of registration of an Industrial design ID 0 008 936-D in the name of defendant, because of lack of novelty. The registered industrial design No. ID 0 008 936 was stated novel as per the Commercial Court at Central Jakarta District and it was not cancelled.

4.6. Novelty Evaluation of Industrial Design in Indonesia

The right to Industrial Design shall be granted for an Industrial design that is new/novel (vide Article 2 of Law No. 31 of 2000 on Industrial design). For determining the novelty of industrial design, there can be roughly three standards: identical (degree of novelty none), similar (degree of novelty some), and Non-similar (degree of novelty existing) in view of the kind of goods (article) and its design creation (configuration). Once a design is registered, the term of protection is generally ten years.

5. Contributed by

Insan Budi Maulana.

APAA 2014 DESIGN COMMITTEE REPORT – JAPAN

1. Japanese Designs Office Statistics 2013–2014

No. of Applications Filed	31,125
No. of Applications Granted	28,208
No. of Applications Filed for Partial Designs	11,178 (35.9% total no. of applications)

2. Changes to Japan's Legislation (as of Oct. 2014)

The Design Act has been amended this year.

The amendment is ready for entry into the Hague Agreement.

The Locarno Agreement entered into force with respect to Japan on September 24, 2014.

The Hague Agreement is expected to enter into force with respect to Japan in the next year, but not determined concretely when it is done.

Current information as of May, 2015.

The Hague Agreement will enter into force with respect to Japan on May 13, 2015.

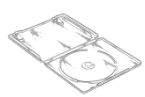
3. Practice Changes

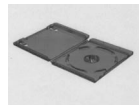
NA.

4. Some Significant Court and Designs Office Decisions

4.1. Heisei 25 (wa) 12233 [Decided on 23 January 2014 by Tokyo District Court]

The registration is a partial design in which an element for securing an aperture of disc here to is excluded.





The court had evaluated the common points and different points between the Design registration No. 1308670 and the accused product and found that most of the common points are found in the prior art and the different points prevail. The Tokyo District Court judged that both designs were not similar to each other, and thus, decided non-infringement by Defendant and rejected Plaintiff's demands for the injunction and damages. An abstract of the judgment is as follows – "The subject design is a partial design. The portion to be protected is a "container for disc" except for two-dot chain line, 'fastener', which is positioned at slightly lower part of the centre in the base portion."

5. Contributed by

Toru Watanabe and Keiichi Yamamoto.

APAA 2014 DESIGN COMMITTEE REPORT – KOREA

1. Korea Designs Office Statistics 2013–2014

No. of Applications Filed: 66,940 in 2013
No. of Applications Registered: 47,308 in 2013

2. Changes to Korean Legislation

2.1. The term of a design right has been extended

The term of a design right was extended to 20 years from the filing date from 15 years from the registration date.

2.2. Adoption of "related design" system

Similar design system was replaced by new "Related Design".

2.3. Improvement of multiple design system

Multiple Design Application covering up to 100 articles in the same Locarno Class became acceptable.

2.4. Adoption of Locarno Classification

Locarno Classification was made acceptable.

2.5. Expansion of the grounds for a request of re-examination

Post-Amendment, re-examination based on an amendment of any specifications indicated in the application has been made possible (Argument for re-examination – also possible).

2.6. Improvement of exception of loss of novelty

It is possible to claim exception of loss of novelty with relevant document (i) at the time of filing design application, (ii) filing a response when responding to a rejection notice, (iii) filing a response when responding to the opposition, or (iv) filing a response when responding to the trial request (it is allowed in invalidation trial).

2.7. The Hague Agreement came into effect

The Hague Agreement came into effect in the Republic of Korea on 1 July 2014.

3. Practice Changes

NA.

4. Some Significant Court and Designs Office Decisions

4.1. 2012 Hu 3343 [Supreme Court]



Perspective view



Front view



Rear view

Even though the elements of a partial design application, '' and '' of the subject design are separated physically by the body of mobile phone, these parts can perceived respectively as "rabbit's ears" and "rabbit's tail" and thus the integrity of these parts can be perceived as "a rabbit" to produce a visual aesthetic sense as a whole. The application, therefore, satisfies the statutory requirement of a single design.

5. Contributed by

Young Cheol Byun, Pil Jin Park and Yong-jin LEE.

APAA 2014 DESIGN COMMITTEE REPORT – MACAU

1. Macau Designs Office Statistics 2013–2014

No. of Applications Filed	141 (82/Jan–July 2014)
No. of Applications Registered	

2. Changes to Macau's Legislation

NA.

3. Practice Changes

NA.

4. Some Significant Court and Designs Office Decisions

NA.

5. Contributed by

Bruno Nunes, Macau Group.

APAA 2014 DESIGN COMMITTEE REPORT – MALAYSIA

1. Malaysia Designs Office Statistics 2013–2014

No. of Applications Filed	679 (616 Sept. 2014)
No. of Applications Registered	698 (373 Sept. 2014)

2. Changes to Malaysia's Legislation

NA.

3. Practice Changes

NA.

4. Some Significant Court and Designs Office Decisions

4.1. *F&N Dairies (Malaysia) Sdn Bhd v. Tropicana Products Inc.* [(2013) 1 LNS 380]

This case relates to a bottle design for fruit juices that was registered by the Plaintiff (Tropicana Products Inc). The Plaintiff filed lawsuits for infringement against several parties who were said to be selling their products using bottle designs which were — obvious or fraudulent imitation – of the Plaintiff's registered design. At the High Court (where the trial was heard), the Plaintiff's claims were allowed. The Defendants appealed against the High Court decisions to the Court of Appeal. The Court of Appeal allowed the Defendants appeal and their counterclaim for invalidation of the Plaintiff's registered design. Main grounds on which Court of appeal had allowed the Defendants' appeal:

1. Element of "eye-appeal" was not established (main consideration);
2. Design was dictated solely by the function which it has to perform; and
3. The Plaintiff's registered design was not new at the priority date.

Court of Appeal shifted the burden of proof to the proprietor of the registered industrial design to prove the validity of an impugned registered industrial design. The issue as to what constitutes – "dictated solely by function", remained uncertain.

4.2. *Veresdale Ltd. v. Doerwyn Ltd.* (High Court, Originating Summons No. 24ip-24-10/2013) *("Veresdale 1")*

The case was related to industrial design registrations for automobile parts. The Plaintiff and Defendant had collaborated in designing and building an automobile. The Defendant subsequently sought and obtained unilateral industrial design registrations of the automobile parts. The Plaintiff had applied to the court that these automobile parts were not registrable as industrial designs under the "must match" exclusion in section 3(1) of Malaysia's

Industrial Designs Act. "Must match" exclusion determinants are as follows:

(a) That the concerned design is dependent on another article; and

(b) intended to form an "integral part" of that other article;

The High Court concluded that the "must match" exclusion was applicable. Court held that these car parts were non-registrable.

4.3. *Veresdale Ltd. v. Doerwyn Ltd. & Registrar of Industrial Designs, Malaysia* (High Court, Suit No. 22ip-26-05/2014) ("*Veresdale 2*")

In *Veresdale 1*, the Plaintiff and Doerwyn Ltd (First Defendant) had agreed to be bound by any decision reached by the court in that case. Further to the court's judgement in *Veresdale 1*, the First Defendant lodged an appeal with the Court of Appeal. The Plaintiff therefore commenced proceedings in *Veresdale 2.* As the Registrar of Industrial Designs (Second Defendant) was the appropriate party to enforce any order granted by the court for the removal and expunging of the designs from the Register of Industrial Designs. The Plaintiff joined the Second Defendant in the suit accordingly. The Plaintiff and the First Defendant thereafter reached a settlement and recorded a consent order. The Second Defendant raised preliminary objections to be joined in the suit. This implied that the Second Defendant would not as-of-right enforce the previous court judgment reached in *Veresdale 1*, and expunge the industrial designs concerned from the Register of Industrial Designs. The Second Defendant's preliminary objections were subsequently dismissed by the court. The court ordered the Second Defendant to comply with the court order made in *Veresdale 1* and rectify the Register of Industrial Designs accordingly.

5. Contributed by

Teo Bong Kwang and Lee Siew Ling.

APAA 2014 DESIGN COMMITTEE REPORT – PAKISTAN

1. Pakistan Designs Office Statistics 2013–2014

No. of Applications Filed	390
No. of Applications Registered	NA.

2. Changes to Pakistan's Legislation

NA.

3. Practice Changes

NA.

4. Some Significant Court and Designs Office Decisions

NA.

5. Contributed by

Sultan Ahmad Sheikh.

APAA 2014 DESIGN COMMITTEE REPORT – PHILIPPINES

1. Philippines Designs Office Statistics 2013–2014

No. of Applications Filed	1,362 (913 in 2014)
No. of Applications Registered	1,322 (796 in 2014)

2. Changes to Philippines' Legislation

The Philippine Bureau of Patents had issued Memorandum Circular No. 14-004 on 20 May 2014 which allows for the deferred publication of industrial design applications. Its purpose is to allow deference of publication of such industrial designs so as to maintain their secrecy from competitors until such time the products utilising these designs have been placed in the market. The maximum period for deferred publication is 30 months from filing date or priority date.

3. Practice Changes

NA.

4. Some Significant Court and Design Office Decisions

NA.

5. Contributed by

Bienvenido I. Somera, Jr. and Lorna Patajo-Kapunan.

APAA 2014 DESIGN COMMITTEE REPORT – SINGAPORE

1. Singapore Designs Office Statistics 2013–2014

No. of Applications Filed	1,681
No. of Applications Registered	NA.

2. Changes to Singapore's Legislation

The Intellectual Property (Miscellaneous Amendments) Bill 2012 noted in the 2012 and 2013 Singapore Country Report has partially come into force as the Intellectual Property (Miscellaneous Amendments) Act 2012 on 7 March 2014 and 30 July 2014. However, substantive changes pertinent to the Registered Designs Act have not yet come into force. The recent changes to the Registered Designs Act only concern the reorganisation of the definition of the International Bureau of the World Intellectual Property Organization (WIPO) within the Registered Designs Act and prescribed fees.

3. Practice Changes

The option of entering a notice of an express trust and its beneficiary (or beneficiaries) will be available as of 30 April 2014 (Circular No. 1/2014). It should be clarified that entering of a notice of an express trust is not equivalent to registering a transaction under the Registered Designs Act and hence would not have the same statutory effects (e.g. entitlement to certain damages in respect of infringement).

How can notice of an express trust and its beneficiary be entered?

a. A fresh application can be made by entering the particulars "X" in trust for "Y" (where X is the trustee and Y is the beneficiary) in the "Name" field in form D3*.

b. An existing application can be made by entering the particulars "X" in trust for "Y" (where X is the trustee and Y is the beneficiary) in the "Name" field in form D1. For those using form D1*, it should be highlighted that entering a notice of an express trust will apply to all designs filed in the name of the proprietor. If it has to be for specific design, it has to be separately mentioned.

4. Some Significant Court and Trademark Office Decisions

NA.

5. Contributed by

Angeline Lee and Alvin Lim.

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* Other ways of doing it are as follows:

a. "Y" as trustee of "X"

b. any other format, so long as both the trustee(s) and the beneficiary (or beneficiaries) are clearly identified.

APAA 2014 DESIGN COMMITTEE REPORT – SRI LANKA

1. Sri Lanka Designs Office Statistics 2013–2014

No. of Applications Filed	100 (158 for 2014)
No. of Applications Registered	NA.

2. Changes to Sri Lanka's Legislation

NA.

3. Practice Changes

NA.

4. Some Significant Court and Designs Office Decisions

NA.

5. Contributed by

Surani Wickramaratna.

APAA 2014 DESIGN COMMITTEE REPORT – TAIWAN

1. Taiwan Designs Office Statistics 2013–2014

No. of Applications Filed	8,968
No. of Applications Registered	7,050

2. Changes to Taiwan's Legislation

NA.

3. Practice Changes

NA.

4. Some Significant Court and Designs Office Decisions

NA.

5. Contributed by

Edmund M. H. Chi.

APAA 2014 DESIGN COMMITTEE REPORT – THAILAND

1. Thailand Designs Office Statistics 2013–2014

No. of Applications Filed	9,393 (5,547 for 2014)
No. of Applications Registered	2,777 (1,824 for 2014)

2. Changes to Thailand's Legislation

NA.

3. Practice Changes

NA.

4. Some Significant Court and Trademark Office Decisions

NA.

5. Contributed by

Say Sujintaya.

APAA 2014 DESIGN COMMITTEE REPORT – VIETNAM

1. Vietnam Designs Office Statistics 2013–2014

No. of Applications Filed	2,129
No. of Applications Registered	NA.

2. Changes to Vietnam's Legislation

NA.

3. Practice Changes

NA.

4. Some Significant Court and Trademark Office Decisions

NA.

5. Contributed by

Le Thi Kim Dzung, Vietnam Group.

APAA 2014 EMERGING IP RIGHTS COMMITTEE REPORT – AUSTRALIA

1. Australian Emerging IP Statistics Year 2013

NA.

2. Changes to Australian Legislations

2.1. Intellectual Property Laws Amendment Bill 2014

The Intellectual Property Laws Amendment Bill 2014 proposes, *inter alia*, to implement the Protocol amending the World Trade Organization Agreement on Trade-Related Aspects of Intellectual Property (TRIPS Protocol), enabling Australian medicine producers to manufacture and export patented pharmaceuticals to countries experiencing health crises, under a compulsory licence from the Federal Court. Nevertheless, there is a lack of precedents regarding the use of compulsory licences in Australia.

3. Practice Changes

3.1. Hong Kong Bilateral Investment Treaty on Plain Packaging

On 14 April 2014, after receiving the full Statement of Claim from Philip Morris Asia and the full Statement of Defence from Australia, the tribunal decided that the proceedings would be bifurcated into jurisdictional and merit grounds in favour of Australia. On 16 May 2014 the tribunal established the timetable for the period leading up to the hearing on preliminary objections. Its outcome is likely to be known later this year.

3.2. IP Australia

IP Australia engaged in a pilot study which examined a number of metrics in Australian universities across four key areas, which include patenting portfolios, patent impact, and the potential for commercialisation, collaboration and connectivity.

This study demonstrates that applying patent metric as an assessment can be undertaken efficiently by relying on the identification, analysis, interpretation and visual representation of patent datasets. In addition, the methodology employed in this study promises to be useful in further developing approaches to patent analytics.

3.3. World Trade Organization Challenges to Tobacco Plain Packaging

To date, a record number of WTO members (in excess of 40) have joined those disputes as third parties. On 5 May 2014, the WTO Director-General appointed Mr. Alexander Erwin (Chair, South Africa), Professor François Dessemontet (Member, Switzerland) and Dame Billie Miller (Member, Barbados) as panelists to hear the disputes.

It is likely that the outcome of the case will not be known until sometime between late 2014

and early 2015. Depending on the outcome, this may be followed by an appeal.

4. Some Significant Court Decisions

4.1. *D'Arcy v. Myraid Genetic Inc.* [(2014) FCAFC 115]

The Full Federal Court of Australia affirmed in *D'Arcy v. Myraid Genetic Inc.* that isolated DNA and RNA are patentable subject matter under Australia law. The Court reiterated the NRDA test for patentable subject being an artificially created state of affairs and having utility in economic endeavour. The Court further stated that it was not the role of the courts to decide "whether, for policy or moral or social reasons, patents for gene sequences should be excluded from patentability". Accordingly, the Court found that an isolated gene sequence was different to gene in nature, in particular as a result of the isolation process.

4.2. *Apotex Pty Ltd. v. Sanofi-Aventis Australia Pty Ltd.* [(2013) HCA 50]

The High Court of Australia confirmed that medical treatment methods were patentable subject matter in Australia.

APAA 2014 EMERGING IP RIGHTS COMMITTEE REPORT – HONG KONG

1. Hong Kong Emerging IP Statistics Year 2013

NA.

2. Changes to Hong Kong's Legislations

NA.

3. Practice Changes

3.1. Update on the Reform of the Patent System in Hong Kong

On 7 February 2013, the Hong Kong Administration announced the adoption of the changes to the Hong Kong patent system, in particular, the creation of an "Original Grant" patent (the "OGP") system. Various steps have been taken to move forward in this direction:

(a) Commerce and Economic Development Bureau and the Intellectual Property Department ("IPD") [6 December 2013]: Signed a Co-operation Arrangement in the Area of Patent with the State Intellectual Property Office in China ("SIPO") for aid by providing technical assistance for substantive examination of patent applications and staff training.

(b) Working Group on Intellectual Property Trading ("Working Group") [10 September 2014]: Set out their strategies to develop the OGP system and encouraged the filling of quality inventions in Hong Kong, Mainland China and overseas.

On 7 February 2013, the Hong Kong Administration announced the adoption of the changes. The current aim is to launch the OGP system in 2016–17, while in the meantime, the Review Committee will explore interim measures to be launched together with the OGP system before the full implementation of the patent regime.

3.2. Update on the Reform of the Patent System in Hong Kong

On 9 October 2014, the Competition Commission ("Commission") and the Communications Authority published drafts of Guidelines ("Draft Guidelines") required by the Competition Ordinance (Cap. 619), as part of the preparatory work towards the full implementation of the Ordinance. Six Draft Guidelines were released:

3.2.1. Draft Guideline on the First Conduct Rule

It excludes agreements between undertakings in the same economic entity from the ambit of the First Conduct Rule.

It stated that resale price maintenance will be considered as anti-competition by object.

3.2.2. Draft Guideline on the Second Conduct Rule

The degree of market power of an undertaking will be assessed on a case-by-case basis.

It provides examples of what conduct may constitute abuse of substantial market power. For instance, refusal to grant intellectual property may amount to the aforesaid in exceptional circumstances, for example wherein such refusal prevents the development of a secondary market or a new product.

3.2.3. Draft Guideline on the Merger Rule

3.2.4. Draft Guideline on Complaints

3.2.5. Draft Guideline on Investigations

3.2.6. Draft Guideline on Application Exclusions and Exemptions

The first three Draft Guidelines set out how the Commission expects to interpret and implement the three competition rules and the latter three relate to procedural matters.

4. Some Significant Court Decisions

NA.

5. Contributed by

Anita Leung and Sheila Lee.

APAA 2014 EMERGING IP RIGHTS COMMITTEE REPORT – INDIA

1. Indian Emerging IP Statistics Year 2013

NA.

2. Changes to India's Legislations

NA.

3. Practice Changes

NA.

4. Some Significant Court Decisions

4.1. *NTT DoCoMo Inc. v. Controller of Patents & Design* [OA/39/2011/PT/CH]

(Proof of right mandatory for all patent applicants)

Intellectual Property Appellate Board (IPAB) passed an Order making it mandatory for the applicant, who is not the true and first inventor of the invention, to file a "proof of right" while applying for the patent It took into cognizance the scope of section 7(2) of the Indian Patents Act, 1970, which requires an applicant, other than the true and first inventor, to establish "proof of the right" to file a patent application. It nullified the 2004 notification issued by the Controller General of Patents that had waived the requirement to submit such proof in cases where the patent applicant was the same in the priority country and in India. The order is, however, silent as to whether this requirement is applicable only to cases which are currently pending or even those cases which have been granted in the last decade without the proof of right document on record.

4.2. *Dr. Aloys Wobben & Ors. v. Yogesh Mehra & Ors.* [AIR 2014 SC 2210 : 2014 (7) SCALE 536]

In the instant case, the Supreme Court ruled out that:

(a) If prior to the infringement suit, a defendant has filed revocation under section 64(1) before the IPAB, then the defendant would be disentitled to file a counter claim;

(b) If the defendant counter claims for revocation in a suit, he cannot thereafter file revocation under section 64(1) before the IPAB; and

(c) If any interested person has filed a post-grant opposition under section 25(2), he is barred from filing revocation before the IPAB under section 64(1) or filing a counter claim as a defendant in an infringement suit.

4.3. *Mumbai High Court upholds compulsory license to NATCO*: Bombay High Court

The Bombay High Court, while agreeing with IPAB decision on granting compulsory licensing to Nacto for a drug patented by Bayer Corporation, held that the grant of compulsory licenses is to be considered on a case to case basis. Further, importation is considered as

working so long as the patentee can justify the same.

4.4. *Chemtura v. Union of India* [2009 (41) PTC 260 (Del) : MIPR 2009 (3) 287] (Section 8 requirements)

In 2009, the Delhi High Court, in the case of *Chemtura v. Union of India,* emphasised on the need to comply with the obligations enshrined under section 8 of the Patent Act, 1970, while determining the validity of the patent.

4.5. *Koninklijke Philips Electronics N.V. v. Maj. (Retd) Sukesh Behl & Anr.* [2013 (56) PTC 570 (Del) : 205 (2013) DLT 680] (Section 8 requirements)

The Court said that it would have to be seen if the matter not disclosed was material to the grant of patent. Conversely, it also held that it is imperative to take into cognizance whether the aforesaid information was wilfully suppressed or not.

4.6. *XU Dejun & Ors. v. Vringo Infrastructure Inc. & Anr.*

A Division Bench of the Delhi High Court reversed the trend of setting interim arrangements in the form of royalty rates in favour of a plaintiff, where the plaintiff alleges infringement of Standard Essential Patents (SEPs) and claims FRAND (fair, reasonable and non-discriminatory) negotiations. Recognising the time sensitivity of patent litigation matters, the Court, inter alia, ordered an expedited trial of the suit.

4.7. *Interim injunctions granted in Novartis patent suits in Vildagliptin*: Delhi High Court

In a move to enforce its Indian Patent No. 212815 for Type 2 Diabetes Mellitus (Type2DM) compound Vildagliptin, Novartis initiated a series of suits as *quia timet* action before the Delhi High Court against various pharmaceutical companies. It contended that since the Defendants had been granted the permission to manufacture Vildagliptin pharmaceutical products, it was established that the Defendants intent to launch such product which would constitute infringement of the suit patent. The High Court favoured injunctions in favour of Novartis in some of the suits while passing restraining orders in others.

4.8. *Kibow Biotech Inc. v. La Renon Healthcare Pvt. Ltd*. (Positive news for bio-nutraceuticals)

The IPAB upheld a product patent relating to a dietary supplement comprising a probiotic composition that reduced the need for kidney patients to undergo dialysis. While rejecting the ground of obviousness, the IPAB noted that mere speculation of a hypothesis was not enough to defeat the claimed invention on the ground of obviousness. Besides, it stated that the claimed composition was indeed a synergistic composition having unexpected benefits and was not a mere admixture. It was, thus, held that the petitioner had deliberately misconstrued the scope and ambit of the invention. Based on the above analysis, the IPAB dismissed the revocation petition and imposed costs of INR 20,000 (approximately US$ 320) on the petitioner.

4.9. *Teijin Ltd. v. Union of India* [AIR 2014 Bom 68 : 2014 (4) BomCR 208] (Restoration of Patent)

The Bombay High Court restored a patent that had ceased due to procedural lapses on the part of the Patent Office. In the writ, the plaintiff claimed that the Patent Office violated the principles of natural justice by cancelling its registered patent without intimation or granting a hearing. The evidence highlighted that the petitioner had paid all annuities due for renewal of its patent within the prescribed time period and that it was the Patent Office which had

failed to rectify the register or promptly intimate Teijin to rectify any errors.

4.10. *Nitto Denko Corp. v. Union of India* [W.P. (C) 3756/2013]

The Delhi High Court issued an order directing the Indian patent office to file an affidavit indicating the state of affairs in the patents office regarding issuance of First Examination Report (FER) and to disclose the year wise pendency of patent matters. Upon the court's direction, a committee has been constituted to look into expediting examination of patent applications, recruitment of examiners, compensatory measures for applicants whose examination is delayed and so on.

5. Contributed by

D. Calab Gabriel.

APAA 2014 EMERGING IP RIGHTS COMMITTEE REPORT – INDONESIA

1. Indonesian Emerging IP Statistics Year 2013

Geographical Indication Applications Granted	27 (2007–2014) (3 new applications published during April–August 2014)

2. Changes to Indonesian Legislations

2.1. New Copyright Act

On 16 September 2014 the House of Representative passed the Bill on Copyright, replacing former Law No. 19 of 2002 on Copyright. The Indonesian Minister Laws and Human Rights said that the amended Copyright Act has emphasised more weight on protections of the economic and moral rights of authors and related rights owners. Further target will be to promote creative economy in Indonesia in order to increase economic growth. Key points in the new Copyright Act are, among others:

(a) In Article 16(3), copyright is intangible moving objects and could be used as collateral fiduciary.

(b) In Article 57(1), the protection of moral rights is unlimited.

(c) In Article 58(1), the protection of economic right is extended from 50 years after the creator's death to be 70 years after the creator's death.

(d) In Article 69, there will be one national collective management organisations (CMO) to collect and manage the royalty of copyright owners.

(e) Criminal copyright infringement now requires a formal complaint from the authorised/the holder of the rights.

(f) It regulates about traditional cultural expressions, data compilations and video games.

(g) Government has authority to block website containing the material of copyright infringement.

3. Practice Changes

3.1. Genetic Resources & Traditional Knowledge

Nagoya Protocol on Access to Genetic Resources and the Fair and Equitable Sharing of Benefits Arising from their Utilisation will begin to have an impact on 12 October 2014. Indonesia was among the 24 countries signing the protocol on 11 May 2011. Coinciding with efforts toward protocol compliance, Govt. of Indonesia has announced in May 2014 the construction of the Indonesian Culture Collection (InaCC), a microorganism collection center located at Cibinong, West Java province. The center provides several services including ordering and depositing cultures which is required in intellectual property like in patent

application. Establishment of the center is expected to contribute in improving the quality of food, animal feed, clothing, environment, health, and energy.

InaCC is operated under the management of Microbiology Division, Research Center for Biology, the Indonesian Institute of Sciences (LIPI). InaCC holds living collections since 1960's of filamentous fungi (mould), yeast and bacteria having important taxonomical data and physiological characters of mediating bio-processes in ood, health, pesticide, fertiliser, and bioremediation for improving the quality of human life.

The main objective of the culture collection is to facilitate *ex-situ* conservation of Indonesian microbial resources, to provide microbial resources for research, and aimed at optimising its potential use for national and international interest, and as one of important infrastructure of national research system and biotechnology.

Several functions of InaCC include as a library or depository of microorganism and its genetic materials (mainly Indonesia origin) used in scientific purposes (research and academic) and industrial purposes, and as a data source of microbial taxonomy.

InaCC is permitted to nationally or internationally exchange biological materials in the form of culture collection among culture collection centers, and other institutions especially aimed at enriching microbial collection and for research purposes. Culture collection exchange must comply with Material Transfer Agreement (MTA). Culture exchange fee is regulated by memorandum of understanding signed by both parties.

Joint research collaboration between InaCC and other parties with the use of culture collection of each party or both parties is encouraged and followed regulation through memorandum of understanding. Intellectual property right and benefit sharing of beneficiaries arising from joint research collaboration as described in the article is regulated under mutual and equal agree terms.

4. Some Significant Court Decisions

NA.

5. Contributed by

Kusno Hadi Kuncoro and Heru Lukito.

APAA 2014 EMERGING IP RIGHTS COMMITTEE REPORT – JAPAN

1. Japan Emerging IP Statistics Year 2013

Geographical Indication Applications Granted	27 (2007–2014) (3 new applications published during April-August 2014)

2. Changes to Japan's Legislations

2.1. Geographical Indication (GI) Act Promulgated on 25 June 2014

The Act aims to protect producers of certain agricultural products, promote local agricultural and food brands, and protect consumers. The Act shall come into force within one year from 25 June 2014. The products protected under the Act are those produced in a particular region, using a method unique to that area, thus linking a product's quality and reputation to its geographical origin. The registration is applied to the local producers' association. The local producers' association must submit the detailed statement which determined the production name, production method, geographic area, etc. to the Minister of Agriculture, Forestry and Fisheries with an application to apply for registration.

The local producers' associations will be responsible for checking whether products marketed under registered brand names meet the standard. Registered products will be allowed to bear a logo to indicate they are certified.

For the violator, the correction order by the Minister of Agriculture, Forestry and Fisheries is accomplished, and a criminal charge is inflicted.

There is already provided a regional collective trademark system that allows registration of marks consisting of a regional name and a generic name. (Trademark Act, Article 7-2).

Under the trademark system, producers are not obliged to set any criteria to register a product, and only members of the organisation that registered the product have the right to use the trademark. After the GI Act shall come into force, producers will be able to use both the GI system and the regional collective trademark system.

2.2. Amendment to Copyright Act

Copyright Law has been amended to expand publishing rights to cover an electronic book. The amendments shall come into force on 1 January 2015.

3. Practice Changes

NA.

4. Some Significant Court Decisions

4.1. H25 (Yo) 20003 *(Wall of Hope Case)* [Decided on 6 September 2013 by Osaka District Court] (Modification of a Garden)

In pursuant to Article 20(1), the Court read out that the author shall have the right to maintain the integrity of his work and its title, and no distortion, mutilation or other modification thereof shall be made against his intent. However, the Court found that the construction of the vegetated wall corresponds to remodeling of an architectural work pursuant to an analogical application of Article 20(2) (ii) and does not violate the right to maintain integrity.

5. Contributed by

Tomoya KurokawaM and Michiko Uji.

APAA 2014 EMERGING IP RIGHTS COMMITTEE REPORT – KOREA

1. Korean Emerging IP Statistics Year 2013

Geographical Indication Applications Granted	27 (2007–2014) (3 new applications published during April–August 2014)

2. Changes to Korean Legislations

2.1. Patent Act Revision

2.1.1. Specification Disclosure for obtaining the Filing Date and Accepted Languages (Enforced 1 January 2015)

Patent applications can be filed, simply with "idea description data" consisting of theses published in Korean or foreign journals or research notes, without complex restrictions to the filing format. Furthermore, the filed specification can be drafted in English. However, the specification of the Korean language must be filed within 14 months from the earliest priority date.

2.1.2. Amendment of Specification based on Foreign Applications (Enforced 1 January 2015)

Currently, simple mistranslations in the Korean translation cannot be corrected after entering an international patent application in the national phase. In order to substantively protect the rights of the applicant, the standards of amendments are converted to allow amendments within the scope of the specification in a foreign language (original-oriented), providing the actual rights of the applicant. Namely, mistranslations can be amended.

2.1.3. One Month Extension of Time for Filing a Korean Translation of the PCT Patent Application (Enforced 1 January 2015)

To allow the filing of high-quality Korean translations.

2.1.4. Less Strict Restoration of Patent Rights (Enforced 11 June 2014)

Under the current Patent Act, only patents "in force" can be restored. Under the revised Patent Act, however, all patents can be restored regardless of the status of the patents, and the fee to restore patent rights has also been reduced from three times the patent fee to two times the patent fee to minimise the burden on the patent holder

2.1.5. Pharmaceutical Affairs Act for Korean Patent-Regulatory Approval Linkage System

On 21 March 2014, the Ministry of Food and Drug Safety ("MFDS") announced draft legislation of the Pharmaceutical Affairs Act to fully implement the linkage system. The draft legislation includes revised provisions on the current patent listing and generic notice

systems, new provisions on the stay mechanism and generic exclusivity.

2.1.6. The Korea Fair Trade Commission (KFTC), to propel the report system of agreement on concluding pharmaceutical patent infringement

This is for preventing intellectual property right abuse under the approval patent linkage system. In accordance with health medical field, the report system of agreement on concluding patent infringement is to be implemented, in order to block the reverse payment, which can be derived from pharmaceutical field with the approval patent linkage system. If the agreement on concluding patent infringement is established between pharmaceutical companies, it is recommended to report to the KFTC.

2.1.7. No Monopoly of the Terminology, "App Store" by Apple

3. Practice Changes

3.1. Finding Future Prey in Big Patent Data

The Korean Intellectual Property Office ("KIPO") has revealed their initiation of the National Patent Strategy Blueprint Construction Project ("Blueprint Project") this year, which pursues prospective future technologies that can generate fundamental and core patents through a large-scale patent analysis on five industrial fields (agriculture, food and rural affairs; parts; LED and light; new renewable energy; and marine and aerial transportation). The KIPO is planning to categorize all industrial fields, except for the field of human society, into 18 industrial fields, and to construct Patent Strategy Blueprints for all 18 industrial fields by 2015, three to five industrial fields each year.

The KFDA sets up 12 months to discontinue the process of the generic approval during the patent infringement. One other significant change is that the exclusive rights for one year are to be given to the generic company that incapacitated the original patent. The KFDA decided to institute prior sale marketing approval, which grants the request of restricting the sales of the same drugs of other pharmaceutical companies up to one year, if the pharmaceutical company that won a patent suit against the patentees files a marketing approval first.

4. Some Significant Court Decisions

4.2. 2012 Hu 4162 [Decided on 20 March 2014 by Korean Supreme Court *en banc*] (Issue of inventive step cannot be raised in a confirmation-of-scope trial)

In the past, the Supreme Court has taken inconsistent positions on whether the inventive step of a patented invention or a registered utility model can be tried or decided in a confirmation-of-scope trial.

But, in a decision that appears to resolve inconsistencies in previous Supreme Court decisions, the Supreme Court, in a split decision, has ruled that a claim of lack of inventive step (non-obviousness) cannot be raised as a defensive move in a patent infringement action. Once a patent has been registered, its validity cannot be challenged in confirmation-of-scope proceedings until it has been invalidated in an invalidation trial.

5. Contributed by

Young Joo ROH, Keum Nang PARK and Byoung Hun Yoon.

APAA 2014 EMERGING IP RIGHTS COMMITTEE REPORT – NEW ZEALAND

1. New Zealand Emerging IP Statistics Year 2013

NA.

2. Changes to New Zealand's Legislations

2.1. A new New Zealand Patents Act came into force on 13 September 2014

There is at least one provision in the Patents Act 2013 that relates to emerging IP rights in the area of Māori traditional knowledge. Under the new Patents Act the Commissioner of Patents has to take into account if the invention being claimed pertains to the indigenous Māori's traditional knowledge or is derived from indigenous plants or animals. Any such inventions that fall into this category must be sent to and be considered by a Māori Advisory Committee. The function of the Māori Advisory Committee is to advise the Commissioner (on request) on whether:

(a) an invention claimed in a patent application is derived from Māori traditional knowledge or from indigenous plants or animals; and

(b) if so, whether the commercial exploitation of that invention is likely to be contrary to Māori values.

(c) The Commissioner must consider, but is not bound by, the advice given by the Māori Advisory Committee. It is envisaged that in the majority of cases the Commissioner will follow the advice of the Māori advisory committee.

(d) Since the commencement of the new Patent Act on 13 September 2014, there has been no patent application sent to the Māori Advisory Committee.

3. Practice Changes

NA.

4. Some Significant Court Decisions

NA.

5. Contributed by

Tom Robertson.

APAA 2014 EMERGING IP RIGHTS COMMITTEE REPORT – PAKISTAN

1. Pakistan Emerging IP Statistics Year 2013

NA.

2. Changes to Pakistan's Legislations

2.1. Plant Breeders' Rights Bill 2010 ("PBR Bill") yet to be passed

The PBR Bill had been pending for contemplation in the National Assembly for the past few years and it had received renewed attention from the government after the formation of Intellectual Property Organisation (IPO) as the regulator of Intellectual Property Rights (IPRs) in Pakistan.

The stakeholders, including the small farmers, as well as the civil society organisations have asked the government not to pass the bill in haste as more time is required to consider the proposed bill and resolve the issues arising thereunder, cause if passed in haste, the bill would have drastic implications for the small farmers and the agricultural sector. For this purpose, a seminar on "Plant Breeder's Rights (PBR) Bill 2010" was held by the Centre for Culture and Development (C2D), Sustainable Agriculture Action Group (SAAG), Potohar Organisation for Development Advocacy (PODA) and Lok Sanjh Foundation in collaboration with Actionaid-Pakistan to discuss the issues affecting the farmers and the agricultural sector in connection with the PBR Bill.

2.2. Electronic Publication of the Patent Journal

During the year, the Federal Cabinet approved the electronic publication of the Patent Journal and in this regard, the Director General, IPO-Pakistan presented a proposal for amendment in Patents Ordinance, 2000 to facilitate electronic publication of Patent Journal before Federal Cabinet in its meeting held on 18 April 2014. After detailed discussion, the Federal Cabinet approved the proposal.

2.3. Up-gradation of Industrial Property Automation System

Further the up-gradation of Industrial Property Automation System (IP AS) from the old technology (Centura) to a latest technology (Java) in IPO-Pakistan offices is under process. This is first step on the way to paperless environment which will lead towards the goal of online filing (e-filing) of IP applications in the coming years.

3. Practice Changes

NA.

4. Some Significant Court Decisions

NA.

5. Contributed by

Hameeda Asif, Auqil Ali Shah and Khushnum Muncherji.

APAA 2014 EMERGING IP RIGHTS COMMITTEE REPORT – PHILIPPINES

1. Philippines Emerging IP Statistics Year 2013

NA.

2. Changes to Philippines' Legislations

2.1. Republic Act (R.A.) No. 10643 ("The Graphic Health Warnings Law")

It seeks to have photographic messages as graphic health warnings on tobacco product packages, and remove misleading or deceptive numbers or descriptors like "low tar", "light", "ultra lights" or "mild" from the same. Manufacturers, importers and distributors are held liable for the violation of the provisions of this Act and are punishable by fine and/or imprisonment.

2.2. Free/Open Source Software (FOSS) Act (House Bill No. 1473)

It seeks to strengthen the public's access to information and data by mandating the use of open standards and formats in government. This Act likewise seeks to exclude from patent protection: (a) computer programs, techniques and methods in computing and arranging data for use in digital format, including algorithms; and (b) protocols, specifications, and methods of arranging data that are known to form part of open standards or are integral to implementation of open standards.

2.3. Anti-Online Piracy Act of 2013 (House Bill No. 915)

It seeks to prohibit copying, without the consent of the copyright owner, of music recordings or films, in complete or substantially complete form, by any means, including but not limited to uploading, downloading, or streaming.

2.4. House Bill No. 2324

It seeks to amend section 217.1 of R.A. No. 8293, otherwise known as the "*Intellectual Property Code of the Philippines*" by increasing the penalties for infringement.

2.5. Milk Nutrition and Labeling Act

The Senate version seeks to establish standards for the identity of milk and labelling thereof (Senate Bill NO. 364). The bill from the House of Representatives seeks to prohibit producers, importers, and traders of pasteurized and processed milk from using the label "fresh milk" in the packaging and sale of milk products (House Bill No. 231).

2.6. Draft Rules and Regulations on Geographical Indications

The IPO, through the Bureau of Trademarks ("BOT"), seeks to adopt and promulgate Rules and Regulations on Geographical Indications ("Draft GI-RR ") and schedule of fees ("Schedule of GI Fees").

2.7. Amendments to the Rules and Regulations on *Inter Partes* Proceedings (Office Order No. 14-068, Series of 2014, 27 May 2014)

It provides that the period within which the opposer must complete, or cure the defects of, the notice of opposition is increased from five (5) days to ten (10) days. Besides, the period within which the respondent must complete, or cure the defects of, the verified answer is likewise increased from five (5) days to ten (10) days.

2.8. Deferred Publication of Industrial Design Application (BOP Memorandum-Circular No. 14-004, Series of 2014, 20 May 2014)

This is to enable designers and companies applying for the registration of industrial designs to keep them secret from competitors until such time that these are placed in the market. The maximum period allowed for the deferred publication of an industrial design application shall be 30 months from the filing date or priority date of the application. In case the request for the deferred publication is made after the filing of the application, the allowable period for the deferred publication shall be the remaining time from the allowed 30 months deferred publication period.

2.9. Continuation of Patent Prosecution Highway (PPH) Pilot Programs between the Intellectual Property Office (IPO) of the Philippines & the United States Patent and Trademark Office (USPTO) (2014) (Office Order No. 14-016, Series of 2014)

On 29 January 2013, the IPO commenced the PPH 2.0 Pilot Programs (PPH & PCT-PPH) with USPTO. The IPO indicated that both pilot programs would terminate on 28 January 2014, but may be extended thereafter. The PPH is a framework in which an application whose claims have been determined to be patentable in the Office of First Filing (OFF) is eligible to go through an accelerated examination in the Office of Second Filing (OSF) with a simple procedure upon filing of a request. In order to further assess the feasibility of both the PPH and PCT-PPH Pilot Programs, the USPTO and the IPO have agreed to extend the pilots indefinitely, under the same guidelines.

2.10. The BOT Office Order No. 13-06, series of 2013, was issued to provide for *implementation guidelines* of Office Order No. 13-061, series of 2013 entitled "***Trademark Applications with Priority Right Claim***".

2.11. The National Telecommunications Commission promulgated the *Implementing Rules and Regulations* 8 on R.A. No. 10515 or the "***Anti-Cable Television and Cable Internet Tapping Act of 2013***."

2.12. The Office Order No. 13-169 on ***Rules on Resolution of Public Performance Disputes*** was issued by the IPO pursuant to R.A. No. 8293, as amended. The Office Order grants the newly-created Bureau of Copyright and Other Related Rights of the IPO original jurisdiction to resolve disputes relating to the terms of a license involving the author's right to public performance or other communication of his work.

2.13. The Office Order No. 13-170 on ***Rules of Procedure on Intellectual Property Enforcement*** was issued by the IPO pursuant to sections 7 (c) (d) & (e) of R.A. No. 8293, as amended.

3. Practice Changes

3.1. Project Gawi

On 25 April 2014, the LES Philippines launched "Project Gawi" for the purpose of raising awareness about Filipino Traditional Knowledge, particularly customary organic farming practices of Filipino tribes.

3.2. Philippine Traditional Knowledge Digital Library on Health

The University of the Philippines, Manila, recently developed a digital library of the country's traditional practices on health and healing to prevent them from being patented by private companies. The website helps prevent private entities from exclusively claiming the therapeutic practices or medicinal products of indigenous groups by creating proof of ownership for the traditional knowledge.

4. Some Significant Court Decisions

NA.

5. Contributed by

Alban Kang and Jonathan Foong.

APAA 2014 EMERGING IP RIGHTS COMMITTEE REPORT – SINGAPORE

1. Singapore Emerging IP Statistics Year 2013

NA.

2. Changes to Legislations

2.1. New Geographical Indications Act ("GI Act") to be enacted

A new Geographical Indications Bill for Singapore has been passed by Parliament on 14 April 2014. It will replace the current GI Act once it is brought into force. The new GI Act is a consequence of Singapore's commitments under the European Union-Free Trade Agreement ("EUSFTA"). The main inadequacies of the current GI regime stem from the fact that it lacks a registration system. A register will provide a supporting institutional mechanism for the protection of GIs. The absence of a registration system leaves producers and other interested parties with no other recourse but to file a civil claim in the Singapore courts where they will have to first prove that they are entitled to protection for the GI in question. While owners of GIs can currently look to the provisions of the Singapore Trade Marks Act ("TM Act") which allow for the registration of certification or collective marks, such routes to protection are not always suited to GIs.

2.2. Establishment of a GI Registry

A new GI Registry will be established, which will be administered and maintained by the Intellectual Property Office of Singapore ("IPOS"). Applications for the registration of a GI may be made by producers of the relevant goods, a competent authority, or trade organisations or associations dealing with those goods.

The application will undergo substantive examination by the IPOS. A key requirement for the registration of a GI would be the outlining of details of its "quality, reputation or other characteristic", as linked to the geographical origin of the goods. Upon acceptance, the GI will be published for possible opposition. Applications for registration will be possible for a fairly long list of natural products including wines, spirits, cheeses, meat products, seafood, edible oils, fruits, vegetables, spices, condiments, confectionery and baked goods and flowers.

Apart from easier recognition of their rights, the owners of a registered GI will also have access to improved border enforcement measures. This includes being able to request the customs authorities in Singapore to restrict the importation of infringing goods, or seize infringing goods which are expected to be exported.

The new GI act will be a sui generis system of protection. Producers and associations will have a further option as to whether to register their GI under the GI Registry or as a certification or collective mark under the TM Act. Protection for a GI can therefore be acquired in a cumulative manner.

2.3. Implementation of the New GI Act

The provisions of the new GI Act will come into operation in several stages, alongside the ratification process of the EUSFTA. The phased implementation approach will also allow organisations and their operations in Singapore time to adjust their policies, processes and systems to comply with and take advantage of the enhanced protection regime for GIs.

Within three years of entry into force of the EUSFTA, the border enforcement measures will come into effect.

2.4. Consequential Amendments to the TM Act to be made

A trade mark cannot be registered if there exists a prior identical or similar GI that has been applied for registration, or is registered in the GI register.

3. Practice Changes

3.1. Public Consultation on the Review of the Registered Designs Regime in Singapore

The IPOS conducted a public consultation exercise in May/June 2014 on the review of the registered designs regime in Singapore to obtain feedback from members of the public on possible improvements that can be made to the current regime. The last major review of the registered designs regime took place in 2000. The objective of the public consultation was to assist in the crafting of a designs regime relevant to stakeholders who would support and encourage the growth of designs-related industries, and one which is able to deal with the advent of new technologies and business models.

4. Some Significant Court Decisions

NA.

5. Contributed by

Alban Kang and Jonathan Foong.

APAA 2014 EMERGING IP RIGHTS COMMITTEE REPORT – SRI LANKA

1. Sri Lanka Emerging IP Statistics Year 2013

NA.

2. Changes to Sri Lankan Legislations

There have been no significant developments in Sri Lanka in this area.

Concern groups have been actively considering the introduction of a Plant Variety Legislation in Sri Lanka although this is still at an initial stage.

There is considerable interest in the law relating to Traditional Knowledge and several interested groups continue to discuss this matter with a view to ascertaining how Traditional Knowledge could be protected in Sri Lanka.

3. Practice Changes

NA.

4. Some Significant Court Decisions

NA.

5. Contributed by

J. M. Swaminathan.

APAA 2014 EMERGING IP RIGHTS COMMITTEE REPORT – TAIWAN

1. Taiwan Emerging IP Rights Statistics 2013–2014

NA.

2. Changes to Australian Legislation

2.1. Border Protection Measures introduced to the Patent Act

In the past practice, Customs would detain goods only after having received a judicial injunction so a patentee had to request a preliminary injunction from the court. After the injunction had been granted, the patentee could petition the court to send execution orders to Customs for assistance in enforcement. The key points to the amendments to the Patent Act on 3 January 2014 are:

i. ***Detention procedures***

To make a detention request, the requestor shall show the written document specifying the facts of infringement as well as provide a security amounting to the duty-paid price of the accused goods.

Customs should give notice to the requestor and the owner of the detained goods after the validity of the aforesaid request is confirmed.

Based on the condition where confidential information protection of the goods is not damaged, Customs shall allow both parties to examine the detained goods.

ii. ***Repeal of detention***

When one of the following conditions exists, Customs should repeal the detention: if the requestor does not file an infringement litigation within twelve days from the date when the detention request is accepted by Customers, if a final and binding judgement by a court of law on non-infringement is rendered, if the requestor revokes the detention request, or if the owner provides counter security of the detained goods.

However, once the cause of repeal is attributable to the requestor, all the costs, including the fees of warehousing, loading and unloading the detained goods, shall be borne by the requestor.

iii. ***Damages***

If a final and binding judgment made by a court of law declares that the detained goods do not infringe the patent rights, the requestor shall be liable to the owner of the detained goods for the damages caused by the detention. Besides, both parties may file a request with Customers to return their security or counter security if a settlement has been reached or one obtains the other party's agreement.

It is apparent that the main purpose of said amendments is to strengthen the protection of patent rights.

2.2. Amendment to the Intellectual Property Case Adjudication Act

To further protect an owner of the trade secrets, an amendment to the Intellectual Property Case Adjudication Act has been effective since 6 June 2014. According to the amendment to the Intellectual Property Case Adjudication Act (Article 10.1 of the said Act), if an owner of the trade secrets (hereinafter "the complainant"), in a trade secret infringement litigation, has sufficiently presented the matter of fact regarding its claim for trade secret infringement, the accused infringer should give substantive reasons and suitable arguments on denying the complainant's claim or the court will demand the accused infringer to provide necessary reasons and arguments. Where the accused infringer disobeys such demand without giving a justifiable reason, the court may, in its discretion, take as the truth the complainant's allegation with regard to its claim for trade secret infringement. The amendment to the Intellectual Property Case Adjudication Act makes the infringer carry heavier burden of proof for non-infringement.

3. Practice Changes

NA.

4. Some Significant Court Secisions

NA.

5. Contributed by

Mr. Fu-Chu Chen, Ms. Grace W.T. Liao and Mr. Jerry C.Y. Lin.

APAA 2014 EMERGING IP RIGHTS COMMITTEE REPORT – THAILAND

1. Thailand Emerging IP Statistics Year 2013

No. of Plant Varieties Registered	70
No. Of Geographical Indication Filed	21

2. Changes to Thailand's Legislations

2.1. Protection and Promotion of Traditional Thai Medicine Wisdom (TTMW) Act

In the light of the Intellectual Property Rights in TTMW, the Department of Traditional Thai and Alternative Medicine has issued the Specifications for Application of a Right in TTMW. The main elements of the Specifications are:

(a) Category of the traditional Thai medicine wisdom, which includes traditional Thai drug formulas and traditional Thai medicine text.

(b) Specifications and qualities of traditional Thai medicine wisdom to be declared during the right registration.

(c) Specifications to be indicated on the registration form.

2.2. Trade Secret Act

In former times, the Department of Intellectual Property (DIP) allowed trade secret proprietors to record their trade secret information to protect the IP rights of Thai IP owners. The DIP, however, recently issued a Notification announcing that they are no longer accepting applications for the registration of trade secrets, effective 15 June 2013. There still is an online service for a trade secret search on the DIP's website.

3. Practice Changes

3.1. Protection of Geographical Indication Act

With respect to policy movement, in 27 March 2014; and international symposium called Worldwide Symposium on Geographical Indications 2013 was hosted by WIPO in Thailand. The participants were professionals from many international agencies and organisations from various fields with an aim to create a mutual point of view and to exchange opinions on the future of Geographic Indicators (GI).

The purpose of the Worldwide Symposium on Geographical Indications is to enhance knowledge for entrepreneurs and those interested in GI development in order to add value to their products and to commercially use the GI in the sense of an intellectual property which link characteristic of products to the geographical source of products. There were GI exhibitions from European countries, ASEAN, Japan, Mexico, United States of America, and Thailand as well as exhibition booths of 38 registered agricultural, handicraft, and industrial products; including "Tung Kula

Rong-Hai Thai Hom Mali Rice: TKR" which have been registered for geographical indications in the E.U.

The main content of the exhibition is the development and management of Geographical Indications, brand creative strategy, and the future of Geographical Indications in an international forum which will enhance and encourage all segments of Thailand to be aware of the significant in relationship development between entrepreneurs and communities using Geographical Indications as a tool. This measure is conform to the 11th National Economic and Social Development Plan of Thailand which emphasise on reform the economic structure by using knowledge and creativity as one of the option to add value to the nation economy. Moreover, the measure also helps to promote Thailand as a champion country of Geographical Indications in Southeast Asia which will complete the intention in the ASEAN Intellectual Property Rights Action Plan.

4. Some Significant Court Decisions

NA.

5. Contributed by

Kowit Somwaiya and Areeya Ratanayu Pornwiriyangkura.

APAA 2014 EMERGING IP RIGHTS COMMITTEE REPORT – VIETNAM

1. Vietnam Emerging IP Statistics Year 2013

NA.

2. Changes to Vietnam's Legislations

NA.

3. Practice Changes

NA.

4. Some Significant Court Decisions

4.1. Decree No. 131/2013/ND-CP dated 16 October 2013 on sanctioning of administrative violations in the domain of copyright and related rights ("Decree 131"), effective as from 15 December 2013

Decree 131 clarifies fine levels applicable to individual infringers and organisational infringers. In particular, for a relevant violation, the maximum fine level applicable to an organizational infringer is VND 500 million (appr. US$ 25,000), meanwhile the fine applicable to an individual infringer is VND 250 million (appr. US$ 12,500). The determination of fine level in accordance with Decree 131 is no longer based on the value of the infringing goods, but it now provides for a range of fine values for particular violating acts.

In addition, acts of transporting and storing goods produced without authorisation of the copyright or related rights holder will be subject to additional sanction of confiscation of the material evidence.

Measures for remedying violation consequences comprise of, *inter alia*:

(i) order on correction of the name of the author/performer;

(ii) order on removal of e-copies of protected works, performances, recordings, broadcasted programs from the Internet, digital environments; and

(iii) order on payment of royalties, compensation and other property benefits gained from the violating act to the copyright/copyright-related rights owner.

4.2. Decree No. 185/2013/ND-CP dated 25 November 2013 sanctioning administrative violations in commercial activities, manufacturing of fake and banned products, and protecting consumers' rights ("Decree 185"), effective as from 1 January 2014

Decree 185 has been issued as a consolidation of seven previous decrees relating to the respective domains, with relevant amendments and supplementations. Accordingly, for acts of producing, trading fake or banned products, the maximum fine applicable to individual violators is VND 200 million (approx. US$ 10,000), while the maximum fine applicable to organizational violators is VND 400 million (US$ 20,000).

4.3. Decree No. 181/2013/ND-CP dated 14 November 2013 detailing a number of articles of the 2012 Advertising Law, effective as from 1 January 2014

Decree 181 clarifies that official confirmations on advertising contents are required for advertising special goods and services including drugs, cosmetics, foods and food additives, household and medical chemicals, pesticides and antiseptics, medical equipment, milk products and nutritional supplements for small children, certain medical services, plan protection preparations, fertilisers, etc. The competent authorities responsible for issuing such confirmations are the Ministry of Health, the Ministry of Industry and Trade, and the Ministry of Agriculture and Rural Development subject to each ministry's specialized management competence.

Decree 181 requires that the advertisement on websites of foreign service providers providing cross-border advertising services in Vietnam must be conducted through Vietnamese licensed advertising service providers, and foreign advertising service providers having income from advertising services in Vietnam must pay taxes required by Vietnam law.

In addition, foreign service providers providing cross-border advertising services in Vietnam are responsible for notifying the competent authority of certain information about their local advertising agents in Vietnam 15 days prior to the commencement of running relevant advertisements.

4.4. Decree No. 158/2013/ND-CP dated 12 November 2013 on sanctioning of administrative violations in the field of culture, sports, tourism and advertisement ("Decree 158"), effective as from 1 January 2014

In connection with the provision on confirmation requirements for advertising special goods or services as provided in Decree 181 mentioned above, acts of advertising special goods or services without the required confirmation are subject to administrative sanctions of from VND 5 million (approx. US$ 250) to VND 10 million (approx. US$ 500). In addition, the advertisements in question must be removed.

Failure to notify the competent authority of the required information about the Vietnamese advertising agents by foreign service providers providing cross-border advertising services in Vietnam shall be subject to a fine of from VND 2 million (appr. US$ 100) to VND 5 million (appr. US$ 250).

4.5. Decree No. 185/2013/ND-CP dated 25 November 2013 sanctioning administrative violations in commercial activities, manufacturing of fake and banned products, and protecting consumers' rights ("Decree 185"), effective as from 1 January 2014

Setting up or amending and supplementing e-commerce websites without reporting to the competent authorities will result in fines of from VND 5 million to VND 10 million (approx. US$ 250–500), while those websites failing to keep customer information confidential will be fined VND 30 million (approx. US$ 1.500). In addition, violating e-commerce websites will have their operations suspended for 6 to 12 months, the domain name of ".vn" may be withdrawn and the owners of the websites may be ordered to hand in illegal gains earned from such violations.

The maximum fine applicable for an act of violation in the domain of e-commerce is VND 100 million (approx. US$ 5.000).

4.6. Decree No. 71/2014/ND-CP dated 21 July 2014 providing the handling of law violations in unfair competition ("Decree 71"), effective as from 15 September 2014

Decree 71 specifies the way to calculate the fine levels for a violation of provisions on control of competition restriction acts. The

fine level is based on the following factors, in priority order: (i) a percentage of selling revenue or purchasing sales of the relating goods/ services; or (ii) the enterprise's total revenue of the preceding year. Such percentage will be determined by the competent authority based on certain elements, including the extent of the completion restriction caused by the violation, the level of damage caused by the violation, the possibility of causing competition restriction of the violating subjects, violation time, profits earned from the violation, etc. However, such percentage must not exceed 10% of the enterprise's total revenue of the preceding year.

For violation of provisions on unfair competition and other provisions on competition, the minimum fine level is VND 2 million (approx. US$ 100), and the maximum fine level is VND 100 million (approx. US$ 5,000) for individual infringers, or VND 200 million (approx. US$ 10,000) for organisational infringers.

Specifically, an act of advertising for the purpose of unfair competition may be subject to a fine of up to VND 140 million (approx. US$ 7,000), meanwhile a fine of up to VND 80 million (approx. US$ 4,000) may be imposed for a commercial promotion for the purpose of unfair competition. This fine will be increased to VND 100 million (approx. US$ 5,000) in cases where such promotion is conducted in two or more provinces.

4.7. Decision No. 38/2014/QD-TTg dated 1 July 2014 regulating auction, transfer of right to use of telecommunications number storage and internet domain names ("Decision 38"), effective as from 1 September 2014

Decision 38 allows entities to transfer ".vn" domain names of which they have the legal right of use as granted by the competent authority. The transfer of a registered ".vn" domain name is prohibited in the following cases: (i) domain names with protection priority as specified by the Ministry of Information and Communications ("**MOIC**"), including domain names which are the names of the Party organisations, State authorities, socio-political organisations and other domain names in association with national interests, security and sovereignty; and (ii) domain names which are objects of handling of violations, dispute resolution or currently suspended from use. A transferee of the right to use of a ".vn" domain name must conduct the re-registration of such domain name for officially recording such transferee as a new entity having the legal right to use such domain name. Parties involved in a ".vn" domain name transfer transaction are responsible for non-acceptance of the domain name transfer by the competent authority in case the domain name to be transferred is suspended or revoked in accordance with the regulations during the transfer process.

Decision 38 also provides for the auction of certain ".vn" domain names. Accordingly, determination of ".vn" domain names which are subject to auction are based on the result of the survey on use demand for such domain names. In particular, a domain name with high use demand will be classified as an auctionable domain name. The MOIC will approve the list of domain names brought to auction.

4.8. Circular No. 09/2014/TT-BTTTT dated 19 August 2014, on management, provision and usage of information on websites and social networks ("Circular 09"), effective as from 3 October 2014

Circular 09 requires that internal websites, specialized application websites and social networks which provide collective information be subject to registration requirements similar to those promulgated for a collective website. Furthermore, internal websites, specialised application websites and collective websites which establish social networks are to be registered as social networks. For a registered collective website or social network, the owner must establish the relevant website

or network within 90 days from the effective date of the operation license or the license will be automatically invalidated. If a registered collective website or network is transferred, a new registration is required within 30 days from the date of transfer.

As specified in Circular 09, an individual owner of a personal website has the right to share legitimate information on his/her website and is responsible for contents posted by himself/herself. However, such person is not representative of any other entities, and the provision of collective information on his/her website is strictly prohibited. Collective websites other than collective websites of press agencies that quote information from other registered press websites must comply with the regulations on information resources and must not post comments of readers on such quoted information.

Technical systems of social networks must meet the requirements of having the ability to store information about accounts, log-in and log-out times, IP addresses of users and history of processing posted information for at least two years; to execute the registration and storage of user information, including: DOB, ID card or passport number, date of issuance, place of issuance, phone number and email address; to verify service users through messages sent to the telephone number or email box provided by the users during their registration; and to be available for connecting to, verifying personal information with the electronic ID card database or the National Personal Code System at a request from the competent authorities.

5. Contributed by

Dang The Duc.

APAA 2014 ANTI-COUNTERFEITING COMMITTEE REPORT – AUSTRALIA

1. Australian Anti-Counterfeiting Statistics 2012–2013

No. of seizures of counterfeit goods	1,694
Quantity of infringing products involved	296,186

2. Changes to Australian Legislation

2.1. Australian Law Review Committee Report: The report suggested introduction of the US "Fair Use" provision in the Australian Copyright Act.

2.2. The Anti-Counterfeiting Trade Agreement: ACTA has not yet been ratified.

3. Practice Changes

3.1. Australian Federal Court has approved a settlement deal that will require Target Australia to pay Estée Lauder AU$ 1 million in compensation for selling products in the MAC. line that Estée Lauder claimed were fake.

3.2. In 2012, legislation was enacted to standardise tobacco product packaging. The new legislation required that brand names should only be present in a standard font and exclude any other graphic or text elements by which manufacturers can express their brand identity. However, a survey report published by KPMG in 2013 stated an increase in the illicit trade of cigarettes, both counterfeit and illegally branded imports.

4. Some Significant Court and Office Decisions

4.1. *Facton Ltd. & Ors. v. Remmy Cardin Pty Ltd.* [(2014) FCCA 627]

The applicants alleged copyright and trade-mark infringement, breaches of the Australian Consumer Law and "passing off" by the sale of counterfeit clothing bearing the applicants' G-STAR branding. The respondent did not file an address for service or appear before the court, thus the applicants filed an interlocutory application seeking default judgment and damages. The Federal Circuit Court of Australia decided in favour of the applicant, awarding reasonable damages for infringement of applicants' trademarks, copyright works, contravened under sections 18 and 29 of the Australian Consumer Law and for engaging in the tort of passing off.

4.2. *Malletier v. Sonya Valentine Pty Ltd.* [(2013) FCA 933]

The applicant, Louis Vuitton Malletier, sold luxury goods internationally, including Australia. The applicant alleged trade-mark infringement, misleading or deceptive conduct and passing off. The applicant is the owner of the mark "LOUIS VUITTON" and the device mark ⌖. The applicant's range of goods included sunglasses, also being sold by the respondent, who is an importer and distributor in Australia of goods sourced in China, which bore the mark "LOUIS V". The respondent offered for sale, and sold, those goods to retailers in Australia. These goods

also bore a "flower" symbol and by admission of the respondent it was found that a small number of the sunglasses into the trade bore the expression "EYEWEAR EST 1941 PARIS". The applicant alleged that the expression "LOUIS V" was deceptively similar to its registered mark "LOUIS VUITTON", and that the flower symbol referred to was deceptively similar to its flower device mark. Further, it was claimed that, by trading in sunglasses marked in these ways, the respondent engaged in misleading or deceptive conduct in contravention of section 18 of the Australian Consumer Law and made false or misleading representations in contravention of section 29(1)(a), (g) & (k) of the Competition and Consumer Act.

As the respondent remained absent from the hearing of the interlocutory application, a default judgment was applied for by the applicant. The Federal Circuit Court of Australia found TM infringement and contravention of the Competition and Consumer Act. Declarations and a permanent injunction were issued. An order for delivery up and destruction of a wide range of artefacts including the sunglasses was also issued as well as procedural orders to assist in the election between damages and an account of profits as well as to establish the circumstances, including sales and conduct of the applicant to assess damages pursuant to the Competition and Consumer Act.

4.3. *Halal Certification Authority Pty Ltd. v. Scadilone Pty Ltd. & Ors.; Halal Certification Authority Pty Ltd. v. Quality Kebabs Wholesalers Pty Ltd. & Ors.* [(2014) FCA 614]

The applicant, Halal Certification Authority Pty Ltd., certified that food was halal and prepared in accordance with Islamic rites. It issued certificates bearing a seal, which was registered as a trade mark. Halal Certification Authority commenced proceedings against two restaurant operators Scadilone Pty Ltd. and White Heaven Pty Ltd. It also commenced proceedings against the wholesale manufacturer of kebabs; Quality Kebab Wholesalers Pty Ltd. Halal Certification Authority alleged that Scadilone and White Heaven had infringed its trade marks by displaying a certificate, "Certificate of Halal Products", on their respective premises, which included its seal. These businesses obtained the certificates from Quality Kebab wholesalers.

The principle that was laid down in the said case was that Certificate(s) issued by the Certifying Authority can be registered as a Trade Mark, which if copied without the permission of the owner would amount to infringement of the trademark.

4.4. *Seafolly Pty Ltd. v. Fewstone Pty Ltd.* [(2014) FCA 321]

The applicant, Seafolly Pty Ltd, and the respondent, Fewstone Pty Ltd, both design, manufacture and sell swimwear and beachwear. Fewstone trades as City Beach Australia. Seafolly commenced proceedings against Fewstone in the Federal Court of Australia, alleging copyright infringement in three artistic works: the "English Rose" artwork; the "Covent Garden" artwork; and the "Senorita" artwork. Similar to the Louis Vuitton case, in this case as well the court illustrates that a copier can't necessarily avoid infringement even if they did not make a direct copy of the goods and/or TMs.

As Seafolly had a reputation for originality and exclusivity and City Beach's infringing products could decrease consumer willingness to purchase Seafolly's goods, the court entitled it to an award of compensatory damages of $20,000 for damage to its reputation. The Federal Circuit Court of Australia further found that City Beach intended to copy Seafolly's artistic works as it continued to sell its goods even after receiving notice of Seafolly's concerns about copyright infringement. General and specific deterrence warrant a substantial award of additional damages in the amount of $ 150,000.

5. Contributed by

Chris Owens, Ian Rose and Andrew Morton.

APAA 2014 ANTI-COUNTERFEITING COMMITTEE REPORT – HONG KONG

1. Hong Kong Anti-Counterfeiting Statistics 2013–2014

No. of counterfeit goods cases	99
No. of IP rights infringement cases	633 (88% of 720)
No. of online counterfeit goods cases	162

2. Changes to Hong Kong's Legislations

2.1. Trade Descriptions (Unfair Trade Practices) (Amendment) Ordinance 2012: The amended Ordinance introduces new offences involving false description of services, thus plugging a critical loophole in the Trade Descriptions Ordinance the definition of "trade description" in respect of goods to mean any indication has been expanded, false trade descriptions in respect of services made in consumer transactions has been prohibited and "services" under the Consumer Act has been defined by way of this amendment.

2.2. Further, new offences have been created on practices as misleading omissions, aggressive commercial practices, bait advertising, bait-and-switch and wrongly accepting payment. Civil compliance-based enforcement mechanism in addition to criminal sanctions has also been introduced.

2.3. A set of Enforcement Guidelines has been published by the Customs and the Communication Authority in July 2013.

2.4. Schedule 3 of the new Ordinance contains the categories of professionals who are excluded from coverage by the new Ordinance including solicitors, trainee-solicitors, barristers, pupil-barristers, pharmacists, chartered accountants and medical practitioners.

3. Practice Changes

NA.

4. Some Significant Court and Office Decisions

4.1. Re *Power Dekor (HK) Ltd*. [(2014) HKEC 42]

Under the Companies (Amendment) Ordinance 2010 la, if the company name was not the same as another name on the Company Register and did not contain certain specified words or expressions, the applied-for company name would be accepted for registration. Nonetheless, if the company name was found to be objectionable subsequently, the Registrar of the Companies ("the Registrar") was empowered to direct the company in question to change its name. The Court of First Instance however, criticised these provisions as they did not provide sufficient protection for brand name

proprietors and suggested that more effective measures, such as giving the Registry power not to register a company name or to deregister a company with offending names. The Court also suggested that the Companies Ordinance should empower the Registry to play a more proactive role in scrutinising company names before accepting them for registration.

Key Enforcement Activities:

4.1.1. In January 2014, the Customs found a bakery had been selling bread products containing artificial flavours or extracts, contrary to the claims of "natural" and "no addictives" on its official website and advertisements. The bakery was co-operative in the course of investigations and proposed to undertake in writing not to continue the offending conduct and to take remedial actions, which was accepted by the Customs.

4.1.2. In February 2014, a mobile, dried-seafood stall operator was convicted for misleading sales practice under the amended Ordinance in the course of selling dried abalone to customers. He was sentenced to one month's imprisonment and HK$100,000 worth of abalone was seized and confiscated.

4.1.3. In October 2014, a Customs officer, disguised as a customer, conducted a test-buy operation at a drug store. About 1,000 pills of lookalike medicines with an estimated value of HK$4,000 were seized. A 25-year-old salesperson suspected of selling the medicines with unfair trade practices was arrested. In the test-buy, the salesperson concerned passed off lookalike products to the Customs officer as genuine medicines. He also claimed that the lookalike goods were the genuine medicines in old packaging.

5. Contributed by

Robin Bridge and John Liu.

APAA 2014 ANTI-COUNTERFEITING COMMITTEE REPORT – INDIA

1. India Anti-Counterfeiting Statistics 2012–2013

NA.

2. Changes to Indian Legislation

No legislative changes.

3. Practice Changes

Proactive measures have been adopted and steps taken to curtail counterfeiting.

3.1. Government initiatives

The Department of Industrial Policy and Promotion (DIPP) functioning under the Ministry of Commerce and Industry has, through the Office of the Controller General of Patents, Designs and Trade Marks (CGPDTM), been conducting programs for creating general awareness on the need and manner in which protection should be sought for intellectual property generated.

Programs are also conducted for stakeholders on building respect for intellectual property rights and sensitising the enforcement agencies such as the state police force, judiciary, etc.

The **Drugs and Cosmetics (Amendment) Bill, 2013** was introduced in the Upper House of the Parliament in the fall of 2013 and is pending. The Bill proposes establishment of Central Drug Authority by the Central Government which will subsume the existing Central Drugs Standards Control Organisation; contemplates provisions to ensure standard quality of drugs, cosmetics, and medical devices and specifies conditions under which they will be considered misbranded, adulterated, and spurious; specifies penalties and offences for the same.

The **National Council of Applied Economic Research** (NCAER) in association with the Ministry of Human Resource Development (Copyright Division, Department of Higher Education) Government of India, in January 2014 prepared and circulated a report on "The Impact of Parallel Imports of Books, Films/ Music and Software on the Indian Economy with Special Reference to Students".

Self-certification bar-coding for drug export: The Directorate General of Foreign Trade (DGFT) has issued a public notice informing that a self-certification process on compliance of bar-coding requirement on secondary (packets) and tertiary-level packaging (carton) of pharmaceuticals and drugs has been introduced. Implemented, in May, 2014, bar-coding would also assist in tracking and tracing the origins of drugs which in turn will help in minimizing chances of genuine drugs being considered spurious, substandard or counterfeit.

3.2. Police

The police have been instrumental in carrying out **raids** in various parts of the country and have targeted various entities/persons indulging in counterfeiting activities.

The Delhi Police in April, 2014 launched the Copyright Enforcement Tool Kit – a ready reference to assist police in protecting IPR. The crime branch of the Aurangabad police in May, 2014 arrested two persons under the Copyright Act for allegedly downloading and distributing songs and movies from a mobile phone shop. The Central Crime Branch (CCB) of Bangalore city police arrested the owner of a garment factory and seized fake shirts and trousers worth INR 2000000 (approx.US$ 33500) from his facilities in Bangalore south.

3.3. Customs

The Central Board of Excise and Custom (CBEC) released in January, 2014 the Customs Manual 2014 to make available an updated guide to all Customs officers handling clearance of goods and other related matters. A software module called Automatic Recordation & Targeting System (ARTS) has been developed by the CBEC with the objective of (i) Effective implementation of the Intellectual Property Rights (Imported Goods) Enforcement Rules, 2007; (ii) Integration of IPR enforcement with Customs clearance procedure; (iii) Providing a platform for right holders to record their rights online with Customs; (iv) Enabling national targeting of suspect consignments; (v) Creation of a centralised national database containing useful information for enforcement; (vi) Providing access to National data for the Customs field officers; and (vii) Trade facilitation.

Indian Customs is developing a barcode-based system using GS1 standards to curb import of counterfeits. It would connect Customs officials to several product identification databases and services with detailed and authentic product information through mobile scanning of GS1 barcodes on product packaging.

3.4. Industry

Report "Counterfeiting, Piracy and Smuggling in India – Effects and Possible Solutions"

A report was prepared by the International Chamber of Commerce (ICC), Business Action to Stop Counterfeiting and Piracy (BASCAP) – an initiative of ICC and India's FICCI CASCADE (a Committee Against Smuggling and Counterfeiting Activities Destroying Economy established by the Federation of Indian Chambers of Commerce and Industry (FICCI)). The report highlights the serious consequences of the increase in counterfeiting, piracy and smuggling in India and calls for more government attention to these issues at the national, state and local levels and recommends implementing India's existing laws and regulations.

National Consumer Rights Week, 2013: candle light congregation organized by Consumer Action and Network Society in association with FICCI CASCADE in Jaipur (State of Rajasthan) to energize the consumers to take up the fight against smuggling and counterfeiting.

Cyclothon was organised by FICCI CASCADE on 29 December 2013 on the theme of "Fight against Counterfeiting and Smuggling" in Lucknow (State of Uttar Pradesh). Around 250 students from across the city took part in the race and peddled for the cause of "Fight the Fake" and "Quit Smuggling".

Tata Motors conducted a raid on 33 spare parts manufacturers and duplicate packaging suppliers in Maharashtra.

IPR Chair: Microsoft India has established the Intellectual Property Rights (IPR) chair at Gujarat National Law University (GNLU) in an

effort to raise awareness about Intellectual Property Rights laws in India.

Elocution Competition: In May, 2014, FICCI CASCADE conducted elocution competition "Youth Against Counterfeiting And Smuggling" in New Delhi to spread awareness among the young minds and seek their support to underpin the fight against counterfeiting and smuggling.

World Anti-Counterfeiting Day: Celebrated on 5 June 2014 by FICCI CASCADE where senior officials from Directorate of Revenue Intelligence, Police and Customs were present. Mr. Sandeep Kumar from Economic Offences Wing of Delhi Police was awarded Best Investigation Officer, Delhi Police. Mr. Kumar had, in the last six months, seized articles of estimated value of INR 770000 (Approx. US$ 13000). Mr. M. Arun Kanth, Deputy Director, Directorate of Revenue Intelligence (DRI), Chennai Zonal Unit was awarded the Best Performing Officer from DRI for his distinguished work in enforcement of anti-counterfeiting and anti-smuggling laws.

Customised anti-counterfeiting solutions: Merck India's performance materials division has come up with two solutions to help manufacturers with brand protection concepts and security solutions.

1. Securalic security concepts help in making counterfeiting of consumer and industrial goods next to impossible with conventional tools and methods. They can be easily integrated into an existing product design and cost efficiently incorporated into an established fabrication procedure for printing and plastic manufacturing.
2. Candurin is a pearl effect pigment especially for the pharmaceutical industry in India. Following a sophisticated manufacturing process, these colorants are coated on thin, natural and semi-transparent silicate platelets. This new physical structure gives rise to the unique optical properties that are innovative and eye-catching.

Website: Companies are increasingly publishing caution notices on their websites re-counterfeiting of their products and providing a comparative analysis to help consumers identify counterfeits. One such notice was published by a company which manufactures Blood Glucose Test Strips. Moreover, the company has a dedicated page on its website to update its consumers on counterfeiting of its products.

3.5. Social Enterprise and Non-government Organisations

A social enterprise in India has come up with text messaging services to help patients check that their medicines are safe and not products of the counterfeit drugs industry which kills many thousands of people annually. India's PharmaSecure has partnered with drug manufacturers such as GlaxoSmithKline and Lupin, to print unique codes on the packaging and strips of medicines which can be verified by customers through sending a text message.

4. Some Significant Court and Office Decisions

4.1. *Asian Paints (India) Ltd. v. Satish Kumar & Ors.* [2013 (56) PTC 206 (Del)]

Plaintiff, a company engaged in manufacturing and marketing of paints, varnishes, enamels and other like products for more than 50 years, claimed to have obtained registration of various trademarks and copyright in the artistic work used in relation to its packaging. Defendants were using identical trademarks APCOLITE, APEX and TRACTOR in respect of synthetic enamel, paints and distemper as well as other allied and cognate goods and also GREAT ASIAN, ASIAN GLOW and SUPER ASIAN along with identical/look-alike packaging as that of the Plaintiff. Interim injunction was granted in favour of the Plaintiff, restraining Defendants from using packaging material similar to that of the Plaintiff

and from using Plaintiff's trade marks on their goods and products. The Court decreed the suit in favour of Plaintiff and awarding damages of INR 500000 (Approx. US$ 8500).

4.2. *Hasmukhbhai C. Panchal v. State of Gujarat* [Cr.MA/8723/2013]

A First Information Report (FIR) registered against an automobile spare parts dealer for infringement of copyright was quashed by the Gujarat High Court. The FIR was registered against Hasmukhbhai C. Panchal on the basis of a complaint made by an informant claiming to be an investigating officer of IPR Vigilance Indian Company.

Panchal moved the Court for quashing and setting aside the FIR and contended that the provisions of the Copyright Act are not attracted to automobile parts and the First Informant was not authorised to make the complaint. The State submitted that the impugned FIR was for the alleged offences punishable under sections 63 and 65 of the Copyright Act, 1957. None appeared for the First Informant despite being served. The Court observed that the FIR did not mention anything about the author or owner of the work in question or in what capacity the First Informant had lodged the FIR.

Further, neither did the FIR disclose if the spare parts are artistic work or any other work to which the Copyright Act applies, nor did it mention if the First Informant had acquired any rights under the Copyright Act. Counsel for the State also failed to show how the allegations levelled in the FIR relate to any of the provisions of the Copyright Act. Hence, the Court held that on a bare perusal of the FIR no case was made out under the provisions of the Copyright Act and quashed the FIR and consequential proceedings.

4.3. *Anil Sanghvi v. State of Gujarat* (PIL) [Decided in May 2014 by High Court of Gujarat]

Anil Sanghvi, an automobile spare-parts dealer has filed a Public Interest Litigation before the Gujarat High Court seeking directions to police authorities to not arrest vendors for infringement of copyright and trade mark laws without following proper norms. Reportedly, the grievance of the petitioner is that dealers who sell local-made adaptable spare parts are arrested on the basis of FIRs without first obtaining opinion from the Registrar as stipulated under the Trade Marks Act, 1999 or conducting an inquiry about infringement of copyright. The Court issued notices and allowed the request of the petitioner to add authorities under the Trade Marks Act, 1999 as additional respondents in the matter. The matter is pending adjudication and its outcome is awaited.

4.4. *Jockey Intl. Inc. & Anr. v. R Chandra Mohan & Ors.* [2014 (59) PTC 437 (Del) : MIPR 2014 (2) 177]

The lawsuit was filed by Jockey International Inc. for infringement of trade mark, passing off, dilution, tarnishment, unfair competition, damages and rendition of accounts in respect of its trade mark JOCKEY. Defendants were using the marks JOCKEY and JOOKEY. Defendant No. 6 did not appear. The Delhi High Court reiterated that a defendant, who chooses to stay away from the proceedings of the Court, should not be permitted to enjoy the benefits of evasion of court proceedings. And that a party who chooses not to participate in court proceedings and stays away must, thus, suffer the consequences of damages. The suit was decreed in favour of the Plaintiff and against the Defendant No. 6. Damages to the tune of INR 300000 (Approx. US$ 5000) were awarded to the Plaintiff.

4.5. *Pepsico Inc & Anr. v. PSI Ganesh Marketing & Anr.* [2014 (59) PTC 275 (Del) : MIPR 2014 (2) 240]

The Plaintiffs filed a suit in an attempt to restrain violation and infringement of rights in the trade mark, trade name, label AQUAFINA and infringement of copyright and sought permanent injunction, rendition of accounts, dilution and delivery up. The Defendants were using the mark AQUA FIES with similar get-up and layout. The matter was proceeded *ex parte*. The Court found that the Defendants are misrepresenting to the purchasing public that they are selling their goods in association with/in connection with the Plaintiffs and thus causing confusion as to the source of the goods and passing off and in a mala fide, dishonest and an unethical manner are encashing upon the goodwill and reputation of the Plaintiffs, established by the latter over the period of many years. The Court awarded punitive damages to the tune of INR 500000 (Approx. US$ 8500).

5. Contributed by

Amarjit Singh and Vikram Grover.

APAA 2014 ANTI-COUNTERFEITING COMMITTEE REPORT – INDONESIA

1. Indonesia Anti-Counterfeiting Statistics 2012–2013

No. of Intellectual Property Cases *(Data from Indonesian National Police Headquarters)*	266 (98 of 2014)
No. of Intellectual Property Cases *(Data from Indonesian civil servant investigator)*	19 (9 of 2014)

2. Changes to Indonesian Legislation

No legislative changes have taken place. However, the House of Representatives passed the copyright law on 16 September 2014. The new law will officially replace the existing Copyright Law (Law No. 19 of 2002) following completion of formalities within the government. Some of the relevant amendments have been discussed below:

2.1. Copyright

1. New Definitions have been introduced namely phonogram producer (Article 1. Paragraph 7), economic right of a phonogram producer (Article 24) and copyright piracy (Article 23).
2. Article 28 states that a phonogram producer must pay the performer in the amount of half from the income.
3. The period of copyright protection has been extended to 70 years from the death of an author.
4. Introduction of Collective Management Society.
5. Article 107 Paragraph (1) states that the request for a preliminary injunction shall be filed in writing with the Indonesian commercial court by the creator, copyright holder or the rights of the owner and has to fulfill several requirements.
6. New Criminal sanctions and/or fines have been introduced. Such criminal sanctions and/or fines have been death with by the Articles 113 (Paragraphs 3&4) and Article 114.

2.2. New Government Regulation No. 45 of 2014

A new Government Regulation No. 45 of 2014 stipulates the Types and Tariffs of Non-Taxed Revenues of The Ministry of Law and Human Rights of the Republic of Indonesia ("GR 45/2014") were signed by the Indonesian President on 30 May 2014. The GR 45/2014 has set out a number of changes to the amount of official fees payable to the Indonesian IP Office in respect of IP matters and prosecution. The areas in which such changes have been made are Trademark, Patent, Copyright and Geographical Indication.

2.3. Supreme Court Regulation No. 4 of 2012 regarding Temporary Suspension

Article 1 talks of temporary postponement of the release of goods from the customs area.

Such temporary suspension can take place only if sufficient evidence has been provided by the applicant in support of his claim that the impugned goods/articles have infringed some trademark or copyright. Article 2 deals with the requirements that are required to be fulfilled to establish that goods have been infringed. According to Articles 6 and 7, the request for temporary suspension can either be accepted or rejected. However, if the grant has been accepted, suspension can remain valid for ten days (Article 10)

2.4. The Supreme Court Regulation No. 5 of 2012 regarding Preliminary Injunction

This regulation provides more comprehensive guidelines for the IPR owner (i.e. industrial design, patent, trademark and copyright) in order to file a request to the Commercial Court to issue a preliminary injunction upon IPR infringement. Article 1 stipulates the purposes for which preliminary injunction can be sought whereas and Article 2 stipulates the documents that are required to be furnished along with the application of preliminary injunction. As per Article 2 the owner of IP has to make a Payment of guarantee money to the Court. The amount of the guarantee money would be equivalent to the value of the goods that are subject to the provisional decision. As per Article 5, decision, whether the Application is accepted or declined, must be issued by the Court within 48 hours. Article 7 deals with the types of decisions that court may issue. Article 10 stipulates that following the implementation of the Court preliminary injunction, the parties must be informed within 24 hours. Moreover, both parties have the right to provide their additional statement/testimony regarding the preliminary injunction. After receiving testimonies from both parties, the Court, within 30 days may amend, cancel or strengthen the preliminary injunction.

3. Practice Changes

NA.

4. Some Significant Court and Office Decisions

4.1. Soekarno Movie Case (Copyright)

Soekarno's daughter Rachmawati Soekarnoputri ("**the Plaintiff**") filed a lawsuit against PT. Tripar Multivision Plus, Ram Jethmal Punjabi and Hanung Bramantyo ("**the Defendants**") for the historical drama movie of Indonesia's first president Soekarno ("**Soekarno Movie**"). This case was the first preliminary injunction request filed at the Indonesian Commercial Court based on Supreme Court Regulation No. 5 of 2012 ("**PERMA No. 5**"). Plaintiff had demanded a cessation of the movie to be shown in public and Plaintiff's copyright recognition. The Commercial Court issued a preliminary injunction on 11 December 2013 in order to stop the showing of Soekarno Movie in cinemas all over Indonesia which was later on reversed for lack of evidence. But In the first instance court, the Judges grant the Plaintiff's claim partially, namely the Defendants should pay the material and immaterial damages, however, the Defendants did not violate the Plaintiff's copyright. Towards this decision, the Defendants filed a cassation to the Supreme Court and the Supreme Court had issued its decision in favor of the Defendants. At the present, The Plaintiff considers to file a petition for review to the Supreme Court.

4.2. ***IKEA v. IKEMA*** (Trademark)

IKEA System B.V. ("**the Plaintiff**") as the owner of IKEA trademark under Registration No. IDM000092006 ("**IKEA Trademark**") filed the cancellation claim against IKEMA trademark under Registration No. IDM000247129 ("**IKEMA Trademark**") in the name of PT.

Kadaung Industrial Ltd ("**the Defendant**") based on "similarity of principle" and "well-known" trademark at the Commercial Court. On 22 September 2011 the Commercial Court decided under decision No. 53/MEREK/2011/Pdt.Sus/2012 ("First Instance Court's Decision") to reject the claim filed by the Plaintiff by the Commercial Court. Further, the Plaintiff proceeded with further legal action filing the cassation to the Supreme Court under decision No. 159 K/Pdt/Sus/2012 on 13 June 2012 ("Second Instance Court' Decision"). The Supreme Court decided that the First Instance Court's Decision was cancelled, with the following decision:

1. IKEA Trademark as the "well-known" trademark;
2. IKEMA Trademark having the 'similarity of principle' with IKEA Trademark and IKEMA;
3. Trademark covered the same details of goods as IKEA Trademark; the Plaintiff is the legitimate owner of the well-known IKEA Trademark;
4. The Defendant had "bad faith";
5. IKEMA Trademark registration must be cancelled from the Trademark Official Gazette.

Based on the said Second Instance Court's Decision, the Defendant filed a judicial review to the Supreme Court, however, the Defendant's judicial review was rejected by the Supreme Court on 16 April 2014.

4.3. *VAIO v. VAIO* (Trademark)

Judges decided that the Defendant's intention behind filing the trade mark registration was based on bad faith since the trademark VAIO is a well-known mark. Further, the judges also cancelled the Defendant's trade mark registration and instructed the Directorate of Trademark to cross out the said registration from the General Register of Trademark. Towards this decision, the Defendant did not file a cassation, so the decision is final and binding.

4.4. Tray Design is being cancelled
(Industrial Design)

Tray design owned by local businessmen, Sindu Handoyo, was cancelled after the cancellation lawsuit of CV Sin Sil Rattan, Soemadyo, and Park Chae Young was granted by the Commercial Court of Central Jakarta. The panel of judges stated that the tray types of oval decor and foc decor has been produced since 2008, while the Defendant registered his industrial design in 2011. The judges partially granted the plaintiff's claim on Tuesday 23 September 2014 and instructed the Co-Defendant to cross out the Defendant's Industrial Design or declare it void. The Defendant considers filing a cassation to the Supreme Court.

5. Contributed by

Justisiari P. Kusuma and Endra A. Prabawa.

APAA 2014 ANTI-COUNTERFEITING COMMITTEE REPORT – JAPAN

1. Japan's Anti-Counterfeiting Statistics 2013–2014

No. of suspension cases	28,135
No. of investigated cases	524
No. of counterfeit goods seized	23,524

2. Changes to Japan's Legislations

A new law for protecting geographical indications has been enacted in June, 2014.

The new law makes facilitates registration for a combined trademark consisting of "geographical indication" and "name of products" as long as it meets several requirements under the current trademark law.

The law would be applied only to geographical indications of "foods", "beverages", "agricultural and marine products" as long as the GI can identify the "place of production" and "feature of products". The law would not be applied to medicine, cosmetics.

Once the GI application is registered, everybody in the corresponding geographical area can affix the GI to their products as long as their products meet the above "quality standard". The producer's group should however check the quality of products bearing the GI as to whether they fulfill the above "quality standard".

The Ministry of Agriculture, Forestry and Fisheries is entitled to check the management system of the producer's group regarding quality control. If any third party not authorised to do so affixes the GI, the Ministry of Agriculture, Forestry and Fisheries can order removal of the GI.

3. Practice Change

3.1. The process for registering a GI application includes the Producer's group in some geographical area to discuss and decide a "quality standard" regarding production method, etc. in connection with the products, proceeding which an application can be filed for a GI at the Ministry of Agriculture, Forestry and Fisheries.

3.2. The Ministry would examine the application for fulfillment of requirements stipulated in the law and thus would publish the GI application in a gazette for two months for possible opposition.

3.3. If the GI application is identical or similar to a registered trademark in terms of "mark" and "goods", it would be rejected.

3.4. Unless the ministry finds any refusal ground, they will register the application and notify the producer's group and publish the mark.

4. Some Significant Court and Office Decisions

NA.

5. Contributed by

Masashi Kurose, Hiromichi Aoki Takao Matsui, Akira Watanabe Mariko Nakayama and Tomoya Inoue Nami Togawa.

APAA 2014 ANTI-COUNTERFEITING COMMITTEE REPORT – KOREA

1. Korean Anti-Counterfeiting Statistics 2013–2014

No. of seizures of counterfeit goods	822,370
No. of counterfeit goods cases	2,709

2. Changes to Korean Legislations

Enforcement of reward to those who provide information on counterfeits as from 31 January 2014: Commissioner of KIPO can award rewards to those who provide information on a certain type of unfair competition action, more specifically production or distribution of goods pirating registered or well-known marks in Korea.

3. Practice Changes

3.1. Korean Intellectual Property Office (KIPO) met with the head of the intellectual property (IP) office of Vietnam on April 8, where they resolved to expand collaborative projects pertaining to IP rights.

3.2. KIPO announced that its subsidiary public agency, the Korea Intellectual Property Protection Association, signed a Memorandum of understanding (MOU) with Alibaba Group, China's largest internet based company, on April 23 in Hangzhou, China, to resolve the issue of counterfeit goods distribution in Chinese e-commerce.

4. Some Significant Court and Office Decisions

4.1. 2010 Ma 817 [Supreme Court] (Responsibility of online open market operators for trademark infringing goods)

The plaintiff notified the defendant a list of goods that appeared to infringe its trademarks and requested to ban the sales, delete accounts of sellers from its online market sites and active measures to prevent goods bearing plaintiff's mark from being sold and advertised without the plaintiff's approval. However the defendant in response claimed of not having any affirmative duty to prevent trademark infringement since it has a policy to ban sales of goods that are reported as trade-mark infringement by trade-mark holders. The court in this case held that even though the operator is liable to take appropriate steps to prevent sales of goods on open market for which evidence of trademark infringement has been provided, it does not make him liable for only providing e-commerce system without participating in actual sales. Thus, the Defendant was not liable for aid and abetment on the premise that the Defendant has affirmative duty to actively prevent trademark infringement actions.

5. Contributed by

Beom-Seok KANG, Sun CHANG and Tae-Jun SUH.

APAA 2014 ANTI-COUNTERFEITING COMMITTEE REPORT – MACAU

1. Macau's Anti-Counterfeiting Statistics 2013–2014

NA.

2. Changes to Macau's Legislations

Industrial Property Code (IPC) was enacted in June 2000, Macau Special Administrative Region (Macau SAR) was provided with the legal framework to promote protection of IP rights.

As part of the enforcement system of Macau SAR, the Macau Customs (MC) are the Government body that assures protection of intellectual property rights in Macau SAR (including trademarks), with a correspondingly broad range of powers.

3. Practice Change

NA.

4. Some Significant Court and Office Decisions

4.1. Counterfeited iPhones and Watches

MC's officers and Public Security Police officers jointly busted three separate cases involving the selling of counterfeited iPhones and watches. The three persons detained, were from mainland China. The iPhones and watches were all counterfeited ones, according to a Police spokesperson. The suspects also paid about 500 yuan for each watch but sold them for HK$ 1,000 while they paid 180 to 300 yuan for each counterfeit iPhone but were selling them for MOP 500 to MOP 1,000.

4.2. Counterfeited Ginseng

In October 2014 Macao Customs seized fake Korean ginseng worth at least MOP 3 million, arresting three Macau residents in the operation. Macao Customs believe that the counterfeiters had been selling the fake products since 2012 and it is estimated that they illegally earned about MOP100,000.00 each month.

4.3. Fake Goods seized in the amount of 50 Million Yuan

In the end of 2013 a joint operation of the Intellectual Property Department of the Macao Customs Services and the police in Guangdong Province led to the dismantling of a business selling lady bags of fake brands, involving two stores Zhuhai. According to Customs, four suspects were detained and products seized worth about 50 million yuan. During the operation, more than a thousand watches and more than 300 bags of brands were discovered products which were mainly sold in Macau and Zhuhai. The main suspect is 50 years old and operated in a shop located in the commercial centre of Gongbei.

4.4. Macau Customs Seize Several Fake Items [Public Attorney's Office]

Macau Customs searched an industrial building where they found forty pieces of well-known brand names of handbags, watches, jewellery and cosmetics of several, worth over MOP 100,000. The suspects were charged with infringement of section 292, IPC (which punishes the sale, circulation or concealment of counterfeited goods). The suspects were investigated and the Public Attorney's office took the case for subsequent prosecution. This crime is punishable with up to six months in prison or a branch office on the 30th to 90 day fines.

4.5. *Macau Customs seize 300 Fake Jerseys*

The Customs Service seized about 300 fake jerseys of various football teams participating in the Brazil World Cup. According to the Customs Service, the jerseys seized would be worth a total of MOOP 180,000, if they were sold at the price of original products.

The two detained individuals are suspected of having bought jerseys outside Macao, at prices between MOP 50 and MOP 120 each, and to have then sold at prices between MOP 200 and MOP 400. It is also suspected that the group tried to attract customers via social networks.

4.6. *Macau Customs seize 5,000 Fake Watches*

MC inspectors at the Macau airport detected a large number of goods in transit, for export purposes, which did not match the export forms submitted. Upon thorough investigation, a total of 34 boxes were apprehended, containing over 5,000 counterfeited watches of several known watch brands, namely Swiss and French ones. As part of the investigation, two local residents were detained, one being the person in charge at the logistics company and the other the driver of the truck company carrying the goods to the airport. Both individuals were believed to be members of a larger gang using the Macau airport as exit point for counterfeited goods, being shipped by air to other jurisdictions. The apprehended watches had an estimated value of MOP 20 million and were being shipped to Singapore.

5. Contributed by

Carlos D. Simões.

APAA 2014 ANTI-COUNTERFEITING COMMITTEE REPORT – MALAYSIA

1. Malaysian Anti-Counterfeiting Statistics 2013–2014

NA.

2. Changes to Malaysian Legislations

NA.

3. Practice Change

NA.

4. Some Significant Court and Office Decisions

4.1. *WB Fresh Coconut Supplier Sdn Bhd v. Gan Boon Wah & Anr*. [(2013) 6 CLJ 659]

The case regards the issue of passing off of plaintiff's registered mark "WB" by the defendant's mark "BW", both engaged in the business of Thai coconut beverages. the plaintiff filed this suit alleging the defendant to have passed off their goods as plaintiff's by using an identical mark as the plaintiff's registered mark, thus deceiving and causing confusion in the course of the trade in relation to the products of which the plaintiffs trade mark was registered. The court relied on imperfect recollection test and held that the marks apart from the noticeable difference, the defendant's mark was identical to plaintiff's when kept side by side owing to their basic features of representation and was capable of causing likelihood of confusion in the minds of the customers in the absence of the plaintiff's product.

4.2. *Chocosuisse Union Des Fabricants Suisses De Chocolat & Ors. v. Maestro Swiss Chocolate Sdn Bhd & Ors*. [(2013) 6 CLJ 53]

This case is an appeal from the decision of the High Court dismissing the appellants' claim against the respondents for the tort of extended passing off and their claim under section 5 of the Geographical Indications Act 2000 ("the GIA"). The respondents had used the name 'Maestro Swiss' in relation to chocolates and chocolate-related products with the brand name "Vochelle". The appellant contended that given the reputation and goodwill for fine quality chocolates made and exported from Switzerland, the use of the name "Maestro Swiss" would lead a significant number of the Malaysian public to believe that the products were manufactured in Switzerland or by a Swiss manufacturer. While dismissing the appellants' claim, the High Court held that the respondents' chocolate products had not led nor was it likely to lead Malaysian chocolate consumers to believe that such chocolate products were made in or imported from Switzerland. However, the Court of Appeal threw light upon the definition of the term "geographical indication" under section 2 of the GIA and the evidence before the High Court, and thus held that the High Court had erred in dismissing the appellants' claim under the GIA solely on the ground that

the impugned words were not a geographical indication, without relying upon the goodwill of Swiss chocolates, survey and the evidence before the court.

4.3. Raid disrupts counterfeit cosmetics trade (News Update)

An operation in the Malaysian capital Kuala Lumpur by the enforcement division of the Ministry of Domestic Trade, Co-operatives and Consumerism (MDTCC) has resulted in the seizure of around $134,000-worth of counterfeit cosmetic goods and shutdown of several shops in the busy city centre shopping mall. More than 40,000 units of counterfeit cosmetic products were seized from the operation.

5. Contributed by

Tai Foong Lam.

APAA 2014 ANTI-COUNTERFEITING COMMITTEE REPORT – NEW ZEALAND

1. New Zealand's Anti-Counterfeiting Statistics 2013–2014

No. of decisions issued by the Copyright Tribunal	18

2. Changes to New Zealand's Legislations

The New Zealand Government through the Ministry of Business, Innovation and Employment (MBIE) has published guidelines for when it will investigate and prosecute trademark and copyright offences on behalf of rights holders.

The amended anti-infringing file sharing law implements a graduated response regime to copyright infringement through peer-to-peer file sharing. If an account holder receives three notices of their alleged infringing behaviour within a 9 month period, the rights holder may choose to take a claim for up to $15,000 to the Copyright Tribunal.

The New Zealand Government continues to negotiate for free trade agreements that include comprehensive provisions on international standards for intellectual property policy setting and cooperation between enforcement agencies.

The Anti-Counterfeiting Trade Agreement (ACTA), signed by the New Zealand Government in October 2011, has yet to be ratified. At this stage, there is no indication from the Government when this might occur.

Review of the Copyright Act 1994 has been postponed.

3. Practice Change

NA.

4. Some Significant Court and Office Decisions

4.1. Prosecution under New Anti-Infringing File Sharing Law

In the first case before it, the Copyright Tribunal awarded the Recording Industry Association of New Zealand (RIANZ) NZ$ 616.57 for downloading two copies of the same Rhianna song and "Tonight, Tonight" by Hot Chelle Rae.

5. Contributed by

Corinne Cole.

APAA 2014 ANTI-COUNTERFEITING COMMITTEE REPORT – PHILIPPINES

1. Philippines's Anti-Counterfeiting Statistics 2013–2014

No. of cases disposed by IPOPHL	510
Value of counterfeit and pirated products	7.74 Billion (in 2014)

2. Changes to Philippines' Legislations

2.1. Republic Act No. 10175 or the Cybercrime Prevention Act of 2012: The Republic Act No. 10175 came into effect in February 2014. It aims to protect and safeguard the integrity of computer, computer and communications systems, networks, and databases, and the confidentiality, integrity, and availability of information and data stored therein, from all forms of misuse, abuse, and illegal access.

2.2. Implementing Rules and Regulations on Republic Act No. 10515 or the Anti-Cable Television and Cable Internet Tapping Act of 2013: The IRR penalises the unauthorized interception, reception or use of any signal or service over a cable television system or a cable internet system and/or network.

2.3. IPOPHL Office Order No. 13-169, Series of 2013 – Revised Rules and Regulations on Resolution of Public Performances Disputes: The Office Order provides for a procedure in disputes relating to the terms of a license involving the author's right to public performance or other communication of his work.

2.4. IPOPHL Office Order No. 13-171, Series of 2013 – Rules on Copyright Registration and Deposit: The Office Order provides for the rules and regulations on the registration and deposit of copyrighted works with the Intellectual Property Office.

2.5. IPOPHL Office Order No. 13-173, Series of 2013 – Rules and Regulations on the Accreditation of Collective Management Organizations: The Office Order provides for rules and regulations on the accreditation of Collective Management Organizations (CMOs) whose primary purpose is to collectively manage copyright and/or related rights.

2.6. IPOPHL Office Order No. 13-170, Series of 2013 – Rules of Procedure on Intellectual Property Rights (IPR) Enforcement: Under these rules, IPOPHL may receive complaints, reports and information relating to IPR violations and, upon evaluation, may take appropriate action, including the issuance of notice/warning, visitorial order, compliance order or recommend the filing an application for search warrant. It may also file administrative complaints before the local government unit concerned, and/or

other government agencies or tribunals, or refer the case to a law enforcement agency for case build-up or filing of charges.

Pending Legislations

2.7. Senate Bill No. 683 (Amending Certain Sections of Republic Act No. 9502 Otherwise Known as the "UNIVERSALLY ACCESSIBLE CHEAPER AND QUALITY MEDICINES ACT OF 2008" and Other Purposes): If enacted into law, the IPOPHL, through the Director General, may grant a compulsory license to import patented drugs pursuant to the Doha Declaration. The law would further prohibit any retail drug outlet from refusing to carry drugs or medicines brought into the Philippines through parallel importation.

2.8. Senate Bill No. 1980 (Defining the Crime of Economic Espionage and Providing Penalties Therefor): This legislative initiative seeks to provide adequate protection to proprietary economic information which is not available to the public and is not a matter of public concern. If enacted into law, misappropriation of proprietary economic information may be punished with imprisonment of up to 25 years.

2.9. Senate Bill No. 1695 (Defining the Crime of Economic Espionage and Providing Penalties Therefor): Under this legislation the owner would be liable to take reasonable measures to keep proprietary economic information confidential. If enacted into law, misappropriation of proprietary economic information may be punished with a fine and forfeiture.

2.10. House Bill No. 1357 (Declaring Unlawful the Reproduction of Copyrighted Books and Printed Materials through Photocopying, Duplicating, Printing Machines or Similar Means Without the Written Consent of the Copyright Owner, Whether the Publisher or the Author or Both): This legislative initiative seeks to impose additional penalties for unauthorized reproduction of copyrighted materials, apart from those found in the IP Code and penal laws, and to hold schools that allow the operation of photocopying within ten meters from their establishment jointly and severally liable as principals.

2.11. House Bill No. 2324 (An Act Amending Section 217.1 of Republic Act No. 8293, Intellectual Property Code of the Philippines): This legislative initiative seeks to increase the penalties for copyright infringement under the IP Code.

3. Practice Change

NA.

4. Some Significant Court and Office Decisions

4.1. *Birkenstock Orthopaedie GmbH and Co., KG (formerly Birkenstock Orthopaedie GmbH) v. Philippine Shoe Expo Marketing Corporation* [G.R. No. 194307]

Birkenstock Orthopaedie attempted to register its BIRKENSTOCK marks in the Philippines, but it was hindered by Shoe Town's prior registration for BIRKENSTOCK AND DEVICE. When applied for cancellation, it was rendered moot as Shoe Town did not file a Declaration of Actual Use and its registration was cancelled. Therefore, the mark was available for registration. The issue arose whether the mark was capable of being registered. The Supreme Court ruled that Birkenstock Orthopaedie could register its BIRKENSTOCK marks. The Supreme Court relied on the old trademark law and the fact that the Shoe town had no rights in the first place.

4.2. *Jose Jesus Disini Jr. v. Secretary of Justice* [G.R. Nos. 203335, 203299, 203306, 203359, 203378, 203391, 203407, 203440, 203453, 203454, 203469, 203501, 203509, 203515, and 203518]

The Supreme Court upheld the constitutionality of the Cybercrime law's provision on cyber-squatting. Also what was declared constitutional was the provision that imposed a higher penalty if crimes defined under existing laws are committed using the Internet.

4.3. *Willaware Products Corporation v. Jesichris Manufacturing Corporation* [G.R. No. 195549]

In 2000, Willaware began manufacturing plastic-made automotive parts using designs, materials, and colors similar to Jesichris's products. The issue pertained to unfair competition. The Supreme Court ruled that Willaware was guilty of unfair competition under the Civil Code and Willaware's action were done found to be in bad faith and contrary to good conscience.

4.4. *Enrico Perez v. Araneta Center Inc.* [IPO Appeal No. 10-2011-0002, Office of Director General]

Araneta Center filed a complaint for False Designation of Origin against Enrico Perez for using the domain name "aranetacenter.com." The Director General disagreed with Mr. Perez. First, Mr. Perez's own pleadings admitted that the website was meant to promote the business in the area. Second, the fact that he did not earn any income from it does not mean that he did not use the domain name in commerce. Not earning income is not a defense against liability for false designation of origin under the IP Code.

4.5. *Fun Ranch Mega Development Inc. v. Director of the Bureau of Trademarks* [IPO Appeal No. 04-2012-0002 to 05, Office of Director General]

Fun Ranch tried to register its building's facade as a trademark, but the Bureau of Trademark rejected it. On appeal, the Director General affirmed the Bureau of Trademarks. He ruled that there was no proof that the relevant consumers had associated Fun Ranch's facade to its enterprise to function as an indicator of Fun Ranch's business enterprise.

4.6. *Elarfoods Inc. v. Emzee Foods Inc.* [IPO Appeal No. 10-2010-0001, Office of Director General]

The spouses Lontoc sold roasted pigs and formed a company called Elarfoods. Later, it filed trademark applications for ELARS LECHON, PIG DEVICE, and ON A BAMBOO TRAY. The issue was raised pertaining to unfair competition and intellectual property. On appeal, the Director General ruled that while it was true that the spouses Lontoc did not assign the trademarks in writing, there was no need to do so because it was the spouses themselves who incorporated and registered Elarfoods. As a result of the incorporation, all rights and interests of the spouses, including the subject trademarks, were transferred to Elarfoods. Significantly, before their deaths, the spouses actively managed Elarfoods and represented to the public that the latter was the owner of the business along with the marks.

4.7. *Starwood Hotels and Resorts Worldwide v. W Land Holdings Inc.* [IPO Appeal No. 14-2012-0025, Office of Director General]

W Land's W mark (for real estate affairs) could not be registered because Starwood had an existing W registration (for hotel). It claimed that Starwood was not using the mark in the Philippines. The Director General agreed that an interactive website could show actual use in the Philippines. Accepting room reservations wherever in the world is an important and indispensable element of a hotel business. There was no need for Starwood to actually have a hotel in the Philippines.

5. Contributed by

Recognized National Group of Philippines.

APAA 2014 ANTI-COUNTERFEITING COMMITTEE REPORT – SINGAPORE

1. Singapore's Anti-Counterfeiting Statistics 2013–2014

No. of seizures of counterfeit goods	NA.
Quantity of infringing products involved	NA.

2. Changes to Singapore's Legislations

NA.

3. Practice Changes

The Singapore customs has been working closely with the Intellectual Property Rights Branch of the Singapore Police Force, a dedicated team for IPR cases, ("IPRB") in tackling counterfeit goods being "imported" into Singapore.

4. Some Significant Court and Office Decisions

4.1. *Public Prosecutor v. Goik Soon Guan* [(2013) SGDC 301]

The accused dealt with textiles, bed sheets, mattresses, blankets, pillows, bolsters and other related products operating business from two shop units, one of the units to sell the counterfeit goods. The accused obtained his supplies from an agent in Guangzhou, China who shipped the goods to the accused in Singapore. The IPRB conducted raids at the accuser's shop, his company vehicle as well at his accomplice's residence and seized various goods suspected to infringe various trademarks and copyright works. The representatives of the various copyright and trade-mark owners had confirmed that the goods seized were counterfeit goods. The accused faced 16 charges for the infringement of intellectual property rights under the Trade Marks Act and the Copyrights Act. The court while taking into consideration that the accused had made compensation of $ 100,000 to various copyright/trade mark owners sentenced to a total of 15 months imprisonment.

4.2. *Public Prosecutor v. St. Hua Private School Pte Ltd., Song Chunwei* [(2014) SGDC 342]

4.3. The case concerns with abuse of cracked license. A "cracked license" was a file which tampered with the lock and enable unauthorized access to the programs in the NX Software, and could be used an indefinite number of times. The accused entities, St. Hua and its sole director, Ms. Song faced trial charges, brought against them by way of private summons by Siemens for offering training services for Siemens' products even after termination of the license. The raid conducted at St. Hua's premises which resulted in the seizure of 11 desktop computers, 9 laptops and 3 files containing documents. During a joint inspection after the raid, 9 out of the 11 desktops were found to contain NX Software with "cracked license". Both the accused persons were found guilty of their respective charges and convicted accordingly. St. Hua was fined $ 18,000.

Ms. Song was fined $ 20,000, and sentenced to 2 months imprisonment in default.

4.4. *Public Prosecutor v. Koh Peng Kiat & another Appeal* [(2014) SGHC 174]

The accused ("Koh") two faced charges under section 49(b) of the Trade Marks Act ("TMA") for abetting in the possession of 130 boxes of contact lenses where the registered trademark "Freshlook Colorblends" had been falsely applied. In addition, the accused also faced another 12 charges under section 16(2)(b) of the Health Products Act (Cap 122D, 2008 Rev Ed) for arranging for the supply of 130 pairs of counterfeit contact lenses purporting to be Freshlook Colorblends of varying colours.

The High court concluded that all 14 charges do not stand and allowed Koh's appeal but dismissed the prosecutions appeal against sentence. The High Court held that the Koh may have known Ah Seng for only a short period and knew little of his background, but there was no reason for Koh to suspect that the contact lenses were counterfeit and thereby contact CIBA Vision. Further, in the absence of evidence of a market practice, that optometrists are expected to check all purchases of contact lenses with registered proprietors, it was not useful to set a base price to determine whether the contact lenses are counterfeit given that prices of contact lenses vary and large discounts are given for bulk purchases.

5. Contributed by

Sukumar Karuppiah and Wong Siew Hong.

APAA 2014 ANTI-COUNTERFEITING COMMITTEE REPORT – SRI LANKA

1. Sri Lanka's Anti-Counterfeiting Statistics 2013–2014

NA.

2. Changes to Sri Lanka's Legislations

NA.

3. Practice Change

3.1. Action is instituted by way of a private plaint and in some instances through the Commercial Crimes Division of the CID which has been specially set up to deal with these matters.

3.2. Action is instituted by way of a plaint in Commercial High Court.

4. Some Significant Court and Office Decisions

4.1. Counterfeits of Disney Characters

Disney Enterprises Inc. instigated an action against Paragon Paper Industries for using the world-renowned Disney characters on stationery products without a valid license and thus violating their Intellectual Property rights. The raids took place and approximately 34,000 Disney stationery and templates were taken into police custody and thereafter produced in courts. According to the investigations conducted, these stationery items manufactured in large scale were of poor quality, paper and toxic paint which were being distributed across Sri Lanka for unsuspecting children. Disney Enterprises Inc. complained that the actions of this party were violating its intellectual property rights causing severe loss and damage to its goodwill and reputation. It is clear that the actions of the accused are an attempt to piggy back on the goodwill and reputation built up by the brand over the years. This matter is currently pending in Court. The sale of counterfeit goods is an infringement under the Intellectual Property Act No. 36 of 2003. Under the said Act, if a person and/or persons are convicted, a fine of up to Rs. 500,000 and/or six months imprisonment may be imposed.

4.2. Infringement of Energy Drink "Red Bull"

An action was filed on behalf of Red Bull AG of Switzerland, owner of the world renowned energy drink brand of the same name, in the Commercial High Court of Colombo, against United Ceylon Venture Traders which had imported the Thai Red Bull drink – Krating Daeng – to Sri Lanka against the terms of the agreement between the Thai TCPI company and Red Bull, cannot be imported to or sold in Sri Lanka. It was alleged that the infringing product was not manufactured by Red Bull AG nor was it licensed by Red Bull AG or authorised any other party for the purpose of manufacture or sale. It was further claimed that Red Bull AG, as the registered owner of the Red Bull trademark, had not consented or authorised or

licensed United Ceylon Venture Traders or any other individual or organization for use of the said trademark. Thus, a consumer was likely to be confused by the presence of two similar products in the market exhibiting identical trademarks.

Upon satisfaction of documents and annexures filed, the Colombo High Court issued orders preventing the Defendant Company from freely circulating the allegedly infringing products "Red Bull" energy drink. The court also issued orders preventing the first defendant or any one acting under or through it or on its behalf from importing or distributing or marketing or offering for sale in any manner whatsoever, any products bearing the plaintiff's trade name "Red Bull" and/or the trademarks referred to and depicted in paragraph 12(c) of the plaint.

4.3. Counterfeit Microsoft Certificate of Authenticity (COA) Stickers

A seizure took place in Sri Lanka for selling unauthorised and/or counterfeit Microsoft COA stickers, without purchase of original Microsoft software. A complaint was filed on behalf Microsoft, U.S.A., to CID against the unauthorised seller, and a trap purchase in a public location was arranged twice with CID officers witnessing, resulting in seizure of over 40 numbers of counterfeit COAs in the possession of the distributor. Further during a third raid CID discovered over 400 numbers of such stickers. Three separate criminal actions were filed in the relevant Magistrate's Court and the Magistrate fined the accused. Two of the accused were imposed upon six months' imprisonment and suspension for two years, thus resulting in a very successful seizure action against violators of Microsoft copyrights in Sri Lanka, with three separate raids taking place.

5. Contributed by

Sudath Perera.

APAA 2014 ANTI-COUNTERFEITING COMMITTEE REPORT – TAIWAN

1. Taiwan's Anti-Counterfeiting Statistics 2013–2014

No. of IP cases filed	1876
No. of outbound Trademark infringement cases	2 (1 in 2014)
Quantity of outbound Trademark infringing products	54,960 (1500 in 2014)
No. of inbound Trademark infringement cases	89 (77 in 2014)
Quantity of inbound Trademark infringement	40,914 (35,124 in 2014)
No. of inbound Copyright infringement cases	8 (5 in 2014)
Quantity of inbound Trademark infringement	515 (678 in 2014)

2. Changes to Taiwan's Legislations

2.1. The Patent Act on border protection and promulgation of the "Regulation Governing Customs Detaining Goods Suspected of Patent Infringement" was amended.

2.2. The amended act provided for an applicant seeking detention of goods to specify facts of infringement and enclose documents to prove the patent right and an infringement analysis report.

2.3. The applicant shall provide for sufficient description and also provide security bond in the amount equivalent to the duty-paid price of the imported goods.

2.4. Further the applicant is required to commence a suit asserting that the detained goods infringe upon the applicant's patent within 12 days, failure of which would result in Customs' repealing of the detention.

2.5. The applicant is also required to provide asistance to the customs, prior to carrying out of the detention.

2.6. The owner of the detained goods may request Customs to repeal detention if the litigation initiated by the applicant is dismissed by a finalised court judgement, or the detained goods are found not to infringe upon the patent by a finalized court judgment, or by providing a security counter bond, amounting to two times of the duty-paid price of the imported goods, but Customs may release the imported goods by retaining a representative sample.

2.7. The Taiwan Intellectual Property Office ("TIPO") announced the proposed amendment to the Copyright Act in April, 2014, which includes an amendment to the border control provision.

3. Practice Change

NA.

4. Some Significant Court and Office Decisions

4.1. *Q Patnet v. OSIM* [Supreme Court Decision 103 Tai-Shan No. 1843, 5 September 2014]

Q Patnet sued OSIM, a famous health and lifestyle product retailer in Asia, for selling certain eye-care products (iCare200) which infringed upon Q Patnet's utility patent. In this case SC upholded the findings of the second instance of the IP Court and reasonably concluded that the products, if imported, would be deemed to have been sold, despite lack of direct evidence proving the actual sales quantity of the infringing products.

4.2. *Sanjet v. Goushin Machinery Tools et al.* [Second instance of IP Court 102 Min-Juan-Shang No. 16, 28 November 2013]

Sanjet sued Goushin and its affiliated company for manufacturing and selling cutting tools which infringed upon two patents owned by Sanjet. The IP Court rejected Goushin's "entire market value" argument and awarded to Sanjet the entire amount of the profit earned by Goushin out of the infringing products, reasoning that the Patent Act does not require calculation of damages to take into account the patent's contribution to the value of the infringing product.

4.3. *Moroccanoil v. Watsons et al.* [First instance of IP Court 102 Min-Shang-Su No. 19, 4 May 2014]

Plaintiff Moroccanoil Israel Limited is the owner of the trademark "Moroccanoil" registered mainly for hair products. Plaintiff sued Watsons, along with other companies for selling hair products which infringe upon its trademark. Plaintiff elected to calculate the damages by the lump sum of the market value of the infringing goods seized by Plaintiff, which would be equivalent to the sum of the unit price of the infringing products multiplied by the number of the products seized. However, plaintiff and Watsons had disputes over what the unit price and quantity should be used for damages calculation. The IP Court rejected Plaintiff's argument and held Watsons should only pay for the market value of the infringing goods which had been seized by Plaintiff on the ground that Plaintiff had already elected its calculation method and the quantity that Watsons had others manufactured for it was not that of the infringing products seized.

4.4. *People v. S. H. Chang et al.* [IP Court]

In a criminal case filed by several Japanese adult video firms with the prosecutor accusing defendants of committing copyright infringement by distributing complainants' DVDs without their consent, the IP Court held that a pornography work is entitled to copyright protection as long as it meets the originality requirement and imposed a sentence of six-month imprisonment on both defendants. The IP Court emphasised in the decision that as a member of the WTO, Taiwan should comply with TRIPs and other international conventions and should not exclude the protection for pornography.

5. Contributed by

Jeanne Wang.

APAA 2014 ANTI-COUNTERFEITING COMMITTEE REPORT – THAILAND

1. Thailand's Anti-Counterfeiting Statistics 2013–2014

Quantity of infringing products involved	NA
No. of seized counterfeit goods by Royal Thai Police and DIP	1,797,341 (210,727 in 2014)
No. of seized counterfeit goods by DSI	582,059 (675 in 2014)
No. of seized counterfeit goods by Customs	608,027 (32,055 in 2014)
No. of Trademark infringement civil cases	15 (2 in 2014)
No. of Copyright infringement civil cases	47 (18 in 2014)
No. of Patent infringement civil cases	3 (5 in 2014)
No. of Trademark infringement criminal cases	4,137 (840 in 2014)
No. of Copyright infringement criminal cases	1,001 (272 in 2014)
No. of Patent infringement criminal cases	11

2. Changes to Thailand's Legislations

2.1. The Trademark Act has been amended, allowing registration of unconventional marks, such as scent and sound marks, reducing registration period and adjust the government fees.

2.2. The Copyright Act was amended providing additional measures to copyright owners in combating online piracy, such as protecting information rights management, technological measures, and ISPs' liability, has been submitted to the Nation Legislative Assembly (NLA) for consideration.

2.3. The Copyright Act amendment also exempted the infringement offence of reproduction and adaptation of copyright work for beneficial (non-commercial purpose) of disabled persons that would be presented to the NLA shortly. It also aims to criminalize unauthorised camcording in cinemas which would also be presented to the NLA soon.

2.4. The amendment to the Trade Secrets Act concerning the qualifications of the member of the Trade Secrets Boards and the increase of penalties for disclosure or use of trade secrets by officials, that has been approved by the NCPO, and would shortly be submitted to the NLA.

3. Practice Change

The DIP and related organizations have been promoting anti-counterfeiting awareness through the following activities:

3.1. "STOP PIRACY – Buy Original Now" campaign held by the DIP to publicise the disadvantages of intellectual property infringement in economic terms in order to decrease infringements.

3.2. The National Intellectual Property Rights Center of Enforcement (NICE) held a subcommittee forum to which six related organisations were invited to coordinate the principles of Intellectual Property law in ASEAN to be harmonised.

3.3. In March 2014, the DIP made a public announcement about preparations and defensive measures for Thailand to be removed from the United States' Priority Watch List (PWL) by suppressing counterfeit goods sold via the internet and social media sites, such as Facebook and Instagram.

3.4. The DIP organised a destruction ceremony of pirated and counterfeit goods in Phuket on 4 July 2014. The main objective of the event was to promote public awareness on IPR protection in the southern region. Approximately 80,000 of seized items worth almost 500 million baht were destroyed.

4. Some Significant Court and Office Decisions

NA.

5. Contributed by

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APAA 2014 ANTI-COUNTERFEITING COMMITTEE REPORT – VIETNAM

1. Vietnam's Anti-Counterfeiting Statistics 2013–2014

No. of seizures of counterfeit goods	NA
Quantity of infringing products involved	NA
No. of counterfeit goods committee actions	389
No. of Trademark infringement cases	2,325
No. of cases by Market Surveillance of Vietnam	63,978 (in 2014)
No. of cases by custom officers	8,915 (in 2014)
No. of cases by VIPRI	373

2. Changes to Vietnam's Legislations

2.1. Decree No. 08/2013/ND-CP of January 2013 of the Government provided for administrative penalties for producing and trading counterfeit goods.

2.2. Circular No. 05/2013/TT-BKHCN in February 2013 amended and supplemented some articles of Circular No. 01/2007/TT-BKHCN guiding Intellectual Property Law 2009 and Decree No. 103/2006/ND-CP (amended). The Circular included provisions on the time periods of formality and substantive examination of applications, on checking applications to ensure the first-filing principle for every subject matter of industrial property rights.

2.3. Circular No. 09/2013/TT-BCT in May 2013 of the Ministry of Industry and Trade providing for inspection and administrative violation sanction activities of market management offices.

2.4. Decree No. 81/2013/ND-CP in July 2013 of the Government on elaborating some articles and enforcement of the law on handling administrative violations.

2.5. Circular No. 18/2013/TT-BKHCN in August 2013 provided guidelines for the implementation of Government Decree No. 13/2012/ND-CP dated 02 March 2012 on the Regulations on Innovation.

2.6. A new Decree was passed on sanctioning of administrative violations in the field of industrial property.

2.7. Decree No. 185/2013/ND-CP in November 2013 of the Government sanctioned administrative violations in commercial activities, production and trade of counterfeit or prohibited goods, and protection of the consumers' rights. Under this Decree, a monetary fine of up to US$ 2,000 might be imposed on the infringer depending on the scope and seriousness of infringement acts. This Decree took effect on 1 January 2014.

3. Practice Change

3.1. National Office of Intellectual Property participated in 21 intellectual property negotiation rounds in five free trade agreements.

3.2. A National Steering Committee against smuggling, commercial fraud and counterfeiting goods is headed by Standing Deputy Prime Minister with the participation of four deputy heads including the Minister of Finance, the Minister of Industries & Trade, the Minister of Defence and the Minister of Public Security.

4. Some Significant Court and Office Decisions

NA.

5. Contributed by

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