

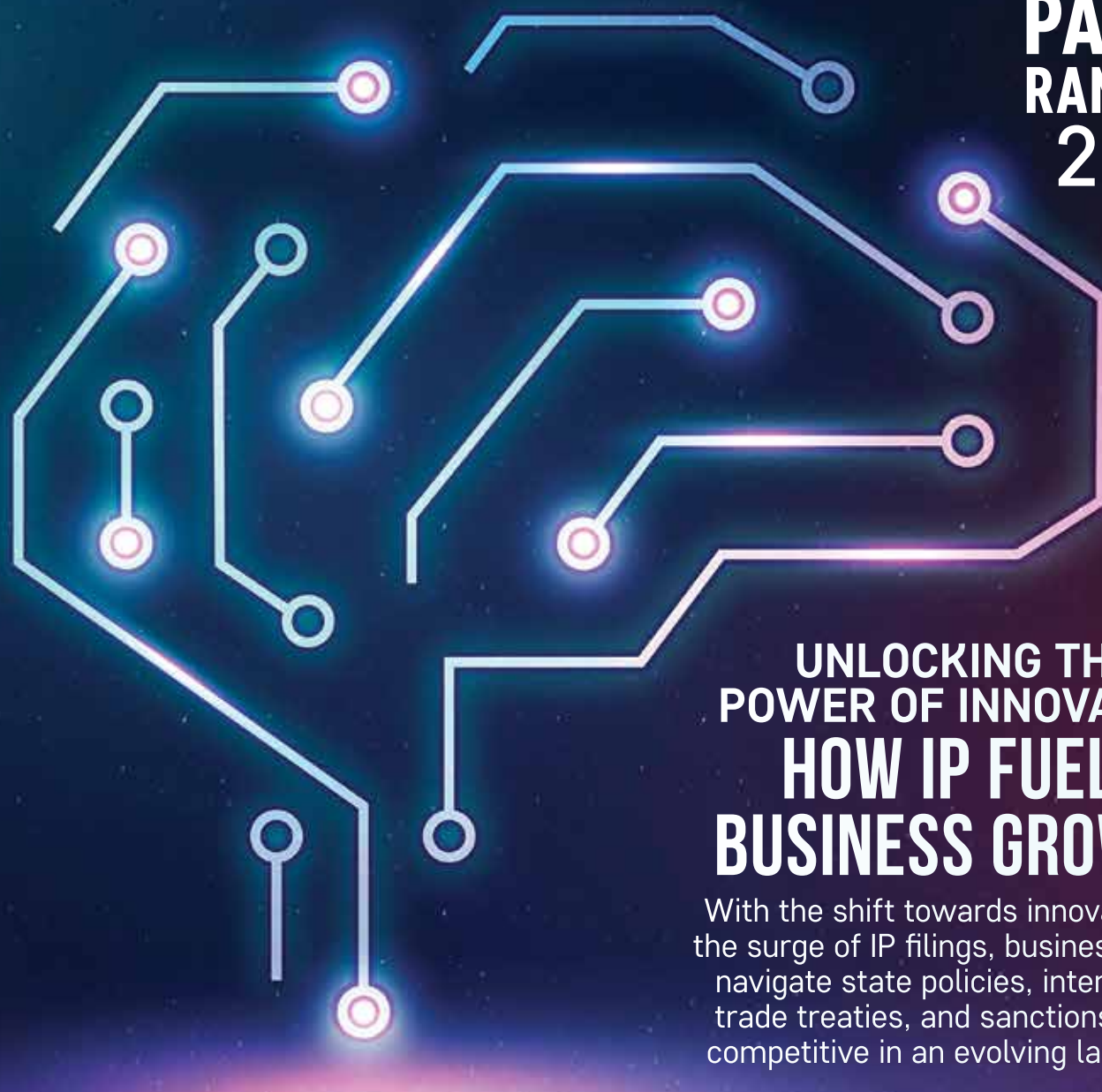
AsiaIP

INFORMED ANALYSIS

SEPTEMBER 2023 • VOL 15 ISSUE 8



PATENT RANKINGS 2023



UNLOCKING THE POWER OF INNOVATION HOW IP FUELS BUSINESS GROWTH

With the shift towards innovation and the surge of IP filings, businesses must navigate state policies, international trade treaties, and sanctions to stay competitive in an evolving landscape.

CONSUMER INTEREST:
In trademark litigation,
are consumers the
missing party?

**THE NEUROTECHNOLOGY
AND DATA PRIVACY
INTERFACE**

**MANAGING THE TAX
IMPLICATIONS OF
TRANSACTIONS WITH
IP RIGHTS**

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—**Excel V. Dyquiango**





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THE PATENT SURGE

The World Intellectual Property Organization has recently reported that global patent filings are heading in a different direction than filings for trademarks and designs.

Patent filings, on the strength of applications from Indian and Chinese innovators, is heading up – way up. Innovators from around the world submitted 3.46 million patent applications in 2022, marking a third consecutive year of growth, according to WIPO's annual World Intellectual Property Indicators (WIPI) report.

China, the United States, Japan, South Korea and Germany were the countries with the highest numbers of patent filings in 2022, WIPO reported. While innovators from China continue to file nearly half of all global patent applications, the country's growth rate dipped for a second consecutive year from 6.8% in 2021 to 3.1% in 2022. Meantime, patent applications by residents of India grew by 31.6% in 2022, extending an 11-year run of growth unmatched by any other country among the top 10 filers.

The short-term future for patents is unclear, though. WIPO director general Daren Tang, upon releasing the report, said: "IP filings have braved the pandemic to continue to grow, powered by increased levels of innovation, creativity, entrepreneurship and digitalization in all parts of the world. Developing countries are increasingly engines of IP, showing the greatest growth rates as they harness the innovation and creative potential of their people. However, uncertainty continues to weigh on the global innovation ecosystem, with venture capital funding dropping in many parts of the world. We urge investors to pursue quality, but not at the expense of supporting good ideas that can change the world for the better."

Excel V. Dyquiango has reported on exactly this for us in this issue. "India boasts a substantial pool of skilled professionals and a burgeoning startup ecosystem, which have contributed to the rising tide of patent applications and technology-related IP. The startup ecosystem has thrived with support from initiatives like Startup India, offering financial assistance and expert guidance to emerging enterprises," he writes. "This has enabled startups to explore innovative ideas and seek protection for their IP, driving growth in the sector."

This issue of *Asia IP* also includes our annual list of patent rankings for the Asia-Pacific region. We hope you enjoy our coverage.

Darren Barton

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UNLOCKING THE POWER OF INNOVATION HOW IP FUELS BUSINESS GROWTH

In recent years, Asia-Pacific countries emphasized innovation and R&D efforts, resulting in a surge in patent filings and technology-related IP. *Excel V. Dyquiango* explores these efforts and the challenges business must navigate to stay competitive in an evolving landscape.



In recent years, there has been a remarkable and undeniable shift towards a strong focus on innovation in many countries across the Asia-Pacific region. Nations like China, Japan and South Korea have embarked on ambitious journeys of investment in research and development (R&D), channeling significant resources into fostering technological advancements. The tangible result of these efforts can be witnessed in the surge of patent filings and the rapid growth of technology-related intellectual property.

India, for instance, has witnessed a significant surge in patent filings and technology-related IP in recent years, driven by a combination of factors. The government has played a crucial role in fostering innovation through initiatives like the National Intellectual Property Rights Policy, which has created a favourable environment for innovation and IP creation. This policy not only emphasizes the protection of IP but also promotes its commercialization, recognizing the economic value of intellectual property.

Additionally, India boasts a substantial pool of skilled professionals and a burgeoning startup ecosystem, which have contributed to the rising tide of patent applications and technology-related IP. The startup ecosystem has thrived with support from initiatives like Startup India, offering financial assistance and expert guidance to emerging enterprises. This has enabled startups to explore innovative ideas and seek protection for their IP, driving growth in the sector.

“India has produced a range of ground-breaking innovations in technology and IP that have garnered international acclaim and reshaped industries, both at home and on the global stage,” said Mudit Kaushik, a partner at Verum Legal in Delhi. “Covaxin, developed by Bharat Biotech, is a prominent example. This indigenous Covid-19 vaccine has been used

in over 100 countries, significantly impacting the global pandemic response. It exemplifies how Indian innovation is addressing global challenges and saving lives worldwide. Aadhaar, India’s unique identification number system, has not only streamlined access to government and private sector services but has also inspired similar identification systems globally. Its impact extends beyond India’s borders, as other countries explore the potential of such systems for efficient service delivery.”

He added that the Unified Payments Interface (UPI) is another standout innovation, revolutionizing digital payments in India and now boasting over a billion users. It simplified financial transactions within the country and gave potential to transform cross-border payments, enhancing global financial connectivity. This innovation illustrates how technology can bridge geographical boundaries and facilitate international financial interactions.

India’s contributions to AI research and development are also noteworthy as Indian companies such as Infosys and Wipro actively develop AI-powered applications across various industries, from finance to healthcare. These AI innovations are expected to significantly impact the global economy, with Indian companies at the forefront of this transformative journey.

“AI is not only improving business operations but also enhancing customer experiences, driving its adoption across industries,” said Kaushik. “Moreover, India’s leadership in deploying 5G technology, led by companies like Jio and Airtel, is transforming various sectors. This high-speed connectivity is enabling real-time data exchange, remote-controlled robotics and advanced healthcare services. The impact of 5G extends beyond India’s borders, as global industries look to leverage its capabilities for enhanced productivity and innovation.”

Taiwan: Government support, academia and tech companies boost surge in patent filings

Similarly in Taiwan, the government has actively supported innovation and R&D through various initiatives, such as tax incentives, grants and research subsidies. The Ministry of Science and Technology (MOST) and the Taiwan Intellectual Property Office (TIPO) have played significant roles in promoting IP protection.

Furthermore, Taiwan has several renowned research universities, such as National Taiwan University and National Tsing Hua University, which foster innovation and contribute to patent filings. The country is also home to leading technology companies such as Taiwan Semiconductor Manufacturing Company (TSMC), Foxconn and ASUS, engaged in the global technology supply chain for manufacturing and supplying components. These companies continually invest in R&D and file numerous patents to protect their innovations, contributing to the surge in patent filings.

Kai Chng, managing partner at Your Team Law in Taichung City, added that Taiwan has made significant strides in semiconductor technology, with TSMC leading the way in advanced chip manufacturing processes.

“Innovations in electric vehicles (EVs) and renewable energy technologies have gained recognition. Companies like Foxconn have ventured into EV production,” she said. “According to a recent study released by the World Intellectual Property Organization (WIPO), computer technology taking the lead in the WIPO’s Patent Cooperation Treaty (PCT) applications suggests Taiwan’s strong presence in global technology innovation. This could be attributed to the emphasis on software development and digital solutions.”

Meanwhile, the prominence of digital communication in PCT applications suggests Taiwan’s contribution to the development of communication technologies, likely including 5G and related innovations, said Chng.

“Taiwan’s biotech and healthcare sectors have also seen notable developments, especially in precision medicine and medical devices,” she added. “These innovations are reshaping industries globally, driving advancements in consumer electronics, clean energy and healthcare.”

Government policies in research and development

In China, active R&D resulted in the surge in patent filings and technology-related IP. Behind that were huge and climbing R&D investments and supporting policies from the government.

According to the PRC National Bureau of Statistics, overall R&D investment in 2022 in China exceeded Rmb3 trillion (US\$416 billion) – contributed by enterprises, research institutions and universities nationwide – which is 10 percent higher than in 2021.

According to Gordon Gao, a partner at King & Wood Mallesons in Beijing, the Chinese government

issued a series of beneficial policies to encourage innovation, such as preferential financial and tax policies, talent attraction policies and funding support policies. For example, he said, based on a 2023 policy announced jointly by the PRC Ministry of Finance and the State Taxation Administration, an extra 100 percent of the amount of R&D expenses incurred by an entity could be deducted before tax payment, in addition to the deduction of actual expenses as prescribed in previous policies.

“To encourage domestic semiconductor R&D and manufacturing given the U.S.-China trade tension, the Beijing government awards up to Rmb30 million (US\$4.17 million) for the first round of the tape-out process (a crucial but expensive step before mass production of a chip) of certain high-end chips,” he said. “China also founded a state-owned fund, such as that of the China Integrated Circuit Industry Investment Fund, known as the Big Fund, to invest in promising entities in the semiconductor industry.”

Among China’s recent innovations in technology and IP that have gained global recognition include several technical fields, such as 5G communication, high-speed railway, cloud computing, digital payment, quantum communication, unmanned aerial vehicles (UAV) and semiconductors.

As of 2023, China’s cloud computing market has exceeded Rmb1.5 trillion (US\$208 billion), becoming one of the largest cloud computing markets in the world.

“Besides, Chinese cloud computing product ranks first worldwide in the four core evaluations of computing, storage, network and security,” said Gao. “China has developed great advantages in the field of UAV research and manufacturing. China’s UAV sales account for more than 70 percent of the total sales worldwide, making China the main producer and exporter of the global UAV market.”

For 5G communication, there are currently more than 210,000 5G standard essential patents declared globally, involving nearly 47,000 patent families, of which China has declared more than 18,000 patent families, accounting for nearly 40 percent, ranking first in the world. Given China’s voice in setting standards in the field of 5G communications, China will have stronger negotiating power on patent licence fees worldwide in the mobile phone and new-energy vehicle communication industries.

As for the semiconductor industry, statistics show that as of September 30, 2022, 55 percent of 69,190 global patents for semiconductors filed in 2022 were Chinese in origin. Thus, China focused on boosting domestic semiconductor production to reduce dependence and try to be self-sufficient.

Collaboration among sectors

Collaboration between governments and industries to safeguard and bolster IP rights is essential, particularly with technology-related IP. According to Kaushik, several noteworthy initiatives and policies underscore this cooperation. The Indian government has taken

"Any advancement or failure in China's effort to be self-sufficient in semiconductors would greatly change the economic status quo. Given the sheer scale of China's import of semiconductors each year, even a small portion of that need being filled by domestic production would heavily affect the current foreign producers."

—GORDON GAO, partner, King & Wood Mallesons, Beijing

"Balancing IP protection with fostering open innovation can be a complex task. A noteworthy challenge arises from the relatively low awareness among many Taiwanese companies, especially OEM-based manufacturers, regarding the importance of patent protection for their innovations."

—KAI CHNG, managing partner, Your Team Law, Taichung City

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—MUDIT KAUSHIK, partner, Verum Legal, Delhi



“significant steps to fortify IP laws and enhance enforcement mechanisms.”

“Recent legal amendments have reinforced protection for patents, trademarks and copyrights. In addition, a concerted effort has been made to educate businesses and consumers about their IP rights, thereby fostering IP awareness and compliance,” he shared. “Cross-border collaboration on IP protection is actively promoted by the government. India’s active participation in the WIPO and its numerous bilateral and multilateral agreements highlight the country’s commitment to global cooperation in IP matters.”

There are also specific initiatives and policies to advance IP protection and promotion in India. For instance, the National Intellectual Property Rights Policy (NIPR), launched in 2016, is instrumental in fostering creativity and innovation within the country.

The NIPR encompasses various initiatives, including the establishment of a National IPR Facilitation Centre and the launch of a nationwide awareness campaign. These measures signify the integral role of IP in India’s innovation ecosystem.

Meanwhile, Taiwan has established a comprehensive legal framework for IP protection with stringent enforcement mechanisms. Among them is that the government provides diverse supports to promote the importance of IP.

According to Chng, the TIPO has been promoting the Positive Patent Examination Pilot Program for Startup Companies in 2023. This program is established to encourage newly founded companies and provide effective assistance on their patent applications, she explained. Additionally, the TIPO also offers new examination services for design patents, including



options for accelerated examination and simultaneous adjustment of the deferred examination period for design patents.

She continued: “The TIPO established a platform called Industrial Patent Knowledge Platform (IPKM), which is a one-stop service tool designed to assist businesses in their IP applications and research. It offers a range of features, including access to patent documents, government agency news, column articles, information about IP systems in different countries, IP videos and insights from local academic experts. IPKM also provides various intelligent services such as industry classification, technology term recommendations, automatic search expansion and text-based searches.”

Overall, Chng said IPKM serves as a “user-friendly platform for data viewing and knowledge management, helping businesses simplify their search for technical information and stay updated on global patent trends.”

The TIPO and other industries have also been collaborating in conducting IP awareness campaigns. Bilateral and multilateral agreements, such as trade agreements and collaborations with international organizations, help safeguard IP rights. For example, TIPO has launched the TW-Support Using the PPH Agreement (TW-SUPA) Examination Program since March 1, 2012, to enhance the efficacy of sharing examination results among patent offices and encourage applicants to take advantage of expedited examination under PPH programs.

However, it is important to note that in this evolving landscape, many challenges are in the offing. One significant challenge is the need for stronger protection against counterfeiting and patent trolls.

“Balancing IP protection with fostering open innovation can also be a complex task,” said Chng. “Furthermore, a noteworthy challenge arises from the relatively low awareness among many Taiwanese companies, especially OEM-based manufacturers, regarding the importance of patent protection for their innovations. Often, these companies delay filing patent applications until they have confirmed their products’ marketing strength or have been requested to do so by their clients. This approach can leave them vulnerable to patent trolls and unfaithful competitors who might take advantage of their innovations.”

But despite these challenges, there are opportunities for businesses and inventors in Taiwan’s evolving IP landscape. Chng said companies can proactively address these challenges by enhancing their awareness of IP protection strategies and adopting early patent filing practices.

“Leveraging Taiwan’s strengths in technology

and innovation, businesses can strategically position themselves in global supply chains and secure a competitive edge through effective IP management. Additionally, Taiwan’s commitment to supporting R&D and innovation provides a favourable environment for inventors and businesses to thrive. By staying adaptable to emerging technologies and market demands, businesses can harness the opportunities presented by Taiwan’s dynamic IP landscape and contribute to their long-term success,” she explained.

The rapid pace of technological advancements

Given the rapid pace of technological advancements, one of the key sectors that would most likely make an impact in the near future is in the semiconductor industry. According to Gao, China has been investing heavily in R&D and is now filing 55 percent of global semiconductor patents.

“Any advancement or failure in China’s effort to be self-sufficient in semiconductors would greatly change the economic status quo,” he said. “Given the sheer scale of China’s import of semiconductors each year (more than US\$300 billion), even a small portion of that need being filled by domestic production would heavily affect the current foreign producers.”

He said that during the past few years, there has been a major increase in government funding for R&D and protectionism. “State subsidies could greatly change the current competitive landscape of the region,” he said. “Businesses not getting state or other outside funding support could be at a disadvantage. China has just announced further tax credits for investments in semiconductor R&D, in addition to hundreds of billions of subsidies already in place. At the same time, other players like the U.S. are also providing major subsidies through vehicles such as the CHIPS Act.”

Therefore, businesses need to pay attention to state policies and international trade treaties or sanctions. It would be crucial to utilize various state policies in R&D, including direct subsidies, tax cuts and certain exemptions. However, these policies and subsidies are often mutually exclusive, such as the CHIPS Act greatly limits its subsidized entities’ ability to expand in China, according to Gao.

“Just as countries are giving more and more support to tech-heavy businesses, there are also more and more restrictions. Violation of laws like the CHIPS Act could lead to devastating sanctions. Much as the subsidies and tax credits can give businesses a leg up, relevant sanctions and penalties could cripple most if not every company,” he said. ^{AIP}



PATENT RANKINGS 2023

AUSTRALIA

	PATENT PROSECUTION
1	Davies Collison Cave
1	FB Rice
1	FPA Patent Attorneys
1	Griffith Hack
1	Spruson & Ferguson
2	Halfords IP
2	Madderns
2	Michael Buck IP
2	Phillips Ormonde Fitzpatrick
2	Wrays

	PATENT CONTENTIOUS
1	Allens
1	Ashurst
1	Davies Collison Cave
1	Herbert Smith Freehills
1	King & Wood Mallesons
2	Clayton Utz
2	Corrs Chambers Westgarth
2	DLA Piper
2	MinterEllison
2	Spruson & Ferguson

BANGLADESH

	PATENTS
1	Advocates IP Law Alliance
1	Bepary & Bepary
1	Doulah & Doulah
1	Dr. Kamal Hossain & Associates
1	Remfry & Son
2	Attorneys & Associates of IP Laws
2	FM Associates
2	H&H Company
2	Islam & Co.
2	K.A. Bari & Co.

BRUNEI

	PATENTS
1	Abrahams, Davidson & Co.
1	AIP Law
1	CCW Partnership
1	Dr. Colin Ong Legal Services
2	Cheok Advocates & Solicitors
2	HEP Law
2	Mirandah Asia
2	YC Lee & Lee
2	Yusof Halim & Partners

CAMBODIA

	PATENTS
1	Abacus IP
1	BNG Legal
1	Bun & Associates
1	Sok Siphana & Associates
1	Tilleke & Gibbins
2	Bou Nou Ouk
2	HBS Law
2	KCP Cambodia
2	P&A Asia
2	Pich & Partners



CHINA

	PATENT PROSECUTION
1	CCPIT Patent and Trademark Law Office
1	China Patent Agent (H.K.)
1	Liu, Shen & Associates
1	NTD Intellectual Property Attorneys
1	Unitalen Attorneys at Law
2	AFD China Intellectual Property Law Office
2	GoldenGate Lawyers
2	Jadong IP Law Firm
2	King & Wood Mallesons
2	Kangxin Partners

	PATENT CONTENTIOUS
1	AFD China Intellectual Property Law Office
1	CCPIT Patent and Trademark Law Office
1	King & Wood Mallesons
1	NTD Intellectual Property Attorneys
1	Unitalen Attorneys at Law
2	Fangda Partners
2	Liu, Shen & Associates
2	Lung Tin Intellectual Property Agent
2	Peksung IP
2	Wanhuida Intellectual Property

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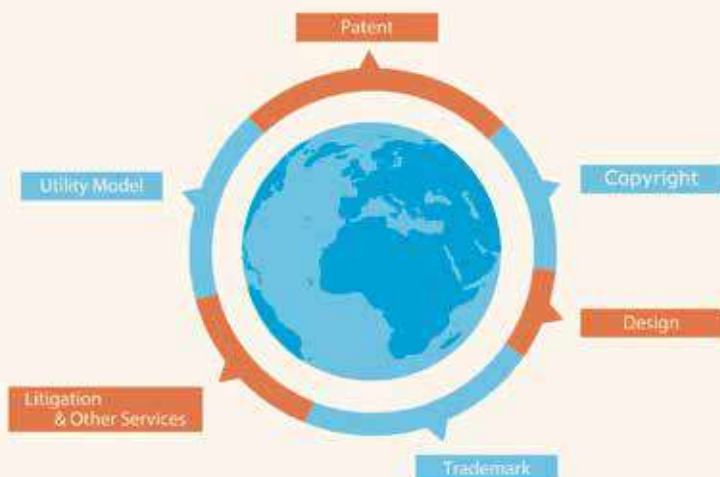
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1	Bird & Bird
1	Deacons
1	Marks & Clerk
1	Spruson & Ferguson
1	Wilkinson & Grist
2	Barron & Young
2	Eagle IP
2	P.C. Woo & Co.
2	Robin Bridge & John Liu
2	Vivien Chan & Co.

	PATENT CONTENTIOUS
1	Baker McKenzie
1	Bird & Bird
1	Deacons
1	Jones Day
1	Nixon Peabody CWL
2	Hogan Lovells
2	Mayer Brown
2	Norton Rose Fulbright
2	Robin Bridge & John Liu
2	Wilkinson & Grist

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60+ Trademark Attorneys
60+ Lawyers
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3 Liaison offices in Silicon Valley, Tokyo, Munich
Good partnership with law firms or IP agencies in 70+ countries and regions worldwide

Cases Handled by NTD

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Investigation and AIC actions: 200+ per year
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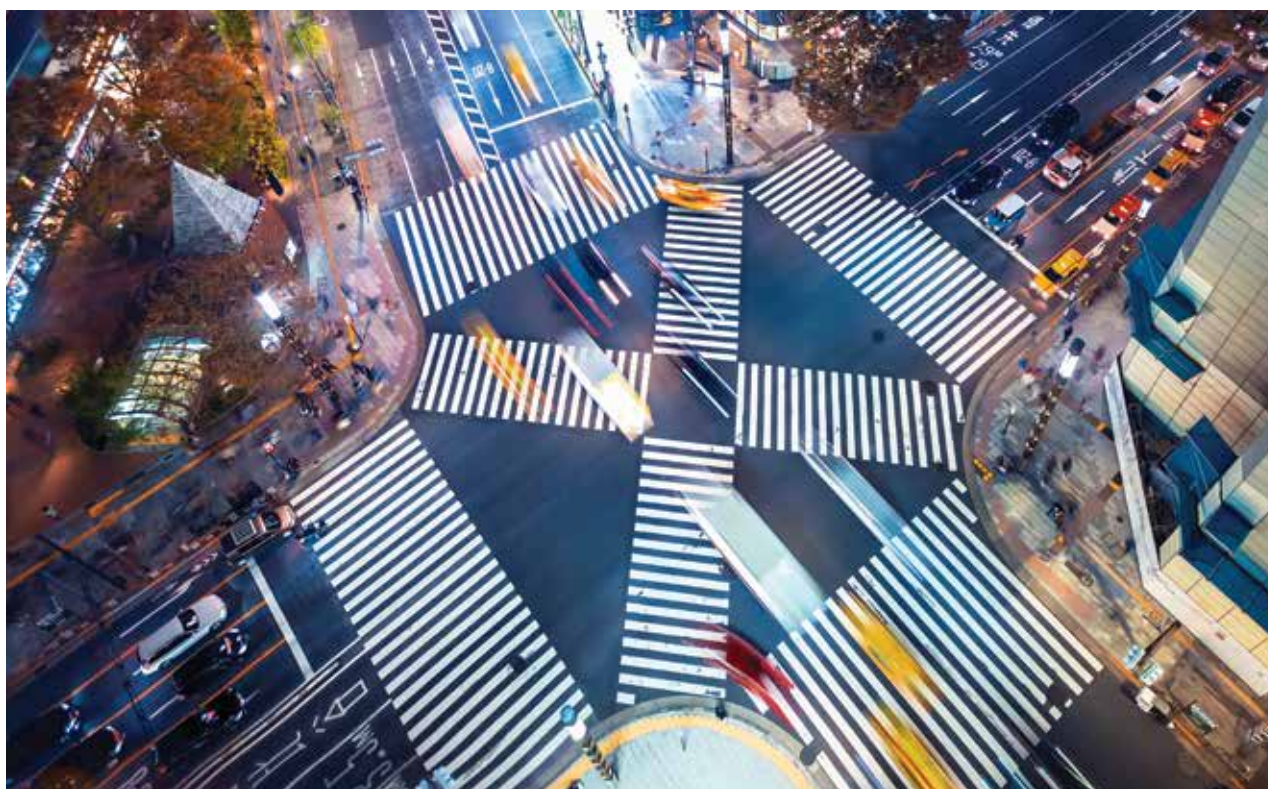


INDIA

PATENT PROSECUTION		PATENT CONTENTIOUS	
1	Anand and Anand	1	Anand and Anand
1	K&S Partners	1	K&S Partners
1	Lakshmikumaran & Sridharan	1	Lall & Sethi
1	LexOrbis	1	Remfry & Sagar
1	Remfry & Sagar	1	Singh & Singh
2	Krishna & Saurastri Associates	2	Krishna & Saurastri Associates
2	R.K. Dewan & Co.	2	Lakshmikumaran & Sridharan
2	Rahul Chaudhry & Partners	2	Rahul Chaudhry & Partners
2	Subramaniam & Associates	2	S. Majumdar & Co.
2	S. Majumdar & Co.	2	Saikrishna & Associates

INDONESIA

PATENT PROSECUTION		PATENT CONTENTIOUS	
1	AMR Partnership	1	HHP Law Firm
1	Biro Oktroi Roosseno	1	K&K Advocates
1	HHP Law Firm	1	Rouse, in association with Suryomurcito & Co.
1	Pacific Patent Multiglobal	1	SKC Law
1	Tilleke & Gibbins	1	Tilleke & Gibbins
2	Cita Citrawinda Noerhadi & Associates	2	AMR Partnership
2	FAIP Advocates & IP Counsels	2	Biro Oktroi Roosseno
2	Inter Patent Office	2	Cita Citrawinda Noerhadi & Associates
2	Januar Jahja & Partners	2	Januar Jahja & Partners
2	Rouse, in association with Suryomurcito & Co.	2	Maulana and Partners



JAPAN

	PATENT PROSECUTION
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1	Nakamura & Partners
1	Shiga International Patent Office
1	TMI Associates
1	Yuasa and Hara
2	Aoyama & Partners
2	Fukami Patent Office
2	Ryuka IP Law Firm
2	Seiwa Patent & Law
2	Sugimura & Partners

	PATENT CONTENTIOUS
1	Anderson Mori & Tomotsune
1	Kubota
1	Nakamura & Partners
1	TMI Associates
1	Yuasa and Hara
2	Abe, Ikubo & Katayama
2	Mori Hamada & Matsumoto
2	Nagashima Ohno & Tsunematsu
2	Nishimura & Asahi
2	Ohno & Partners

LAOS

	PATENTS
1	Kenfox IP & Law Office
1	Lao Interconsult
1	Lao Law & Consultancy
1	Lao Premier International
1	Tilleke & Gibbins
2	Lao IP Agency
2	Rajah & Tann
2	Vientiane International Law
2	VNA Legal
2	ZICO Law (Laos)

MACAU

	PATENTS
1	BN Intellectual Property Services
1	C&C Lawyers
1	DSL Lawyers
1	MdME Lawyers
1	RPmacau
2	FCLaw
2	Inventa International
2	Manuela António Lawyers and Notaries
2	Nuno Simões & Associados
2	Riquito Advogados

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Chinese Trademark Agent



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including 42
attorneys/agents

Technology Fields

- Electronics
- Software
- Semiconductors
- Electronic Materials
- Optics
- Telecommunications
- Mechanical Engineering
- Information Technology
- Semiconductor
- Chemical

Partners



Aki Iyuka



Hiroya Akashi



Tadayoshi Higashiyama



Manabu Takata



Daisuke Koiso



Tetsuya Hase



Kazutoshi Iiyama



Kenichiro Aoki



Nobuhiro Yamanaka



Kouhei Awaya

Recent Recognitions

- Rising Star in Japan IP, ILASA
- Top 5 Japan Patent Firm & Top 10 Japan Trademark Firm, Asia IP
- Top 12 Japanese patent firms & Top 12 Japanese trademark firms, ALB
- Top 20 Japan Patent Firm & Top 20 Japan Trademark Firm, MIP

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MALAYSIA

PATENT PROSECUTION		PATENT CONTENTIOUS	
1	DCC Advanz	1	LindaWang Su & Boo, a member of ZICO IP
1	Henry Goh & Co.	1	Rahmat Lim & Partners
1	Marks & Clerk	1	Shearn Delamore & Co.
1	Shearn Delamore & Co.	1	Skrine
1	Skrine	1	Wong & Partners
2	LindaWang Su & Boo, a member of ZICO IP	2	LAW Partnership
2	Mirandah Asia	2	Raja, Darryl & Loh
2	Rahmat Lim & Partners	2	Shook Lin & Bok
2	Tay & Partners	2	Tay & Partners
2	Wong & Partners	2	Wong Jin Nee & Teo



MONGOLIA

PATENTS	
1	ATS Partners
1	Delger IP
1	GN & Co.
1	IPPI
1	S&O IP
2	DB & GTS
2	Dunnaran + Partners
2	GRATA International
2	Mahoney Liotta
2	MDS & KhanLex

MYANMAR

PATENTS	
1	Khine Khine U Law Firm
1	The Law Chambers
1	Tilleke & Gibbins
1	U Myint Lwin Law Office
1	Win Mu Tin
2	Kelvin Chia Yangon
2	Rouse
2	U Nyunt Tin Associates
2	ZICO Law Myanmar

NEPAL

	PATENTS
1	Apex Law Chambers
1	Gandhi & Associates
1	Global Law Associates
1	Janak Bhandari & Associates
1	Pradhan & Associates
2	Bhagawan & Associates
2	Global Trademark Protection Services
2	Imperial Law Associates
2	Pioneer Law Associates
2	Solar Law Associates



NEW ZEALAND

	PATENT PROSECUTION
1	AJ Park
1	CreteIP
1	Davies Collison Cave
1	Ellis Terry
1	James & Wells
2	Catalyst Intellectual Property
2	Dentons Kensington Swan
2	Henry Hughes
2	Origin IP
2	Pipers

	PATENT CONTENTIOUS
1	AJ Park
1	Chapman Tripp
1	Ellis Terry
1	James & Wells
1	Simpson Grierson
2	Bell Gully
2	Dentons Kensington Swan
2	Henry Hughes
2	Ironside McDonald
2	Zone Law

PAKISTAN

	PATENTS
1	Bharucha & Co.
1	Remfry & Son
1	Sheikh Brothers
1	United Trademark & Patent Services
1	Vellani & Vellani
2	Ali & Associates
2	Irfan & Irfan
2	Khursheed Khan
2	Surridge & Beecheno
2	Zain Sheikh & Associates



PHILIPPINES

	PATENT PROSECUTION
1	ACCRA Law
1	Cruz Marcelo & Tenefrancia
1	Hechanova Group
1	Sapalo Velez Bundang & Bulilan
1	SyCip Salazar Hernandez & Gatmaitan
2	Castillo Laman Tan Pantaleon & San Jose
2	Esguerra & Blanco
2	Mirandah Asia
2	Quisumbing Torres
2	Romulo Mabanta Buenaventura Sayoc & de los Angeles

	PATENT CONTENTIOUS
1	ACCRA Law
1	Cruz Marcelo & Tenefrancia
1	Quisumbing Torres
1	Sapalo Velez Bundang & Bulilan
1	SyCip Salazar Hernandez & Gatmaitan
2	Bengzon Negre Untalan
2	Castillo Laman Tan Pantaleon & San Jose
2	Esguerra & Blanco
2	Hechanova Group
2	Romulo Mabanta Buenaventura Sayoc & de los Angeles



SINGAPORE

	PATENT PROSECUTION
1	Allen & Gledhill
1	Drew & Napier
1	Marks & Clerk
1	Spruson & Ferguson
1	Viering, Jentschura & Partner
2	Amica Law
2	Bird & Bird ATMD
2	Dentons Rodyk
2	Donaldson & Burkinshaw
2	Mirandah Asia

	PATENT CONTENTIOUS
1	Allen & Gledhill
1	Amica Law
1	Bird & Bird ATMD
1	Dentons Rodyk
1	Drew & Napier
2	Baker McKenzie Wong & Leow
2	Lee & Lee
2	Mirandah Law
2	Rajah & Tann
2	Ravindran Associates

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1	FirstLaw
1	Kim & Chang
1	Lee International IP & Law
1	You Me Patent & Law Firm
1	Y.P. Lee, Mock & Partners
2	AIP Patent & Law Firm
2	Bae, Kim & Lee
2	KBK & Associates
2	Lee & Ko
2	Nam & Nam

	PATENT CONTENTIOUS
1	Bae, Kim & Lee
1	FirstLaw
1	Kim & Chang
1	Lee & Ko
1	Lee International IP & Law
2	Nam & Nam
2	Shin & Kim
2	Y.P. Lee, Mock & Partners
2	Yoon & Yang
2	You Me Patent & Law Firm

SRI LANKA

	PATENTS
1	FJ & G de Saram
1	John Wilson Partners
1	Julius & Creasy
1	Neelakandan & Neelakandan
1	Sudath Perera Associates
2	DL & F De Saram
2	Nithi Murugesu & Associates
2	Nithya Partners
2	Shaam & Associates
2	Tiruchelvam Associates



TAIWAN

PATENT PROSECUTION		PATENT CONTENTIOUS	
1	Lee and Li	1	Lee and Li
1	Tai E International Patent & Law Office	1	Tai E International Patent & Law Office
1	TIPL0 (Taiwan International Patent & Law Office)	1	TIPL0 (Taiwan International Patent & Law Office)
1	Top Team International Patent & Trademark Office	1	Tsai, Lee & Chen
1	Tsai, Lee & Chen	1	Tsar & Tsai
2	Baker McKenzie	2	Baker McKenzie
2	Giant Group	2	Formosan Brothers
2	Rich IP	2	Rich IP
2	Saint Island International Patent & Law Offices	2	Sigma IPR
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RichIP Group has been asked to formulate patent curriculums for IP judges and patent examiners for many years.

RichIP Group has delivered patent training courses and lectures to enterprises, universities and research institutes in Taiwan and China for more than two decades.



THAILAND

PATENT PROSECUTION		PATENT CONTENTIOUS	
1	Baker McKenzie	1	Baker McKenzie
1	Domnern Somgiat & Boonma	1	Domnern Somgiat & Boonma
1	Rouse	1	R&T Asia
1	Satyapon & Partners	1	Satyapon & Partners
1	Tilleke & Gibbins	1	Tilleke & Gibbins
2	Ananda Intellectual Property	2	Ananda Intellectual Property
2	ILCT	2	ILAWASIA
2	SLC Nishimura	2	Rouse
2	WE Intellectual Property	2	Spruson & Ferguson
2	ZICO Law	2	WE Intellectual Property



VIETNAM

PATENT PROSECUTION		PATENT CONTENTIOUS	
1	Ageless IP Attorneys & Consultants	1	Baker McKenzie/BMVN International
1	Baker McKenzie/BMVN International	1	Pham & Associates
1	Pham & Associates	1	Rouse
1	Tilleke & Gibbins	1	Tilleke & Gibbins
1	Vision & Associates	1	Vision & Associates
2	Ambys Hanoi	2	Ageless IP Attorneys & Consultants
2	D&N International	2	D&N International
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2	T&T Invenmark	2	Lê & Lê
2	VCCI – IP	2	T&T Invenmark

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Software is now a vital part of innovation across various sectors, but many nations lack sufficient patent protection for software-related inventions. *Excel V. Dyquiango* discusses the shift from hardware- to software-driven innovation and the significance of updating IP regulations.

Technology is the digital economy's backbone, and software is largely responsible for its value. With its exponential growth, software is becoming more necessary to drive growth across all economic sectors. As such, this has brought significant ramifications for laws governing intellectual property.

Until the latter half of the 20th century, most of the functionality of innovative products, especially those that relied on semiconductors, was in hardware. Their patentability was without dispute. Today, however, innovation is no longer only driven by physical items – software is gradually replacing hardware as the primary source of technical capabilities. However, software-related innovations frequently lack or have very little protection under patent laws in many nations.

The enormous economic development and inventive potential of technology businesses that create hybrid products combining hardware and software and the software sector, in general, indicate that it is time to reevaluate IP regulations and bring them in line with modern commercial realities.

“We can find that most industries today must rely on software technology, which can be said to be ubiquitous – Industry 4.0, internet of things (IoT), AI and deep learning, big data, Fintech, blockchain, 3D printing,” said Chien-Chung Yuan, vice CEO of Taiwan Rich IP & Co. in Taipei. “While some research reveals that many start-up companies, especially the so-called unicorns, do not pay much attention to patent

protection in the early stages of the establishment because of the use of funds or strategic priorities. Most of them survive a few years later are those companies that have sought patent protections for their innovations at the beginning, and most of the patents cover and claim software technology. For example, Uber, Snap, Amazon, Facebook and so on.”

He added: “In addition, most of the patents owned or used by the non-practicing entities (NPE) known to us for filing lawsuits are software patents. Obviously, software patents will become more and more important to enterprises, and even an important tool for enterprises to maintain their advantages in market competition.”

Protecting software and making adjustments

Taiwan has announced specific Patent Examination Guidelines for Computer Software-related Inventions since 1998 – with several revisions in 2008, 2014 and 2021. With the Taiwan Intellectual Property Office (TIPO) having good specifications and criteria for various patent requirements, TIPO has successively proposed case compilation or drafting guidelines for patent applications, claiming emerging information technologies so that inventors may have useful tools to protect their creations.

For patent litigation, Taiwan established an intellectual property court in 2008, reorganized in 2021, and exclusively hears cases related to intellectual

property rights, including administrative, civil and criminal proceedings. In addition, due to the inclusion of administrative and civil lawsuits, ordinary courts often suspend litigation and wait for a decision on the validity of patents in the past, thus delaying the trial schedule.

However, in the Patent Examination Guidelines for Computer Software-related Inventions announced in 2014, some references were made to the USPTO's standards for the subject matter's eligibility and EPO's examination standards for inventive steps.

"These guidelines resulted in a significant increase in the threshold and made it difficult for ecommerce related inventions to be patentable or granted," said Yuan. "TIPO, however, adjusted its criteria to comply more with technological developments and world trends by referring to Japan Patent Office guidelines, so software or computer-based inventions will not be barred at the beginning. Accordingly, the patent examination guidelines for computer software-related inventions are more like the criteria for those inventions in other technical fields. At the same time, TIPO maintains good communication with the industry and constantly proposes new measures or revisions to assist inventors in protecting their creations. Therefore, if inventors and applicants have any questions, they are encouraged to contact TIPO directly, and TIPO is willing to work with the public to find better solutions."

Unlike the USPTO, which follows U.S. Court of Appeals judgments to adjust the examination guidelines (MPEP), or China's IP court, which makes judgments completely following the examination guidelines announced by the National Intellectual Property Administration of China (CNIPA), Taiwan's TIPO and IP court have independent criteria for judging the validity of patents.

"Accordingly, there will inevitably be inconsistencies," said Yuan. "This also leads to the fact that software patents may have a quite high approval rate in the application stage – just like Japan. The JPO is called 'the paradise of software patents.' But in the litigation stage, the winning rate for the patentee is relatively low."

He added: "Taiwan revised and announced the Intellectual Property Cases Trial Law on February 15, 2023, expected to be implemented on August 30, 2023, which will establish a judicial and administrative information exchange system to aim an objective to avoid divergent judgments and settle disputes at the one-time. Of course, to avoid this situation, patent applicants should still pay attention to the quality of patent drafting."

Looking for technical features

Meanwhile, in Indonesia, a computer program can be patentable if its characteristics have a technical effect and function to solve a tangible or intangible problem. Computer programs are protected under the copyright law. Enforcement in Indonesia, however, can be challenging in general, and not many cases related to software and computer-implemented inventions have been brought to court. Therefore, it is crucial during

infringement actions to have adequate evidence and good expert witnesses who can explain the invention and the law to the court.

"It is quite important that in looking to patent or protect software or computer-implemented inventions (CII), patent drafters should make sure to include in the description and claims, if possible, that the software can be linked to a tangible medium," said Wongrat Ratanaprayul, director at Tilleke & Gibbins in Jakarta. "A computer program with no connection to a tangible medium is not patentable in Indonesia."

She stressed the importance of finding evidence that would convince the court that infringement occurred for challenges where cases of infringement are involved. As for patent invalidation, "a well-written patent specification demonstrating patentability under the Indonesian patent law is key."

Similarly in Singapore, Desmond Tan, principal at FPA Patent Attorneys Asia in Singapore, said it is also about "technical features" of the invention, as this would be critical for determining both allowability and scope of the invention.

"Patents can be used to protect CIIs," he said. "The use of patents to protect CIIs is consequential of a national thrust to make Singapore a hub for AI and Fintech, both as a centre for R&D and as a testbed for such innovations. There is case law in Singapore maintaining the validity of CII patents (*Main Line v. UOB*), so there is some certainty in this regard."

He added that protecting software or CIIs in Singapore would require a similar approach to seeking the same protection in Europe. While identifying technical features of such inventions can be challenging, the consistent approach with Europe guides patent applicants to adopt Euro-centric strategies for Singapore for some certainty of success. This consistency is especially helpful when prosecuting an application under PPH in Singapore.

Having multiple IP mechanisms

In India, the legal framework for protecting software and computer-implemented inventions (CII) encompasses patent, copyright and IT law. The Indian Patent Act of 1970 stipulates that mathematical or business methods, computer programs per se, or algorithms are not patentable – but software or CII contributing to a technical process or enhancing hardware efficiency could be patentable, which has been expanded to cover digital inventions as per present industry growth by way of some latest judgments.

The Copyright Act of 1957 categorizes computer software as a "literary work," enabling protection for the code, structure, software sequence and organization, safeguarding the expression of an idea rather than the idea itself. The Information Technology Act of 2000, dealing with digital signatures, cybercrime and data privacy, provides legal recognition of the digital rights of the software and CII.

"The protection of software and computer-implemented inventions can be achieved through multiple intellectual property mechanisms," said Rahul Dev, partner and principal attorney at the

"Trademarks, while not protecting the software itself, safeguard the brand name under which it is sold. Each protection form has its pros and cons, and often a comprehensive approach using multiple protections offers the best defense."

—**RAHUL DEV**, partner and principal attorney, Law Office of Rahul Dev, Gurugram

"It is quite important that in looking to patent or protect software or computer-implemented inventions (CII), patent drafters should make sure to include in the description and claims, if possible, that the software can be linked to a tangible medium."

—**WONGRAT RATANAPRAYUL**, director, Tilleke & Gibbins, Jakarta

"Research reveals that many start-up companies do not pay much attention to patent protection in the early stages of the establishment because of the use of funds or strategic priorities."

—**CHIEN-CHUNG YUAN**, vice CEO, Rich IP & Co., Taipei

"The use of patents to protect CIIs is consequential of a national thrust to make Singapore a hub for AI and Fintech, both as a centre for R&D and as a testbed for such innovations. There is case law in Singapore maintaining the validity of CII patents, so there is some certainty in this regard."

—**DESMOND TAN**, principal, FPA Patent Attorneys Asia, Singapore



Law Office of Rahul Dev in Gurugram. "Patents can shield underlying ideas and methods, provided they meet novelty, non-obviousness, and utility criteria, though patentability laws for software vary globally. Copyright automatically protects the software's unique expression, such as source code and user interface, but it can't defend against the independent creation of similar works. Trade secrets offer protection for confidential elements like unique algorithms or techniques but can't safeguard against independent discovery or reverse engineering."

He added: "Trademarks, while not protecting the software itself, safeguard the brand name under which it is sold. Each protection form has its pros and cons, and often a comprehensive approach using multiple protections offers the best defense, depending on the invention's nature, the business model, and jurisdiction-specific laws."

While India has made substantial strides in strengthening its IP laws, the software protection or CII poses specific challenges.

"The patentability guidelines around software or

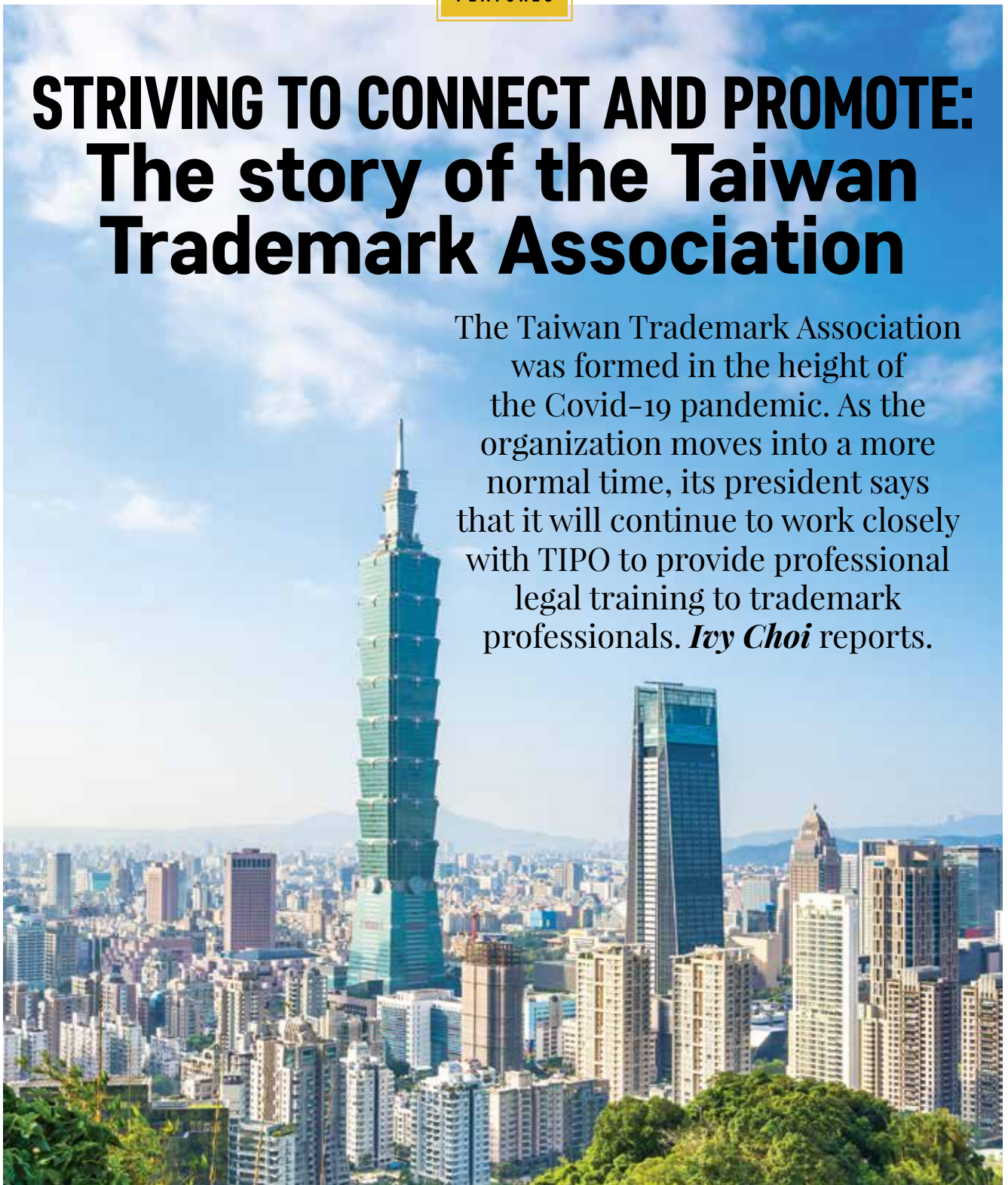
CII contributing to a technical process or enhancing hardware efficiency are somewhat ambiguous, leading to uncertainty, which has been highlighted by courts in few of the recent judgments," he said. "The lengthy patent application process, which often spans several years, can hinder fast-paced software or CII innovations. Enforcing granted patents is another hurdle, with the litigation process often slow and costly. Furthermore, a significant lack of awareness about intellectual property rights among software developers and businesses results in the patent system's under-utilization."

To address these challenges, he added that clearer guidelines from the Indian Patent Office, streamlined patent application processes possibly employing AI technology, enhanced enforcement mechanisms, and widespread awareness campaigns about patent importance and procedures could significantly improve the effectiveness of patent laws and their implementation.

"This would bolster protection for software and CII in India," he said. ^{AP}

STRIVING TO CONNECT AND PROMOTE: The story of the Taiwan Trademark Association

The Taiwan Trademark Association was formed in the height of the Covid-19 pandemic. As the organization moves into a more normal time, its president says that it will continue to work closely with TIPO to provide professional legal training to trademark professionals. *Ivy Choi* reports.



The year 2020 marked the 90th anniversary of the enactment of the Taiwan Trademark Act. While Taiwan's history of trademark laws dates back to nearly a century ago, it wasn't until 2020 that a dedicated trademark organization was finally established. For the past three years, the Taiwan Trademark Association (TTA) has made great progress in achieving its vision of building a robust global network for Taiwan's trademark community, despite challenges such as the Covid pandemic.

Grace Shao, president of TTA and a partner at Baker McKenzie in Taipei, said that prior to the establishment of TTA, the absence of a dedicated trademark organization in Taiwan made it difficult to sustain international collaborations, as there was no dedicated entity to facilitate such partnerships and exchanges, especially when there are already organizations such as INTA, the Japan Trademark Association, the China Trademark Association and other such local and regional organizations. "The

founding president of TTA, Dr. Wen Pin Lai, is the key person in making this possible. With support from the Taiwan IP Office (TIPO), he invited 37 well-known trademark professionals as the founding members to establish TTA.”

Lai, also known as Peter Lai, established Chien Yeh & Associates in 1975; prior to the establishment of the TTA, he had a long history of working with Taiwanese companies doing business in mainland China.

According to Shao, TTA now comprises more than 200 members, including individual and group members. Individual members are mainly lawyers, trademark agents, IP-related legal personnel and law firm partners. Other members include corporate executives, professors, patent agents, designers and engineers. While the majority of group members are patent and trademark agencies, there are also high-tech enterprises, food companies, and design firms.

"Given the complex political dynamics between Taiwan and mainland China, managing IP and trademark exchanges across the Strait can be intricate and sensitive. It requires careful navigation, open dialogues, and efforts towards mutual understanding and recognition. TTA aims to foster a more harmonious trademark and IP environment between Taiwan and mainland China. So far, TTA has taken steps towards this goal by initiating online greeting meetings, a move that has started to bridge the gap and enhance communication with mainland Chinese organizations. By continuing these efforts, TTA aims to promote cross-Strait trademark exchanges, thereby enhancing the overall understanding and cooperation in the trademark industry between Taiwan and mainland China."

—GRACE SHAO, partner, Baker McKenzie, Taipei, and president of the Taiwan Trademark Association



“We hope to enhance the awareness and recognition of Taiwan brands,” Shao said.

Furthermore, TTA has become an official member of INTA, which opens more opportunities for TTA to collaborate with international counterparts, share insights, and contribute to global trademark discussions so that it can work towards its goal of strengthening international connections within the trademark industry. An example of TTA’s endeavour to strengthen its presence in the international trademark arena is hosting the “Taiwan Night” cocktail reception on May 18, during INTA’s 2023 annual meeting in Singapore. The reception attracted more than 120 guests from around the world, and was supported by partners including Yu Jen Jai, Delta, Acer, Gigabyte, Chi Po-lin Foundation, Hsin Tung Yangimeimei, Shin Kong Mitsukoshi, Wistron and Longkow.

“TTA has set its sights on expanding its network and influence by reaching out to different trademark organizations across various jurisdictions,” Shao said. “Target organizations include the Japan Trademark Association and China Trademark Association, among others. By broadening its connections, TTA aims to foster greater international cooperation, exchange ideas and best practices, and strengthen the global trademark ecosystem.”

In particular, promoting cross-strait trademark exchange between Taiwan and China is a challenging but essential aspect of TTA’s work. Shao said: “Given the complex political dynamics between Taiwan and mainland China, managing IP and trademark exchanges across the Strait can be intricate and sensitive.” Despite such challenges, Shao said TTA’s efforts in promoting cross-strait trademark exchanges could potentially bring about beneficial outcomes, though it will take patience, persistence, and strategic planning to achieve these goals. “It requires careful navigation, open dialogues, and efforts towards mutual understanding and recognition.”

The role of TTA is to help mitigate these cross-strait issues and shape a more cooperative trademark environment by establishing a platform for discussion, facilitating dialogue, and promoting understanding between the two sides. “TTA aims to foster a more harmonious trademark and IP environment between Taiwan and mainland China. This goal addresses any existing legal ambiguities and aims to promote mutual recognition of trademarks. So far, TTA has taken steps towards this goal by initiating online greeting meetings, a move that has started to bridge the gap and enhance communication with mainland Chinese organizations.” Future plans to further this goal include potential negotiations, academic exchanges, and collaborative projects with relevant mainland Chinese organizations. “By continuing these efforts, TTA aims to promote cross-Strait trademark exchanges, thereby enhancing the overall understanding and cooperation in the trademark industry between Taiwan and mainland China.”

TTA was founded in August 2020, during which

Taiwan was facing serious impacts of Covid-19. Shao recalled: “The pandemic severely restricted physical interactions and halted many activities. This likely made it difficult for professionals in the trademark industry to network, collaborate, and share knowledge effectively.” Nevertheless, TTA did manage to bring together domestic expertise by organizing the “Master Talk” series, a professional seminar once every two months during the pandemic. “This initiative helped to maintain an active dialogue and foster knowledge sharing among industry professionals during these challenging times.”

One of the goals of TTA is to promote Taiwan’s trademark legal system through education, knowledge sharing, and promoting the understanding of legal reforms and best practices. In addition to the ongoing “Master Talk” series, TTA is also planning a new initiative called the “Fireside Chats”, which aims to delve into topics of brand management and franchise strategy. By inviting business leaders who specialize in these areas, the chats are expected to spark insightful discussions and knowledge exchange on practical aspects of the industry.

In response to the recent Trademark Act amendments, for which TTA has participated in legislative discussions with TIPO and the Legislative Yuan to protect the interests of trademark professionals,



Goal & Mission

1. Establish a brand management mechanism to assist corporate brands to reduce legal risks.
2. Develop an academic environment with domestic trademark law scholars.
3. Build an international exchange system to connect with relevant groups in various countries or regions.
4. Devote trademark legal research and provide professional advice to the government.



Taiwan Trademark Association

- 

The overlapped English letters “T” look like people hands in hands, hoping that the Taiwanese trademark industry can help each other, share prosperity and stick together via TTA’s platform and turn the industry into a union with legal capacities.
- 

The letter “A” on the right of the mark looks like a towering mountain extending into clouds with an endless top, symbolizing an encouragement to TTA to have upward developments as unlimited as possible.
- 

The device on the far right of the mark stands for a volume icon, symbolizing TTA’s expectation to help Taiwanese brands be seen by the world as frequently as possible.

TTA has been providing related workshops regularly, covering the interpretation of new regulations, application and review processes, case studies, and more.

“The goal is to familiarize members with the latest laws and practical operations,” Shao said.

The recent Trademark Act amendments include a new system to regulate trademark agents, and a pending bill for restructuring the trademark prosecution system, to abolish the administrative appeal and establish a trademark review board within the TIPO. “In the future, trademark application and opposition matters will no longer be handled by administrative litigation procedures; instead, they will be handled by quasi-civil litigation procedures. Therefore, we anticipate there will be significant change and impact on the trademark industry and legal professionals.”

In addition, TTA plans to invite officials from TIPO to deliver lectures, ensuring that members are updated with the most current and authoritative information. It also plans to work closely with TIPO to provide professional legal training to trademark professionals, and to promote the image and international visibility of the TTA and its members. 



MEANS-PLUS-FUNCTION LANGUAGE: Inconsistency between the Taiwan Intellectual Property Office and jurisdictional courts

Means-plus-function language – also known as MPF language – is a double-edged sword in Taiwan, sometimes helping and sometimes hurting a patent claim, depending on how the applicant uses it. *Dr. Cross Liu* explains how to weigh the pros and cons of using MPF language.

Taiwan's patent regime has been adopting means (or step)-plus-function ("MPF" for short) language for more than 20 years. MPF language is known as a special way to describe an element in a claim for a combination, and more specifically, it enables the element to be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof. From the practical perspective, there are two important

aspects which need to be considered regarding MPF language: one is how to recognize whether a claim uses MPF language, while the other is how to judge whether a claim using MPF language is definite. This article will draw your attention to the highlight that the Taiwan Intellectual Property Office (TIPO) and the jurisdictional courts have divergent opinions on the two aspects.

Inconsistency in recognizing whether a claim uses MPF language

Same as other patent regimes, the TIPO must follow the Patent Act, the Enforcement Rules of the Patent Act and the Examination Guidelines for Patents during the prosecution of a patent application. The Patent Act is actually silent about MPF language, and MPF language is primarily stipulated in the Enforcement Rules, Article 19, Paragraph 4, as follows:

An element of a claim, pertaining to an invention being a combination of a plurality of elements, may be expressed by means-plus-function language or step-plus-function language. Such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

This article makes a limitation to the usage of MPF language that the claimed invention must be a combination of a plurality of elements, which means that the claim including only one single element shall not use MPF language. The Enforcement Rules do not specify how to recognize whether an element of a claim is described in MPF language, whereas the Examination Guidelines provide a determination rule including three conditions as follows:

1. *Whether an element of a claim uses the expression of “means for” or “step for”?*
2. *Whether the element includes a specific function?*
3. *Whether the element does not include structure, material, or acts in support of the specific function?*

Under the determination rule, an element of a claim shall not be regarded as being described in MPF language unless the description form of the element meets all of the above three conditions. That is, as MPF language is successfully adopted to an element recited in a claim, the element shall basically be expressed as a “means for” or “step for” performing a specific function without the recital of structure, material, or acts in support thereof.

In practice, the TIPO tends to follow the applicant’s intention more than the description form of an element. The author’s experiences tell that the TIPO rarely concludes that an element is described in MPF language without the applicant’s confirmation or acquiescence, even if the TIPO feels or suspects that the description form of the element has met all of the three conditions.

In contrast, the jurisdictional courts (i.e., the Taiwan Supreme Administrative Court and the Taiwan Intellectual Property and Commercial Court) almost always focus on whether the description form of an element meets all of the three conditions, regardless of the applicant’s intention. In other words, the jurisdictional courts may conclude that an element is described in MPF language although the applicant had no such intention, and vice versa.

On the other hand, the TIPO strictly operates by the determination rule, whereas the jurisdictional courts uses the same rule in a looser way. Alternatively, we can say that the TIPO follows the form of the determination rule, while the jurisdictional courts





follow the substance of the same. For example, as an element uses the expression of “unit for” instead of “means for”, the TIPO may not identify that the first condition is met, but the jurisdictional courts may.

Inconsistency in judging whether a claim using MPF language is definite

Under the Enforcement Rules, Article 19, Paragraph 4, a claim using MPF language shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. Nevertheless, the Patent Act and the Enforcement Rules do not stipulate whether failure of describing the corresponding structure, material, or acts in the specification will make the claim indefinite. To some extent, this is why the TIPO and the jurisdictional courts have divergent opinions on determining whether a claim using MPF language is definite.

The definiteness requirement is necessary for both of the claim(s) and the specification and has been stipulated in the Patent Act, Article 26, the first and second paragraphs, as follows:

- 1) *A specification shall provide a description [for the claimed invention] in a **definite** and sufficient manner for a person ordinarily skilled in the art to understood and carried out.*
- 2) *Claim(s) shall define the claimed invention, and more than one claim can be included therein. Each claim shall be described in a **definite** and concise manner and be supported by the specification.*

The Examination Guidelines made by the TIPO further specify that if the specification does not describe the corresponding structure, material, or acts for the specific function described in MPF language, a person ordinarily skilled in the art is unable to determine the corresponding structure, material, or

acts, and such a situation will make the concerned claim indefinite. Because the patent examiners of the TIPO must be constrained by the Examination Guidelines, from the perspective of the TIPO, failure of describing the corresponding structure, material, or acts in the specification indicates that the concerned claim is indefinite.

The jurisdictional courts, however, have different opinions. Firstly, the jurisdictional courts are not bound by the Examination Guidelines, which means that the jurisdictional courts can judge by themselves whether failure of describing the corresponding structure, material, or acts in the specification makes the concerned claim indefinite.

Further, the Taiwan Supreme Administrative Court has affirmed, in its judgments (e.g., No. 355 in 2013, and No. 149 in 2016), that the requirement of describing the corresponding structure, material, or acts in the specification is made only for the sake of claim construction, and failure of describing the corresponding structure, material, or acts in the specification does not necessarily make the concerned claim indefinite. The Taiwan Supreme Administrative Court also expressed that the definiteness of a claim only depends on whether a person ordinarily skilled in the art can clearly understand the claimed invention based on the whole description of the specification, and this rule is fixed no matter whether the concerned claim uses MPF language.

Thus, from the perspective of the jurisdictional courts, a claim using MPF language may still be deemed definite as long as a person ordinarily skilled in the art can clearly understand the claimed invention, even if the specification fails to describe the corresponding structure, material, or acts for the specific function recited in the claim.

Takeaways

1 The specification had better somehow and somewhat provide descriptions about structure, material, or acts of each element of a claim, no matter whether the applicant intends to use MPF language in the claim or not.

If intending to use MPF language in the claim, the applicant, of course, shall describe the corresponding structure, material, or acts for the specific function of each element as much as possible. In doing so, the claim may more easily pass the inspection of the definiteness requirement, as either the TIPO or the jurisdictional courts are in charge. In addition, the more description for the corresponding structure, material, or acts the specification provides, the broader scope the concerned element can covers, once the TIPO or the jurisdictional courts conclude that the concerned element is described in MPF language.

On the other hand, it would be better still to provide some descriptions in the specification about structure, material, or acts of each element of a claim, even if the applicant does not have any intention to use MPF language in the claim. Such descriptions leave the claim a better way out from being indefinite.

If an amendment is applicable, the descriptions will enable the applicant to add the appropriate structure, material, or acts into the claim to help the claim escape from MPF language. If an amendment is not applicable, the descriptions may enable the applicant to clearly prove that the specification has described the corresponding structure, material, or acts for the specific function recited in the claim. In either situation, the applicant may accordingly have a good basis to emphasize that the concerned claim is definite enough based on the descriptions.

2 The applicant needs to carefully weigh up the pros and cons of MPF language before using it.

MPF language is an inherently indefinite way to describe an element of a claim. As an element of a claim is described in MPF language, the only definite part is the function recited in the claim, which means that a person ordinarily skilled in the art can only understand what the element does, but cannot understand how the element performs it. That is why a claim using MPF language shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

In other words, the protection scope of a claim using MPF language is sensitive to the description of the specification. As a result, using MPF language will put a more burden on the applicant about describing the claimed invention in the specification.

In return, MPF language enables the applicant to claim an invention in a concise and simple manner, and this is useful for the applicant to claim a complicated or diverse invention. In addition, MPF language can keep a claim from including an element which is defined and limited to the specific structure, material, or acts. Instead, the element described in MPF language will

be limited to the specific function recited in the claim, which means that the claim will not cover the functions similar to the specific function recited therein.

More specifically, if the claimed invention needs a specific function which can be performed by more than one feasible mechanism (i.e., structure, material, or acts), MPF language may be adopted to avoid that the claimed invention is limited to only one of the feasible mechanisms. The “specific” function will exclude other similar functions from the claim construction. For example, as the function recited in the claim is “detachable connection”, the claim will not be construed to cover other kinds of connection, such as “fixed connection”.

In contrast, if the claimed invention needs a specific mechanism (i.e., structure, material, or acts) which can perform more than one feasible function, MPF language may not be adopted to avoid that the claimed invention is limited to one of the feasible functions. The “specific” mechanism will exclude other similar mechanisms from the claim construction. For example, as the specific material recited in the claim is “Iron (Fe)”, the claim will not be construed to cover other kinds of materials, such as “Cobalt (Co)”.

In a word, MPF language is a double-edged sword, which may help or hurt the claims depending on how the applicant uses it. Accordingly, the applicant needs to carefully weigh up the pros and cons of MPF language before using it.

Conclusions

The inconsistency between the TIPO and the jurisdictional courts may create a loophole for opportunists, and appropriate harmonization is therefore necessary. Before that happens, though, the takeaways mentioned above may be helpful in reducing the possible negative effects caused by the inconsistency. ^{AIIP}

ABOUT THE AUTHOR

Dr. Cross Liu now is the executive manager of the Rich IP & Co. He holds a Ph.D. in electrical engineering from TAMKANG University, Taiwan, and has been committed to patent work for more than a decade. He is familiar with Taiwan and China patent prosecutions, and good at dealing with patent affairs, including but not limited to, patent applications, patent invalidation (revocation), patent portfolio management, patent searching, patent patentability analysis and patent infringement analysis, in the fields of information, communication and electronics. He always tries his best to resolve his clients' problems in an efficient and beneficial way. This article only expresses the author's view, and does not include any opinions of the RichIP Group.

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IP EXPERTS 2023

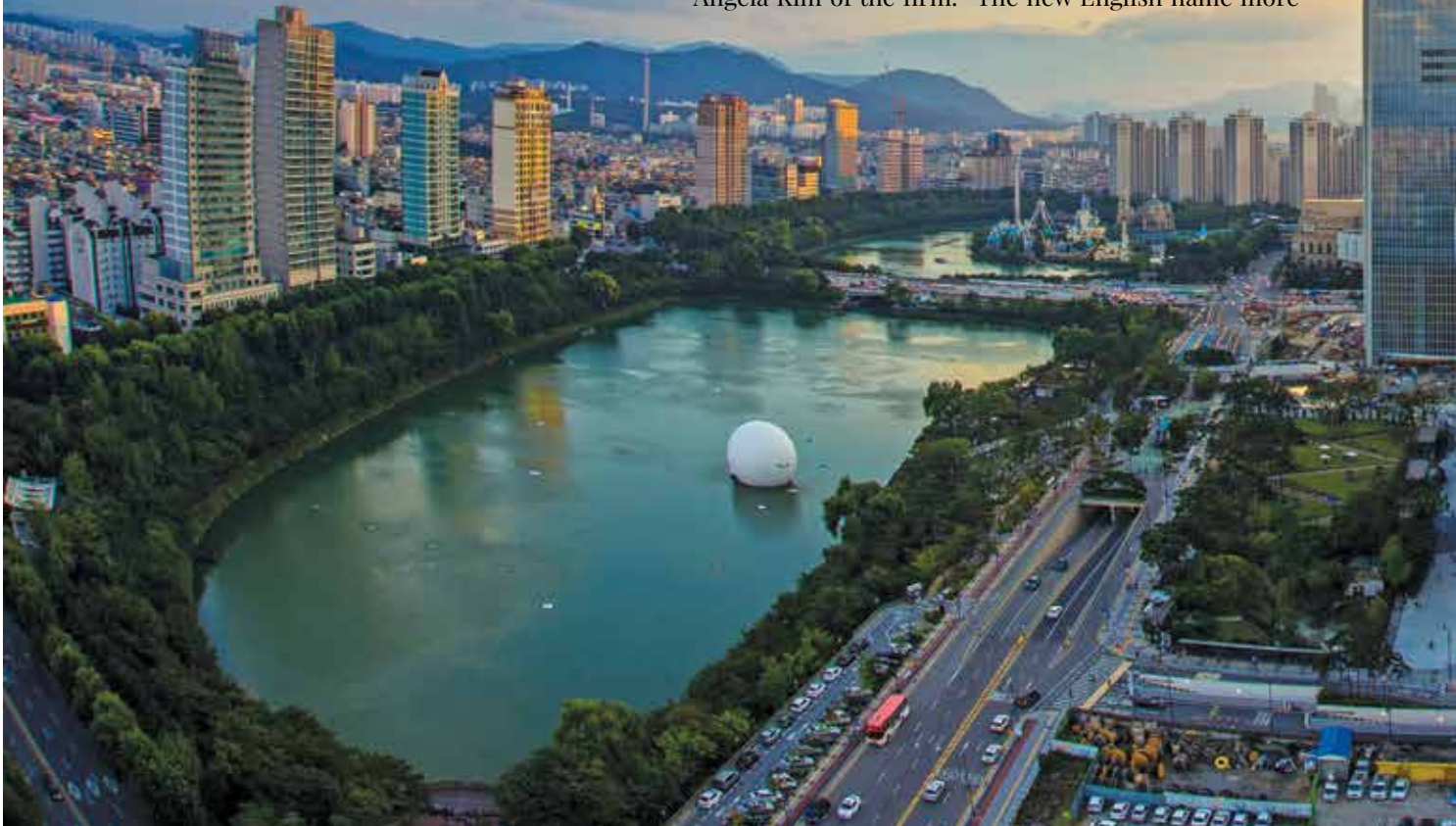
South Korea

The value of South Korea's intellectual property market exceeded US\$1 billion in 2023. That valuation could reach US\$5.2 billion by 2033, according to market research organization Future Market Insights (FMI).

Earlier this year, FMI noted that the South Korean government provides security and protection for intellectual property assets, which is essential in a country with as many advanced technology industries as South Korea does. "Telecommunications, semiconductors and electronics ... create huge opportunities in the country by collaborating with research and development activities," the organization said. It also lauded the work that South Korean companies do in R&D. "Companies heavily invest in research and development activities to bring innovative solutions by adopting technology," it said. "These companies are engaged with Korean institutions in various projects to improve intellectual property."

South Korea has also seen tremendous growth in startups in sectors such as ecommerce, biotechnology, fintech, and gaming, which in turn is increasing the adoption of intellectual property. "Startup companies protect and monetize their intellectual property by enhancing their business scale," company analysts said.

The country has made great efforts to make its IP regime comfortable and friendly for IP owners from abroad. Lawyers from Kim & Chang, writing in a firm news release, reported that the English name for the specialized appellate court for intellectual property cases in Korea, formerly known as the Patent Court, was officially changed to the "Intellectual Property High Court" on February 16, 2023, by order of the Office of the Director of International Affairs. "Interestingly, the Korean name for the court remains the same for now (and literally means 'Patent Court' in English), as no decision to revise the Korean name has yet been taken," wrote Seok Hyun Kwon, Beth Jang and Angela Kim of the firm. "The new English name more



accurately reflects the jurisdiction of the court, which has authority over all types of IP cases, not just patent cases.”

The firm noted that the IP High Court was originally established in 1998 to consolidate appeals of most intellectual property cases in South Korea into a single court with experience handling IP issues; it is located in the city of Daejeon where the Korean Intellectual Property Office is also situated. The court comprises a total of 18 judges, each of whom previously must have served as a judge for at least 12 years, and each appeal case is heard by a panel of three judges from the court.

With the country at such an exciting stage in its development, we turned to IP professionals in the region in order to understand better what clients are looking for from today’s IP lawyer. *Asia IP* asked a large number of professionals – mostly in-house counsel and corporate legal managers – what they were looking for from their legal service providers. From their answers, we have compiled our list of South Korea’s 60 IP Experts, those lawyers who understand just what their clients need and are able to provide them with the best practical advice.


Top-notch individuals are increasingly easy to come by in Seoul, although the legal market itself still

skews to old-school, very established firms. Lee & Ko and Kim & Chang for example, each placed nine lawyers on our list; Kim & Chang placed eight lawyers, together accounting for nearly one-third of our list.

Lee International IP & Law and Nam & Nam each placed four lawyers on the list, while Bae, Kim & Lee; Y.P. Lee, Mock & Partners; and Yulchon each placed three lawyers on the list. A host of firms had two each: KBK & Associates, Muhann Patent & Law Firm, PI IP Law, Shin & Kim, Yoon & Lee International Patent & Law Firm, and You Me Patent & Law Firm.

Thirteen different firms each placed one lawyer on our list, accounting for more than one-quarter of all lawyers named, demonstrating that while the largest firms still dominate, smaller upstarts are hot on their heels.

Most of the lawyers named to our list have multiple practice specialties. Many of them are litigators, while others concentrate on prosecution work or provide strategic advice.

All of them have something in common: they are experts in their fields and, in one way or another, they provide extra value for their clients. They are *Asia IP*’s South Korea IP Experts.—GREGORY GLASS 



SOUTH KOREA IP EXPERTS TOP 60

NAME	FIRM	PATENTS	TRADEMARKS	COPYRIGHT	ENFORCEMENT	LICENSING & FRANCHISING	MEDIA & ENTERTAINMENT	IT & TELECOMS	PHARMA & BIOTECH	IP LITIGATION
Hee-Joo Ahn	SungAm Suh International Patent & Law	✓	✓							✓
In-Gyung Baek	KBK & Associates		✓			✓				✓
Il Hee Bahn	Lee & Ko		✓							
Haecheol Bahng	KBK & Associates	✓			✓	✓				✓
Duck Soon Chang	Kim & Chang	✓							✓	✓
Sun Chang	Lee & Ko	✓	✓		✓					✓
Alex Hyon Cho	NAM & NAM		✓							
Yoon (Yoonkyung) Cho	YP Lee, Mock & Partners		✓	✓	✓	✓				✓
Jeong Yeol Choe	Yulchon	✓			✓			✓	✓	✓
Sung-Woo Choi	WooIn Patent & Law Firm		✓							
Peter SungJin Chun	Muhann Patent & Law Firm	✓			✓	✓		✓		✓
Sang-Wook Han	Kim & Chang	✓				✓		✓		✓
David Hunjoon Kim	You Me Patent & Law Firm	✓				✓				✓
Jae Hoon Kim	Lee & Ko	✓	✓		✓					✓
James Yeon-Soo Kim	HanYang International		✓			✓				
Jehyun Kim	YP Lee, Mock & Partners	✓								
Jihyun Kim	Bae, Kim & Lee		✓		✓					✓
Jin Hoe Kim	Lee International IP & Law		✓		✓			✓	✓	✓
Ji-Woong Kim	NAM & NAM	✓							✓	✓
John Kim	Lee & Ko	✓	✓		✓					✓
Sunghwan Kim	You Me Patent & Law Firm		✓							
Sung-Nam Kim	Kim & Chang		✓							
Terry Taehong Kim	Lee International IP & Law	✓								
Un Ho Kim	Lee & Ko	✓	✓		✓					✓
Wonil Kim	Yoon & Yang IP	✓	✓					✓	✓	✓
Young Kim	Kim & Chang	✓							✓	✓
Eric KeeWan Koo	Muhann Patent & Law Firm		✓	✓	✓		✓		✓	✓
Ann Nam-Yeon Kwon	Kim & Chang		✓		✓			✓	✓	✓
Taeck Soo Kwon	Bae, Kim & Lee	✓	✓		✓					
Young Mo Kwon	Lee & Ko	✓								✓
Daeho Lee	PI IP Law	✓	✓					✓		
Doug Jay Lee	KAI International IP Law Firm		✓							
Jeong Won Lee	FirstLaw							✓	✓	
Samuel SungMok Lee	Yulchon	✓		✓	✓	✓		✓		
Seo-Young Lee	NAM & NAM	✓	✓						✓	✓
So Young Lee	Jipyong			✓			✓			
Soowan Lee	AIP Patent & Law Firm	✓			✓					✓
Vera Eun Woo Lee	Lee & Ko		✓	✓						✓
Youngpil Lee	YP Lee, Mock & Partners	✓								
Yunki Lee	Kim & Chang	✓			✓				✓	✓
Bo Kyung Lim	Shin & Kim	✓								✓
Hyeong Joo Lim	Yulchon		✓	✓				✓		
Ho-Hyun Nahm	Barun IP & Law	✓	✓		✓					✓
Mun Ki Nam	Bae, Kim & Lee	✓			✓	✓			✓	✓
Choong Jin Oh	Lee & Ko	✓	✓							✓
Man Gi Paik	Kim & Chang	✓				✓		✓		✓
Darby Park	Dana Patent Law Firm	✓				✓		✓		✓
Ghyo-Sun Park	Shin & Kim	✓	✓	✓				✓	✓	✓
Gunhong Park	PI IP Law	✓	✓					✓		
Hwan Sung Park	Lee & Ko	✓								✓
Jang Won Park	Park, Kim & Partners	✓	✓							
Seung-Moon Park	Darae Law & IP Firm	✓								✓
Young-Bo Shim	Lee International IP & Law	✓			✓					✓
Yoon Suk Shin	Lee International IP & Law	✓								
Min Son	Hanol IP & Law	✓							✓	
Byeong-Ok Song	Yoon & Lee International Patent & Law Firm	✓								
Chun Y. Yang	Kim & Chang	✓						✓		✓
Jay (Young-June) Yang	Kim & Chang	✓	✓					✓	✓	✓
Dong-Yol Yoon	Yoon & Lee International Patent & Law Firm	✓								
Ben (Beyong-ho) Yoo	NAM & NAM	✓						✓		

Extended biographies of lawyers highlighted above appear on Pages 37-38



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Alex Cho is a vastly experienced trademark attorney, who has handled all types of matters relating to trademark in South Korea and around the world on behalf of multinational corporate clients for more than 20 years.

More specifically, Mr. Cho has handled all types of work relating to trademark, such as trademark search, filing and prosecution, as well as enforcement and litigation matters relating to trademark in South Korea and around the world. Further, Mr. Cho has advised corporate clients over the years about the issues, which closely relate to trademark, such as copyright, advertising, labeling and packaging as well as licensing of trademark rights.

With handling of such extensive range of intellectual property matters over the years, Mr. Cho has gained the

skills of effectively advising corporate clients on issues such as:

1. The best ways to protect their intellectual property rights in South Korea and around the world;
2. The possible legal and business/practical risks of conducting their business under challenging situations;
3. The best strategy of conducting complex litigation; and
4. The cost-effective ways of handling legal issues under tight budget situation.

Thus, if you would need an experienced trademark counsel, who can provide practical and cost-effective solution to a trademark problem, Mr. Cho would be a good counsel for providing such assistance to you.



KIM, JI-WOONG
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Ji-woong KIM is a senior associate of the Electronics & IT group at NAM & NAM. His main areas of technological expertise are semiconductor device, display device, power plant, electric energy device, medical diagnostic imaging, computerized tomography, wireless communication network, and data processing.

His practice covers a wide range of intellectual property matters, including patent prosecution and appeal proceedings before the KIPO and invalidation actions before the Korean Patent Court. Especially, he has positive experience for invalidation actions in the technical fields of

Internet Service Provider as well as validity and freedom-to-operate analysis regarding LEDs.

Also, he has conducted patent trend analyses in the fields of miniature microphone, LTE, and wireless power recharging technologies. He is an excellent communicator, and this led to his being entrusted IP-related business counselling for clients. In addition, he has numerous overseas business experiences and he constantly receives positive feedback along the lines that conversing with he is very useful and the advice he offers is highly practical.



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Seo-young LEE is head of the Chemical & Bio & Pharm Group at NAM & NAM. Her main areas of technological expertise are chemicals, biotechnology, pharmaceuticals, and polymers.

Her practice covers a wide range of intellectual property matters, including patent prosecution and appeal proceedings before the KIPO and invalidation actions before the Korean Patent Court and the Korean Supreme Court, handling prosecution of patent term extension applications in the fields of pharmaceuticals and pesticides, and providing validity and freedom-to-operate opinions concerning vaccines and antibodies patents.

She also handles Green Book listings for international

pharmaceutical companies with Ministry of Food and Drug Safety (MFDS) and providing counseling to the companies regarding issues relating to patent listing under the Korean patent-regulatory approval linkage system.

She advises clients in the fields of pharmaceuticals, vaccines, recombinant DNA technology, microorganisms, pesticides, polymers, adhesive, semiconductor materials, cosmetics, and medical devices.

She also serves as a patent advisor for the Korean Rural Development Administration and frequently gives lectures on Korean patent prosecution and IP litigation in Korea. She is also a Central Pharmaceutical Affairs Review Committee member of MFDS.



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PATENTS
IT & TELECOMS

Ben Yuu understands the value of invention in the real world. Through him and his team, clients witness the strategy, dedication and trustworthiness of a true IP service provider.

Mr. Yuu is an accomplished and experienced patent attorney with a track record of proven results on patent prosecution and post-grant proceedings, infringement and invalidity analyses, litigations and the FTO in the fields of electronic devices, semiconductors, wireless standards including LTE and 5G, computer and SW, and new technologies including AI, the cloud and robotics.

Mr. Yuu has been a managing partner of NAM & NAM since joining the firm in 2016, where he is leading the firm's

operational excellence for international clients. He is admitted to the Korean Patent Bar, the California State Bar as US attorney at law and the USPTO as US patent attorney. Mr. Yuu is a rare attorney who understands the technology at stake and the ambitions of individual clients. He started his career as a patent attorney at NAM & NAM back in 1997 up until 2000.

After his 15-year IP voyage through Qualcomm(San Diego, California, 2001–2010, a vice president and patent counsel) and Samsung(South Korea, 2011–2015, a vice president and legal counsel leading the Patent and Technology Analysis Group) he is armed with greater experiences and deeper insights and committed to pave the ways for the success of clients in Korea.

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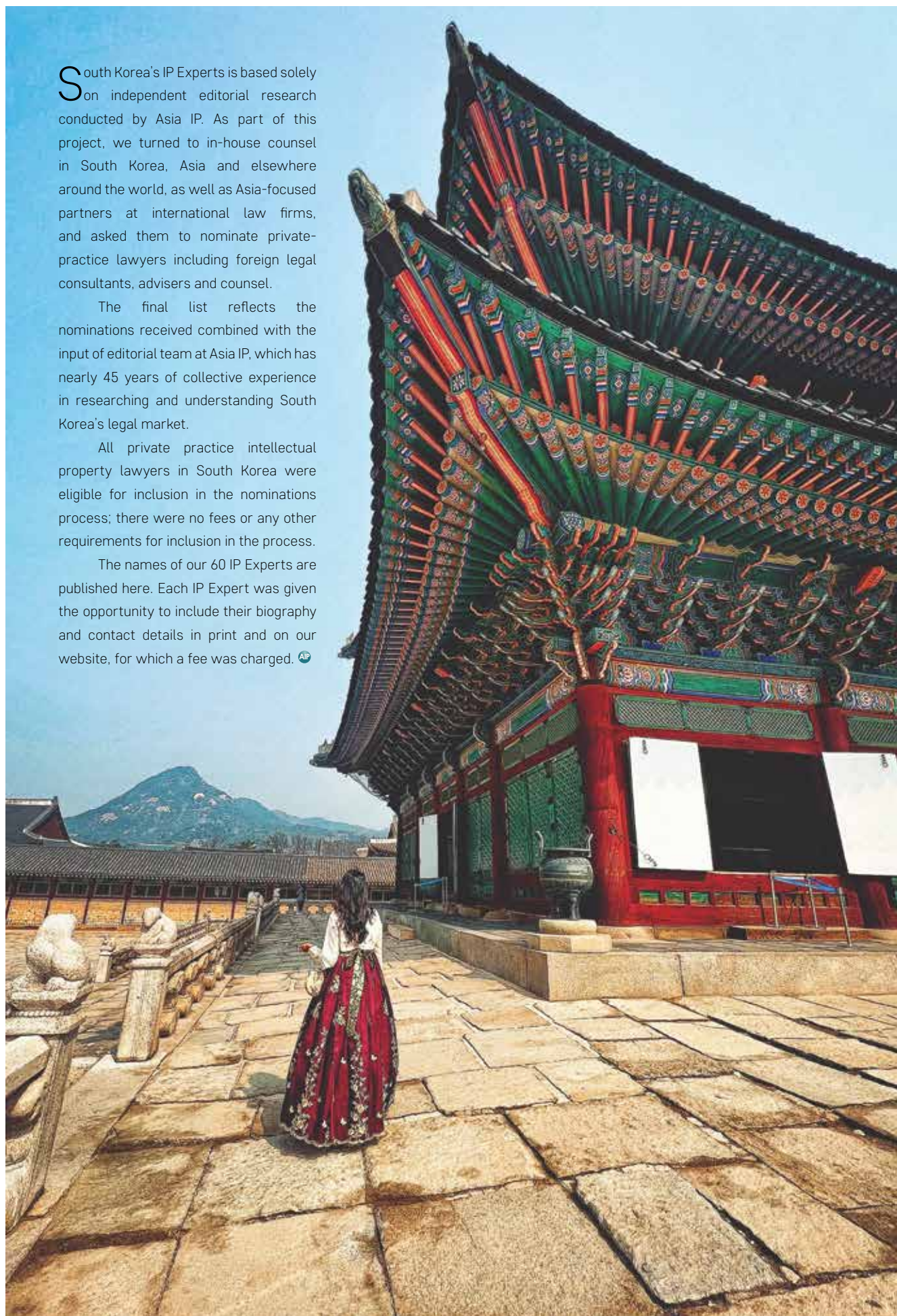


South Korea's IP Experts is based solely on independent editorial research conducted by Asia IP. As part of this project, we turned to in-house counsel in South Korea, Asia and elsewhere around the world, as well as Asia-focused partners at international law firms, and asked them to nominate private-practice lawyers including foreign legal consultants, advisers and counsel.

The final list reflects the nominations received combined with the input of editorial team at Asia IP, which has nearly 45 years of collective experience in researching and understanding South Korea's legal market.

All private practice intellectual property lawyers in South Korea were eligible for inclusion in the nominations process; there were no fees or any other requirements for inclusion in the process.

The names of our 60 IP Experts are published here. Each IP Expert was given the opportunity to include their biography and contact details in print and on our website, for which a fee was charged. 





CONSUMER INTEREST

In trademark litigation, are consumers the missing party?

There is a growing belief that the consumer is a crucial third party missing from the courtroom. *Espie Angelica A. de Leon* discusses how consumer interest is at stake in trademark litigation and the various ways countries address consumer interest within their legal framework.

In trademark litigation, there are two parties: the trademark owner who is the plaintiff, and the alleged infringer who is the defendant.

Some members of the legal community believe there's a third party missing in the courtroom. This missing entity is none other than the consumer.

What role should the consumer play in a trademark courtroom proceeding? In trademark litigation, consumer interest including public health is at stake. What is being addressed and fought for is not only the plaintiff's right but those of the consumers or public interest as well. Hence, the consumer is the missing third party in trademark litigation.

Justice Prathiba M. Singh of the Delhi High Court in India, expressed this belief in one of the sessions held during the 2023 INTA Annual Meeting in Singapore

from May 16 to 20, 2023. The session was titled "Delhi High Court Intellectual Property Division (IPD) – The Journey and the Way Forward," which Singh moderated.

"It is crucial to recognize the vital role of consumer interests, even though they may not actively participate in the courtroom proceedings," said Singh. "Consumers hold a significant position in trademark law as trademarks aim to protect them from confusion and deception in commercial transactions. Recent disputes show that due to use of illegal domain names consisting of well-known marks, innocent consumers are duped of substantial sums of money."

Touching on public health, Singh cited counterfeit medications as having a consumer interest angle. The same goes for counterfeiting food products and automobile parts.

In what ways do trademark laws and litigation in countries around the region protect consumer or public interest? Do IP lawyers and attorneys in Asia agree that the consumer should be the third party in a trademark court proceeding? We interviewed some of them for their reaction and for pertinent information on trademark laws in India, Taiwan, the Philippines, Singapore and Vietnam.

India

In 2022, the Delhi High Court Intellectual Property Rights Division Rules, 2022 (the IPD Rules), and the High Court of Delhi Rules Governing Patent Suits, 2022 were issued.

According to Singh, this signifies a proactive approach in addressing concerns pertaining to the protection of public interest in IP enforcement.

Among the provisions under the IPD Rules is Rule 25. “Allowing third parties to intervene in IP-related matters ensures that the perspectives and interests of the public are taken into account. It allows individuals or organizations with a legitimate interest in the case to participate in the proceedings, contributing their insights and concerns,” said Singh.

Another is Rule 26, which consolidates multiple proceedings related to the same or similar IP rights subject matter. This provision, therefore, allows disputes to be resolved in a more streamlined and efficient manner, avoiding duplicative processes and potentially conflicting outcomes. “By avoiding unnecessary delays and reducing litigation burdens, the public’s interest in timely and fair resolution of IP matters is protected,” explained Singh.

Rule 27 also helps safeguard consumer interest by enabling the court to issue a judgement without a full trial. This allows the court to save time and resources, thus catering to public interest as it avoids prolonged legal battles and promotes timely access to IP rights.

Meanwhile, Rule 36 ensures that the IPD proceedings are accessible to all by requiring filings to be in a specific format and providing for reasonable accommodations for individuals with disabilities. “By setting standards for accessibility and accommodating the needs of individuals with disabilities, the public’s interest in fair and inclusive participation in IP enforcement is protected,” noted Singh.

As to public health, Singh cites *Cadila Health Care v. Cadila Pharmaceuticals*. Cadila Health Care accused Cadila Pharmaceuticals of trademark infringement because the latter used a name and logo similar to theirs. The Supreme Court ruled in favour of the former and ordered the latter to stop using the name and logo.

“The court held that in the case of trademarks for medicinal products, a lower standard of proof is required to establish confusing similarity due to the potential life-threatening consequences of confusion,” said Singh. “The need for clear indicators to differentiate medicinal products is crucial, considering the vulnerability of patients and the risks involved in their usage.”

Taiwan

Gary Kuo, a partner at Winkler Partners in Taipei, agreed that the consumer should be the third party inside the courtroom during trademark litigation.

According to Kuo, the Taiwan Trademark Act explicitly states that it aims to protect consumer interests. When reviewing trademark disputes, Taiwan courts and the Taiwan Intellectual Property Office consider the interest of consumers as to, for example, whether there is actual consumer confusion and the consumers’ familiarity with the disputed trademarks. Yet, the trademark act does not provide consumers with legal rights against the trademark infringer.

“For example, if an infringer imported numerous counterfeit kitchen tools in Taiwan and many consumers bought the counterfeits due to misidentification and confusion, the brand owner of the kitchen tools could initiate a court action against the infringer who sold counterfeits on the market,” said Kuo. “In this case, the party who suffers losses is not only the brand owner but also the consumers who were cheated into buying counterfeits.”

However, consumers cannot claim damages against the infringer under the trademark act. Although consumers can claim damages based on other remedies such as torts, Kuo explained they have to initiate another action and would not be able to solve their disputes with the infringer in the same trademark litigation. In addition, consumers do not have a voice in trademark courtroom proceedings; hence, they cannot relate to the court how fraud, as committed by the infringer, misled them into buying the counterfeit products.

To better serve consumer interest or public interest in Taiwan, Kuo said: “Given that consumers cannot act as a plaintiff under current laws, giving consumers a position in the courtroom might be a good way to bring the consumers’ voices into trademark litigation, where consumers’ views should be a crucial element. This would enable the court to consider factors related to consumer rights – such as actual consumer confusion – with a more direct and authentic source of information.”

He added: “In terms of substantive rights, we can consider granting consumers the right to seek compensation from counterfeit sellers based on the trademark act. Taiwan’s Consumer Protection Act provides consumer advocacy groups with the right to file class actions on behalf of consumers.”

These advocacy groups have websites containing notices of infringement cases on consumer rights. Through these notices, affected consumers are encouraged to join in the class actions. The problem is that most of the cases mentioned in these notices are about traditional consumer rights, such as food safety, rather than counterfeits.

“We believe that if consumers were granted more rights under the trademark act, we might see consumers filing class actions against large-scale counterfeit sellers for compensation in the future,” said

"Consumer interests must not be the 'be-all, end-all' of trademark laws. Trademark laws must also accord sufficient protection to a proprietor against unfair competition from third parties who seek to free ride on the goodwill or reputation that the proprietor has acquired for his goods or services."

—**DARREN LEONG**, associate, Baker McKenzie Wong & Leow, Singapore

"We believe that a streamlined legal procedure focusing primarily on the trademark owner and alleged infringers would result in a more targeted and efficient resolution of the dispute. We should concentrate on promoting our enforcement team and tight management to prevent counterfeit merchandise from circulating on the market."

—**YEN VU**, principal and country manager, Rouse Legal Vietnam, Ho Chi Minh City

"An essential element to ground an infringement of a registered trademark action under Singapore's Trade Marks Act is the likelihood of consumer confusion. The common law tort of passing off also requires misrepresentation of the consumers before a cause of action can be made out."

—**REN JUN LIM**, principal, Baker McKenzie Wong & Leow, Singapore



"It is crucial to recognize the vital role of consumer interests, even though they may not actively participate in the courtroom proceedings. Consumers hold a significant position in trademark law as trademarks aim to protect them from confusion and deception in commercial transactions."

—**PRATHIBA M. SINGH**, Delhi High Court, India

"The primary concern in trademark law is to protect the trademark licensee's rights, which includes the right to use a trademark, the right to sell a product or service using the trademarks, right to use a trade name, and ultimately ensure that their brand is not diluted or misrepresented."

—**MARY WENDY DURAN**, founding senior partner, Duran & Duran-Schulze Law, Manila

"Given that consumers cannot act as a plaintiff under current laws, giving consumers a position in the courtroom might be a good way to bring the consumers' voices into trademark litigation, where consumers' views should be a crucial element."

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Kuo. “This would not only provide greater protection for consumer rights but also result in stricter penalties for counterfeit sellers.”

The Philippines

Trademark litigation proceedings in the Philippines also do not allow active participation from consumers as a third-party litigant.

Mary Wendy Duran, founding senior partner at Duran & Duran-Schulze Law in Manila, believes that allowing consumers to actively participate in trademark litigation would be highly beneficial. A more comprehensive understanding of the case will be laid out by sharing their experiences and voicing their concerns and expectations in a courtroom proceeding. Consequently, it will lead to a more balanced and informed decision-making process for all parties involved.

However, because consumers do not have direct ownership or legal rights over a trademark, she also believes consumers’ participation and presence in trademark litigation must be restricted. “The limitation stems from the nature of trademark disputes. The primary concern in trademark law is to protect the trademark licensee’s rights, which includes the right to use a trademark, the right to sell a product or service using the trademarks, right to use a trade name, and ultimately ensure that their brand is not diluted or misrepresented,” explained Duran.

The silver lining is that the Philippines’ 2020 Revised Rules of Procedure for Intellectual Property Rights Cases now allows the presentation of market survey reports to prove whether the disputed mark may indeed cause confusion among consumers and its significance to the public. Market survey reports contain data gathered from consumers regarding their perception, association or affiliation between two similar brands or trademarks and whether the similarity has caused them to be confused.

The surveys also shed light on consumer understanding of the trademarks involved, which can be crucial in establishing potential harm to the rightful trademark owner. By analyzing the consumer responses, she said experts and the trademark court can determine whether there is a likelihood of confusion or deception among consumers.

She added: “In the consolidated cases of *Ginebra San Miguel v. Director of the Bureau of Trademarks and Tanduay Distillers v. Ginebra San Miguel* decided on August 9, 2022, the court held that these consumer surveys are reliable, credible and significant, and that the survey methodology, the sampling size undertaken and the resulting empirical data were sufficient to establish the state of public perception with respect to the term GINEBRA.”

To better protect consumer or public interest in the Philippines, Duran believes the legal system should increase transparency and accessibility of case-related information by publishing case summaries or judgments online. This will help make such information

accessible to members of the public who may want to know the outcome and details of these court cases.

Another possible measure, according to her, is to provide clear guidelines for reporting potential infringement cases by consumers or for voicing their concerns regarding trademarks.

Singapore

For Ren Jun Lim, principal at Baker McKenzie Wong & Leow in Singapore, it isn’t necessary for the consumer to be the third party inside the courtroom during trademark litigation.

According to him, Singapore’s Trade Marks Act grants trademark rights only to trademark proprietors and licensees. Meanwhile, consumers are not represented in court. However, Lim noted that consumers are not completely unrepresented, and public interest is not set aside. In fact, “consumer interests are explicitly considered in the act.”

“For example, an essential element to ground an infringement of a registered trademark action under Section 27(2) of the act is the likelihood of consumer confusion,” said Lim. “The common law tort of passing off also requires misrepresentation of the consumers before a cause of action can be made out.”

“Such representation of consumer interest in the court in the likelihood of confusion or misrepresentation may be in the form of written evidence, such as a market research and/or survey, or the average consumer may also be called as a witness to provide his or her oral testimony in court,” said Lim’s colleague, Darren Leong, an associate at the firm.

To begin with, a trademark cannot be registered in Singapore if it is contrary to public policy or morality. Also, the exclusivity of trademark rights granted to the proprietor is limited by certain defences.

“For example, fair use of a registered trademark in comparative commercial advertising is allowed in Singapore, which allows new entrants to compare its goods and/or services with an incumbent so as to improve information asymmetry between the consumer and brand owners, so long as the public is not mistaken into thinking that the new entrant is associated with the incumbent,” explained Leong.

Still, Lim and Leong stressed that positive rights are only granted to trademark owners, including the right to bring an action for infringement of a registered trademark. Hence, consumers must not inadvertently be provided with more rights than what they are entitled to under Singaporean law.

Lim claimed allowing the consumer as a third party inside the courtroom during trademark litigation runs the risk of doing just that. He cautioned against going further as “a balance has already been struck” by allowing consumer interests to be factored into any trademark litigation indirectly.

“Consumer interests must not be the ‘be-all, end-all’ of trademark laws,” said Leong. “Trademark laws must also accord sufficient protection to a proprietor against unfair competition from third parties who



seek to free ride on the goodwill or reputation that the proprietor has acquired for his goods or services.”

Vietnam

Yen Vu, principal and country manager of Rouse Legal Vietnam in Ho Chi Minh, agreed that consumers should not be involved as third parties in trademark litigation.

First, the plaintiff already effectively represents consumer interests in a trademark litigation by endeavouring to prevent confusion and deception among the public.

Second, getting consumers involved in trademark court proceedings will lead to issues. According to Vu, consumers are a large group of undefined individuals. To bring about their representation in trademark litigation, additional resources, costs and efforts are required in connection with the additional procedures and evidence needed.

“We believe that a streamlined legal procedure focusing primarily on the trademark owner and alleged infringers would result in a more targeted and efficient resolution of the dispute,” said Vu. “We should concentrate on promoting our enforcement team and tight management to prevent counterfeit merchandise from circulating on the market.”

Instead, Vietnam has regulations in place to protect consumer or public interest.

One of these is Article 73.5 or Article 130 of IP Law 2005, which addresses false advertising and misrepresentation, thus safeguarding consumer rights.

Another is Article 112 of IP Law 2005, which regulates the third-party observation as a mechanism allowing interested parties, such as competitors, consumer groups or any concerned individuals, to voice their concerns or objections about a trademark application. “It also provides a means for the public to contribute valuable information to the trademark examination process, which can assist the trademark office in making informed decisions,” said Vu.

Furthermore, Article 112a of IP Law 2005 allows any person to have the right to oppose the grant of certificate of protection. “This opposition process is an


essential part of the trademark registration system in Vietnam, allowing the public to assert their concerns or raise objections before the trademark is officially granted protection. The fundamental difference between the third-party observation and opposition mechanism is the time limit given to the third-party,” explained Vu.

To determine if there is consumer confusion or if a trademark has acquired secondary meaning, Vu said they consider undertaking consumer market surveys and other indirect engagement initiatives with consumers. Such measures help protect consumer or public interest.

According to her, several consumer protection associations were established in Vietnam in compliance with the Law on Consumers Protection. Unfortunately, these associations haven’t been active, and lack of funds hound the group. To begin with, they do not charge membership fees. She suggested that the government should “seriously consider providing financial funding for consumers’ associations.”

Vu proposed that trademark owners join these associations through financial sponsorship, which will help ensure sufficient resources, and via collaboration for consumer protection campaigns. “This may involve sharing information about trademark infringements and fake – genuine identification. This collaboration can help identify and combat counterfeit products, unauthorized use of trademarks and other violations, ultimately safeguarding the brand’s integrity,” she said.

IP lawyers and attorneys in Asia have different views on the extent of consumers’ involvement in trademark litigation. Nevertheless, in recognition of the importance of consumer interest, including public health, their countries’ laws are protective of consumer rights in different and sometimes similar ways and measures.

While there may be disagreement over whether consumers should be the third party in trademark litigation, the overriding thought is that public interest should be at the core of trademark law. 

IP EXPERTS 2023

Israel

In July 2023, Israel's Knesset passed into law a bill seeking to promote investment in Israel's high-tech and innovation industry. The law aims to both keep home-grown companies in Israel, rather than turning overseas after a period of growth, and to make the country more attractive to major corporations to open offices in Israel.

A report about the new law by *The Jerusalem Post* says that the high-tech industry has been the driving factor of growth in Israel's economy over the last few

decades, now consisting of 15 percent of GDP and 50 percent in total exports. "Amid the first legislation of the judicial reform passed, a new study was published that showed increasing fears of companies shifting their bases abroad. While troubling, the case of companies relocating is nothing new; the United States is already home to 88 Israeli-founded unicorns (companies valued at more than \$1 billion)," the newspaper reported.

"For this reason," the story says, "lawmakers and government high-tech offices have made it a top



priority to remove some of the burdens stifling growth, and to work to encourage internal corporate maturity in the country – particularly in companies whose intellectual property and main business activity is happening in Israel.”

Two main aspects of the bill include the postponement of the payment of capital gains taxes, assuming the funds are invested in start-up companies. The bill also provides a tax credit for those who invest in start-ups. The bill’s second main aspect allows for investments to be considered as expenses for large international corporations who buy controlling shares of high-tech companies in the country, while also allowing for the cost to spread over five years, thereby reducing their tax burden. This makes Israeli start-ups more attractive for would-be buyers, the *Post* reported.


Ofir Akunis, who heads Israel’s Innovation, Science, and Technology Ministry, applauded the law’s passing, saying that “the approval of the law is huge news for Israeli high-tech.” He added that “the purpose of the law is to remove barriers and encourage the establishment and growth of Israeli high-tech companies. I believe this law can herald the beginning of a turning point in the high-tech industry.”

It is with efforts like this in mind that we turned to IP professionals in the region in order to understand better what clients are looking for from today’s IP

lawyer. *Asia IP* asked a large number of professionals – mostly in-house counsel and corporate legal managers – what they were looking for from their legal service providers. From their answers, we have compiled our inaugural list of Israel’s 50 IP Experts, those lawyers who understand just what their clients need and are able to provide them with the best practical advice.

One of the country’s largest legal groups dominates the list: The Reinhold Cohn Group, which includes lawyers from Reinhold Cohn & Partners and Gilat Bareket & Co., placed seven lawyers on the list. Other large firms in Israel also fared well: Cohn de Vries Stadler & Co. and S. Horowitz & Co. each placed three lawyers on the list, while a number of firms placed two, including Adin Liss Pyernik; Drori-Stav & Co.; Ehrlich Group; Fisher Friedman IP Group; Glazberg, Applebaum & Co.; Gornitzky & Co.; Herzog Fox & Neeman; Pearl Cohen Zedek Latzker Baratz; Shalev Jenemen & Co.; and The Luzzatto Group.

Most of the lawyers named to our list have multiple practice specialties. Many of them are litigators, while others concentrate on prosecution work or provide strategic advice.

All of them have something in common: they are experts in their fields and, in one way or another, they provide extra value for their clients. They are *Asia IP*’s Israel IP Experts.—GREGORY GLASS 



ISRAEL IP EXPERTS TOP 50


NAME	FIRM	PATENTS	TRADEMARKS	COPYRIGHT	ENFORCEMENT	LICENSING & FRANCHISING	MEDIA & ENTERTAINMENT	IT & TELECOMS	PHARMA & BIOTECH	IP LITIGATION
Dan Adin	Adin Liss Pyernik	✓	✓	✓	✓					✓
Dovev Apel	S. Horowitz & Co.	✓	✓	✓	✓	✓	✓	✓	✓	✓
Nadav Applebaum	G&A Glazberg, Applebaum & Co.	✓	✓		✓	✓				✓
Tal Band	S. Horowitz & Co.	✓	✓	✓	✓	✓	✓		✓	✓
Eran Bareket	Gilat Bareket & Co (Reinhold Cohn Group)	✓	✓	✓	✓				✓	✓
Ronit Barzik-Soffer	Reinhold Cohn & Partners		✓							✓
Adar Bengom	Herzog Fox & Neeman	✓	✓			✓				
Luiz Blanc	Gilat Bareket & Co (Reinhold Cohn Group)		✓	✓		✓				✓
Shlomo Cohen	Dr. Shlomo Cohen & Co.	✓	✓	✓	✓	✓				✓
Ilan Cohn	Cohn de Vries Stadler & Co.	✓	✓	✓		✓				
David de Vries	Cohn de Vries Stadler & Co.	✓							✓	
Yonatan Drori	Drori-Stav & Co.	✓	✓		✓			✓		✓
Gal Ehrlich	Ehrlich Group	✓					✓	✓	✓	
Karen Elburg	Herzog Fox & Neeman	✓	✓		✓	✓	✓			
Michal Fisher	Fisher Friedman IP Group	✓	✓		✓					
Nathalie Friedman	Fisher Friedman IP Group	✓							✓	
Ehud Gabrieli	Seligsohn Gabrieli & Co.	✓		✓	✓		✓			✓
Shirley Gal	Gornitzky & Co.	✓	✓					✓	✓	
David Gilat	Gilat Bareket & Co (Reinhold Cohn Group)	✓	✓	✓				✓	✓	✓
Ziv Glazberg	G&A Glazberg, Applebaum & Co.	✓	✓		✓	✓				✓
Tony Greenman	Tony Greenman Law Offices		✓	✓			✓	✓		✓
Ehud Hausman	Reinhold Cohn & Partners	✓						✓		
Avi Jencmen	Shalev Jencmen & Co.	✓						✓		
Asa Kling	Naschitz Brandes Amir	✓		✓		✓			✓	✓
Roy Kornick	Gilat Bareket & Co (Reinhold Cohn Group)		✓	✓	✓					✓
Eran Liss	Adin Liss Pyernik	✓	✓	✓	✓	✓		✓		✓
Richard Luthi	Luthi & Co. (CDS-LUTHI Group)	✓	✓	✓				✓	✓	✓
Kfir Luzzatto	The Luzzatto Group	✓							✓	✓
Michal Luzzatto	The Luzzatto Group	✓	✓	✓			✓	✓		
David Mirchin	Meitar Law Offices	✓	✓	✓	✓	✓	✓	✓	✓	
Yehuda Neubauer	Ehrlich Group	✓						✓	✓	✓
Gail Opinsky	Lipa Meir & Co.	✓	✓	✓	✓			✓		✓
Avi Ordo	S. Horowitz & Co.	✓	✓	✓	✓	✓	✓	✓	✓	✓
Zeev Pearl	Pearl Cohen Zedek Latzer Baratz	✓				✓		✓	✓	✓
Rakefet Peled	Gilat Bareket & Co (Reinhold Cohn Group)		✓	✓	✓					✓
Sa'ar Plinner	Goldfarb, Gross Seligman		✓	✓	✓		✓	✓		✓
Eyal Price	Goldfarb, Gross Seligman		✓	✓	✓		✓			✓
Allen Richter	Richter & Shimoni	✓	✓					✓	✓	
Jeremy Rutman	Rutman IP	✓						✓		
Asaf Shalev	Shalev Jencmen & Co.	✓						✓		
Eitan Shaulsky	Sanford T. Colb & Co.	✓	✓	✓	✓				✓	✓
Gila Shimoni-Elhanati	Richter & Shimoni	✓							✓	
Eran Soroker	Soroker Agmon Nordman	✓	✓	✓	✓					✓
Svetlana Stadler	Cohn de Vries Stadler & Co.	✓			✓			✓	✓	
Iyar Stav	Drori-Stav & Co.	✓	✓	✓			✓			✓
Cynthia Webb	Webb + Co.	✓							✓	
Aline Wekselman	Gornitzky & Co.		✓	✓	✓					✓
Liad Whatstein	Liad Whatstein & Co.	✓	✓	✓	✓				✓	✓
Neil Wilkof	Dr. Eyal Bressler & Co.		✓			✓		✓		
Dor Cohen Zedek	Pearl Cohen Zedek Latzer Baratz		✓		✓					



Israel's IP Experts is based solely on independent editorial research conducted by *Asia IP*. As part of this project, we turned to in-house counsel around the world, as well as Middle East-focused partners at international law firms, and asked them to nominate private-practice lawyers including foreign legal consultants, advisers and counsel.

The final list reflects the nominations received combined with the input of editorial team at *Asia IP*, which has nearly 45 years of collective experience in researching and understanding legal markets in the Middle East.

All private practice intellectual property lawyers in Israel were eligible for inclusion in the nominations process; there were no fees or any other requirements for inclusion in the process.

The names of our 50 IP Experts are published here. Each IP Expert was given the opportunity to include their biography and contact details in print and on our website, for which a fee was charged. 





THE NEUROTECHNOLOGY AND DATA PRIVACY INTERFACE

While neurotechnology is a step toward innovation in the field of brain research, *Espie Angelica A. de Leon* also explains the concerns regarding data privacy and protection that come with it.

In 2016, Elon Musk entered the world of neurotechnology when he launched Neuralink Corporation with a team of scientists and engineers. The California-based company aims to develop implantable brain-computer interfaces (BCIs) to connect a computer directly with the human brain.

“The idea is, through painless surgery, to implant very thin wires about five microns in diameter into the cerebral cortex to obtain and send information,” explained Sudeep Chatterjee, a partner at Singh & Singh in New Delhi. The objective is cognitive enhancement.

That same year, American entrepreneur Bryan Johnson founded Kernel and developed a prototype of a non-invasive brain interface based on near-infrared spectroscopy with a team of neuroscientists, engineers and physicists. According to the company’s website, Kernel has built “unparalleled technology for non-invasively measuring the brain with the goal of making precision neuroscience the standard.”

Neurotechnology, or neurotech, has been around for almost half a century. It is a technology for analyzing human brain activity, recording signals emanating from the organ and manipulating brain or nervous system functions, done via invasive and non-invasive means. For invasive neurotechnology, implants may be

placed within the brain, on the dura, under the scalp or through the blood vessels, etc. Meanwhile, non-invasive methods use wearables or tools that may be worn, such as headbands, watches and helmets.

Neurotech is already widely used in the medical world, where experts have been tapping the technology for treating mental, neurological, sensory and movement-related disorders. It scored its first breakthrough with the emergence of brain imaging technology using magnetic resonance imaging (MRI) scans.

Beyond its medical applications, neurotech also has the potential for practical applications in other areas. These include education, sports, national security and consumer devices.

Implications on data privacy and protection

Neurotechnology may sound like rocket science, but it doesn’t take a genius to realize it has implications for data privacy and protection. Neuroscience data produced by neurotech applications can be personally identifiable, according to Manh Hung Tran, managing lawyer at Baker McKenzie in Hanoi.

“For instance, a brain MRI image demonstrates the brain’s unique structure that can single out

whom the data pertains to,” he explained. “Analysis of neuroscience data can also uncover one’s health condition or predict the risk of future diseases. Studies have also shown that neurotech can decode mental contents in the brain and predict future behaviors such as criminal propensity.”

He added: “To this extent, neurotech poses challenges not only to personal data protection but also to mental integrity and freedom of thought at large.”

In addition, the collection, use and disclosure of data acquired from neurotech is subject to similar risks and vulnerabilities as other types of data. These include data reuse, the risk of re-identification of data and hacking.

On top of these, neuro data is subject to the risk of disclosing more information than needed, as neuro data doesn’t just pertain to names, addresses and other basic information, which typify other data sets. Neurotechnology can also make the processing of involuntary brain activity possible.

According to Andy Leck, principal and head of IP and technology at Baker McKenzie Wong & Leow in Singapore, neuro data has two main characteristics that set it apart from other data types. One of these characteristics is its volatile nature.

“Neuro data does change based on the age of an individual, the environment the individual is in, and even the mood of the individual at that juncture as compared with the other types of data sets that typically remain constant and consistent for a period of time,” he said.

The second characteristic is its unique depth and form of insight into an individual.

“As to what we mean by ‘unique depth and form of insight into an individual,’ our understanding is that studying brain activity can reveal a significant amount of information about an individual that would otherwise not be accessible, such as their personality, cognitive abilities and state of health,” explained Leck, adding that such information may be more than what is necessary for collecting the data.

Citing the various types of wearables in the market that analyze neuro data, he said the purpose for analyzing such data also varies. For example, Dreem offers wearables for sleep monitoring to enhance deep sleep quality while BrainCo offers wearables to provide instant feedback about one’s mindset.

“Even if the data collected is only used to analyze a particular trend such as sleep, the same collected set of data may arguably reveal other types of trends as well if the technology or algorithm used to analyze the data changes,” he said. “The risk profile when collecting, using and disclosing neuro data increases from a data privacy and protection perspective due to these two main characteristics.”

According to Chatterjee, each technique of neurotechnology will have implications and potential to pose significant risks to data privacy and protection. BCIs could potentially capture sensitive information about a person’s thoughts, emotions and intentions, which could be misused and exploited.

“For example, data consisting of human memories that are captured may eventually be admissible in court as neuro-evidence,” he said.

There is also the risk of neurotechnological devices remotely accessing neural data directly and storing such information without reference to or consent of the data source.

“This leads to concerns regarding the downstream and other uses of such data, especially as it may be possible to modify or interfere with neural data,” said Stanley Lai, partner and head of IP practice at Allen & Gledhill in Singapore.

Lai added: “For example, the Bioethics Advisory Committee in Singapore has expressed concerns that brain intervention may lead to physical disabilities or changes in cognition, emotion and even personality. The committee has also expressed that research into neurodegenerative diseases also comes with its attendant risks, including the practical difficulty of obtaining informed consent for using neural data from research participants who may be suffering from neurological or psychiatric disorders.”

Legislating neurotechnology

According to Tran, the jurisdiction’s data privacy and protection laws are broad enough to cover neurotechnology. Neurotech will be brought under the Vietnamese administration when it collects and processes personal data.

“Future legislation will also define certain types of personal data, including data on unique physical and biological characteristics. As sensitive data subject them to a higher protection threshold to the extent that neurotechnology poses a threat to one’s private life and secrets, the laws on personal privacy are in place to regulate,” he explained.

However, in the past few years, Tran said that concerns on privacy intrusion in connection with neurotechnology have only been sporadically elaborated on in Vietnam.

Meanwhile, neurotech in India is still a bit foreign, said Chatterjee.

“There is no specific law or regulation in India that governs the use of neurotechnology,” he revealed. “However, there are certain existing law and regulations that can be interpreted to include the governance of neurotechnology.”

One of these is the Right to Privacy verdict, a landmark decision of the Supreme Court of India in *Justice K.S. Puttaswamy & Anr. v. Union of India & Ors.* In this context, Chatterjee said two aspects of the right to privacy become important: informational privacy and informational self-determination.

He explained: “Informational privacy is concerned with an individual’s mind and body. According to Puttaswamy, the mind is an inseparable component of an individual’s personality, and the sanctity of the mind is the very foundation of one’s right to privacy. Therefore, the right to informational privacy exists to promote individual autonomy by protecting one’s mind from the dissemination of personal information.

As a result, any technology that interferes with one's thoughts violates these liberties."

In addition, the Information Technology Rules, 2011, and the proposed Digital Personal Data Protection Bill, 2022, by the Ministry of Electronics and Information Technology provide the said personal information, including biometric data, health information, genetic data and other sensitive information. Organizations are also required to obtain consent from individuals before collecting, processing and storing their personal information.

"We will need a proper and separate framework and laws to regulate the usage of the emerging technology of neurotechnology," said Chatterjee. "But until then, the present laws could be interpreted in a way that may be able to protect data that could be collected from neurotechnology."

However, a problem remains. Chatterjee explained that although the Digital Personal Data Protection Bill, 2022, defines personal data, it is uncertain if neural data can be included in its scope.

The concept of neurotechnology still remains largely

foreign in the country, but activities in certain areas of neurotech are perceived to be seen in India soon. These are BCIs – neuroimaging used to study the brain, check its health and diagnose diseases; and neuromodulation, which focuses on nerve activity. Research initiatives on transcranial magnetic stimulation and transcranial direct current stimulation, two neuromodulation techniques, are currently being undertaken as potential treatments for certain neurological disorders.

In Singapore, neurotech is still a growing and expanding field, but there is a lot of interest in it. Universities, pharmaceutical companies and healthcare institutions are actively interested in harnessing neurotech for medical or clinical use, according to Lai. SingHealth, for example, reported in 2017 that neurotechnological treatments such as deep brain stimulation treat neurodegenerative diseases such as Parkinson's disease and dementia.

Additionally, the National Neuroscience Institute and the Singapore Institute for Neurotechnology websites indicate that these institutions research nascent technologies such as brain stimulation,

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—STANLEY LAI, partner and head of IP practice, Allen & Gledhill, Singapore

"Studies have shown that neurotech can decode mental contents in the brain and predict future behaviors such as criminal propensity. To this extent, neurotech poses challenges not only to personal data protection but also to mental integrity and freedom of thought at large."

—MANH HUNG TRAN, managing lawyer, Baker McKenzie, Hanoi

"As to what we mean by 'unique depth and form of insight into an individual,' our understanding is that studying brain activity can reveal a significant amount of information about an individual that would otherwise not be accessible, such as their personality, cognitive abilities and state of health."

—ANDY LECK, principal, head of IP and technology, Baker McKenzie Wong & Leow, Singapore

"We will need a proper and separate framework and laws to regulate the usage of the emerging technology of neurotechnology. But until then, present laws could be interpreted in a way that may be able to protect data that could be collected from neurotechnology."

—SUDEEP CHATTERJEE, partner, Singh & Singh, New Delhi



BCIs, neuroimaging, stem cell therapy and neuro-pharmaceuticals.

As for laws, the Singapore Personal Data Protection Act (PDPA) could potentially regulate neurotechnology from the perspective of data privacy and protection.

However, Leck said there is a lack of clarity on how the definitions and concepts in the PDPA would apply to neuro data and how organizations will use reasonable efforts to ensure that neuro data collected is accurate and complete. This obligation is premised on the basis that a data set stays constant and consistent for some time.

While neuro data does change, neuro data collected at a particular juncture will almost always be accurate and complete. However, if the neuro data collected stems from a false memory or a lie, it is unclear if this compromises the accuracy of the collected neuro data.

It also remains unclear how organizations will deal with “correction requests” related to neuro data and the “reasonable grounds” for an organization to reject a correction request.

“It is unclear because neuro data collected at a particular juncture will almost always be accurate and complete, albeit some neuro data collected may stem from a false memory or a lie,” explained Leck.

A gray area also arises to the question of when neuro data is considered “anonymized” to fall outside the scope of the PDPA as compared with other datasets, which are more clear-cut.

Leck noted: “While the link to an identifiable individual can be removed, like redacting or deleting the individual’s name from the file, and may not be considered personal data, the nature of the data in itself is still unique in representing a specific individual.”

Another question is whether neural data constitutes personal data and, if so, to what extent.

“The PDPA requires organizations to notify and obtain consent for collecting, using and disclosing personal data, which must be for reasonable purposes,” said Lai. “The PDPA defines personal data as data, whether true or not, about an individual who can be identified from that data on its own or together with other information to which the organization is likely to have access.”

He added: “Within the construct of the PDPA, there may be practical difficulties associated with collecting neural data only for specific reasonable purposes, as neurotechnology may not be sophisticated to collect only specific purpose-limited categories of neural data. The consent regime may also have to be refined to clear obligations under the PDPA.”

According to Lai, the risks of unauthorized collection, future uses, collections and disclosure of neural data are likely to become increasingly prevalent because neurotechnology is rapidly developing and is gaining more awareness. Thus, he believes existing legislation may have to be further reviewed to ensure adequate safeguards are in place.

If this is not undertaken, organizations, data processors and data collectors may be “tempted into obtaining broad-ranging consents from data subjects to

manage compliance risk under data protection laws.”

“Further clarity on how the definitions and concepts used in the PDPA would apply to neuro data – by way of the Personal Data Protection Commission’s advisory guidelines similar to the Guide on the Responsible Use of Biometric Data in Security Applications – would be appreciated,” added Leck. “Neural data specific laws and regulations may have to be further enacted to address express or implied obligations in this field of endeavour.”

Neurotech and the future

Neurotechnology broke new ground in medicine with the emergence of brain imaging using MRI scans. Brain imaging using MRI scans brought significant advancements to medicine through neurotechnology.

A more recent groundbreaking development took place in July 2022 when Synchron, a leading New York-based implantable brain-computer interface company, implanted its flagship innovation called the Stentrode in a human patient for the first time at Mount Sinai West hospital.

The Stentrode is an endovascular brain implant developed for severe paralysis patients. The technology allows the patients to control and use their gadgets for texting, emailing, online shopping and more in a wireless environment, using only their thoughts. It does not need open-brain surgery like other BCIs. Instead, an approximate two-hour minimally invasive surgery is all it would take for the implantation.

It was the first clinical trial in the U.S. for the brain implant.

Meanwhile, Neuralink conducted trials on animals. In April 2021, the company released a clip showing a monkey with a brain implant playing the Pong video game.


“Companies are already thinking about ways to use our brain data to market ads to us. For instance, Facebook has already invested in this neurotechnology,” said Chatterjee.

Developments are also happening as far as legislating neurotechnology is concerned.

In Chile, these positive developments started in 2021 when the Senate approved a bill seeking to include “neuro rights” in the constitution. That same year, Chile’s Chamber of Deputies approved the amendment to the country’s constitution. Once the president signs the bill into law, Chile will become the first country to have neuro rights as part of its constitution.

Chile is also mulling a constitutional reform to amend Article 19 of the Magna Carta to protect the brain from neurotechnology.

Somewhere in the interface between neurotech, data privacy and protection, there is a huge disconnect. As with other modern technologies, neurotech is rapidly making huge strides, but laws and regulations on neuro rights and data privacy haven’t caught up with this remarkable progress.

However, Chile seems to lead the way in this regard. Other jurisdictions should well follow suit. 

IP EXPERTS 2023

Singapore

When it comes to promoting and protecting intellectual property, there has probably never been a government quite like that of Singapore.

While IPOS, the Intellectual Property Office of Singapore, largely takes the lead in promoting Singapore not only as a global IP hub, but also as an international hub for technology and IP dispute resolution, it is strongly aided by other ministries, including the Ministry of Finance, the Ministry of Trade and Industry and many other government agencies.

Singapore is a preferred filing destination for patent, trademark and design applications. Filers understand that the rule of law is paramount in Singapore, in part because of heavy promotion by IPOS, but also due to a long history of reasonable outcomes for commercial cases.

Singapore has seen its stock as a legal and commercial hub in Asia rise in recent years as Hong Kong and its government have grown closer to mainland China, a move exacerbated by Hong Kong's National Security Law and its more than 30 months of tight Covid-19 immigration controls.

Time magazine reported that wealth overseen by the asset



management industry in Singapore has doubled in just six years, to about US\$4 trillion, according to central bank figures, about 80% of which is foreign. “BlackRock Inc. is expanding in Singapore, as is the Ontario Teachers’ Pension Plan, which shut down its equity team in Hong Kong this year. Even Swiss banks are getting into the act: UBS Group AG’s offices dominate an entire city block in a prime shopping district, with a staff of 3,000, a private gym and a cappuccino bar. It’s now the firm’s largest operation in Asia,” *Time* reported.

“There’s not just one subsegment that’s suddenly hot on Asia—we’re seeing allocations from everyone,” Mark Voumard, co-founder of money manager Gordian Capital Singapore Pte told the magazine. Singapore “has momentum, and once something has legs it’ll continue to run.”

There’s no doubt that Singapore will face competition in its drive to become Asia’s regional financial hub, and in its expected efforts to corner the market on services such as arbitration and other forms of ADR. Tokyo and Shanghai also offer the creature comforts required by the expat community, with perhaps better weather to boot.

But Hong Kong’s loss will almost certainly be Singapore’s gain, at least to some degree. And that will likely make Singapore’s legal market even stronger than it is right now.

With Singapore potentially on the cusp of change, we turned to IP professionals in the region in order to understand better what clients need today. *Asia IP* asked a large number of professionals – mostly in-house counsel and corporate legal managers – what they were looking for from their legal service

providers. From their answers, we have compiled our list of Singapore’s 50 IP Experts, those lawyers who understand just what their clients need and are able to provide them with the best practical advice.

Our list reflects a growing diversity of practices in Singapore, with lawyers from a number of young and relatively young firms receiving recognition as IP Experts.

Not surprisingly, a handful of larger firms headline the list. Drew & Napier led our list, placing four lawyers among the Top 50 (Meryl Koh, Siau Wen Lim, Yvonne Tang and Tony Yeo). Amica Law placed three lawyers (Jason Chan, Jo-Ann See and Winnie Tham).

Several firms placed two lawyers each on the list: Allen & Gledhill (Pei Lin Low and Stanley Lai), Bird & Bird ATMD (Alban Kang and Lorraine Tay), Dentons Rodyk (Catherine Lee and Gilbert Leong), Donaldson & Burkinshaw (Michelle See Hui Ng and Shy Tsong Lee), Kelvin Chia Partnership (Kelvin Chia and Yee Ming Lim), Lee & Lee (Tee Jim Tan and Maurice Cheong), Marks & Clerk (Gianfranco Matteucci and Matthew English) and Ravindran Associates (M. Ravindran and Sukumar Karrupiah).

Twenty-seven different firms each placed one lawyer on our list, accounting for more than half of all lawyers named.

Most of the lawyers named to our list have multiple practice specialties. Many of them are litigators, while others concentrate on prosecution work or provide strategic advice.

All of them have something in common: they are experts in their fields and, in one way or another, they provide extra value for their clients. They are *Asia IP*’s Singapore IP Experts.—GREGORY GLASS ^{ALP}



SINGAPORE IP EXPERTS TOP 50

NAME	FIRM	PATENTS	TRADEMARKS	COPYRIGHT	ENFORCEMENT	LICENSING & FRANCHISING	MEDIA & ENTERTAINMENT	IT & TELECOMS	PHARMA & BIOTECH	IP LITIGATION
Ron Awyong	Orion IP	✓	✓							
Jason Chan	Amica Law	✓	✓		✓			✓		✓
Vivian Wei Cheng	JurisAsia	✓								
Maurice Cheong	Lee & Lee	✓	✓		✓	✓	✓			✓
Kelvin Chia	Kelvin Chia Partnership		✓	✓	✓					✓
Cyril Chua	Robinson		✓		✓			✓		✓
Matthew English	Marks & Clerk	✓						✓		
Jonathan Foong	ThatLegal		✓		✓					✓
Audrey Goh	Viering, Jentschura & Partner	✓								
Sheena Jacob	CMS Holborn Asia	✓	✓		✓	✓				✓
Alban Kang	Bird & Bird ATMD	✓	✓	✓	✓			✓	✓	✓
Sukumar Karuppiah	Ravindran Associates		✓							
Chia-Ling Koh	OC Queen Street		✓							
Meryl Koh	Drew & Napier	✓	✓	✓	✓	✓	✓		✓	✓
Jonathan Kok	Withers KhattarWong	✓	✓	✓	✓					✓
Stanley Lai	Allen & Gledhill	✓	✓	✓	✓			✓	✓	✓
Chung Nian Lam	WongPartnership		✓	✓	✓			✓	✓	✓
Rok Keng Lau	Rajah & Tann Singapore	✓	✓	✓	✓		✓	✓		✓
Margaret Law	Margaret Law Corporation		✓			✓				
Catherine Lee	Dentons Rodyk		✓			✓				
Shy Tsong Lee	Donaldson & Burkinshaw		✓	✓		✓				
Andy Leck	Baker McKenzie Wong & Leow	✓	✓		✓					✓
Gilbert Leong	Dentons Rodyk	✓	✓			✓		✓		
Siau Wen Lim	Drew & Napier	✓	✓	✓	✓	✓				✓
Yee Ming Lim	Kelvin Chia Partnership		✓	✓	✓			✓		
Jevon Louis	Shook Lin & Bok	✓	✓		✓					✓
Pei Lin Low	Allen & Gledhill	✓	✓							
Wendy Low	Eldan Law	✓	✓	✓	✓		✓			✓
Gianfranco Matteucci	Marks & Clerk	✓							✓	
Michael McLaughlin	McLaughlin IP	✓						✓		
Gladys Mirandah	Mirandah Asia		✓							
Max Ng	Gateway Law Corporation		✓		✓	✓				✓
Michelle SH Ng	Donaldson & Burkinshaw		✓						✓	
Teresa O'Connor	Ghows		✓	✓						
Regina Quek	One Legal	✓								
M. Ravindran	Ravindran Associates		✓	✓	✓					✓
Kristian Robinson	Spruson & Ferguson	✓							✓	
Jo-Ann See	Amica Law		✓	✓			✓	✓		
Esther Seow	Davies Collison Cave		✓							
Kar Liang Soh	Ella Cheong	✓	✓		✓					
Francine Tan	Francine Tan Law Corporation		✓	✓	✓				✓	✓
Joyce A. Tan	Joyce A. Tan & Partners		✓	✓	✓			✓		
Tee Jim Tan	Lee & Lee	✓	✓	✓	✓			✓	✓	✓
Yvonne Tang	Drew & Napier	✓	✓	✓	✓	✓	✓		✓	✓
Lorraine Tay	Bird & Bird ATMD	✓	✓			✓				
Winnie Tham	Amica Law	✓	✓			✓				
Esther Wee	Harry Elias Partnership	✓		✓				✓	✓	
Rizwi Wun	RHTLaw Asia		✓					✓		
Audrey Yap	Yusarn Audrey	✓	✓	✓	✓				✓	
Tony Yeo	Drew & Napier	✓	✓	✓	✓				✓	✓



Extended biographies of lawyers highlighted above appear on Pages 57-58



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PHARMA & BIOTECH
IP LITIGATION

Meryl Koh is a litigator and a director in both the intellectual property and dispute resolution departments at Drew & Napier. Particularly well-versed in corporate commercial disputes involving shareholders, IP, video games, entertainment, and technology disputes, Meryl is the first port of call for timely practical and commercial advice as well as strong advocacy in these areas.

Meryl’s distinctive competency leads her to act in many complex local and cross-border litigation and arbitrations involving infringement of patents, trademarks and copyright, passing off, oppression, breach of director’s duties, defamation and employment. Many of her clients come from the media, video games, sports, F&B, technology, and biopharmaceutical industries. Her clients include high net worth individuals, listed companies as well as international and household names.

Meryl has earned considerable praise from prestigious legal publications. Lauded as a *“polished litigator”*, Meryl is

“the attorney to have on speed dial when a complex IP issue arises” with clients praising her work as *“crisp, pragmatic and commercial”*. She was recognized as one of the Top 250 Women in IP 2023 by Managing Intellectual Property (MIP). At the Asialaw Awards 2023, Drew & Napier won the Editor’s Choice - Impact Deal and Case of the Year for acting in the *Riot games v. NetEase Interactive Entertainment* matter, where Meryl acted as the lead counsel. In 2019, ALB identified Meryl as one of the bright legal minds in the “40 under 40 list”. Meryl has penned several legal guides and manuals and speaks regularly on panels, having been recognized as a thought leader in her fields.

In 2019, Meryl was appointed to the panel of experts for the World IP Organization’s (“WIPO”) Fast-Track Intellectual Property Dispute Resolution Procedure for Consumer Fairs. She is also a fellow of the Singapore Institute of Arbitrators and on the board of Directors of EB Impact (non-profit).



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IP LITIGATION

Siau Wen Lim is an intellectual property specialist with more than 20 years of experience in contentious and non-contentious IP practice.

She manages the global trademark, patent and design portfolios of foreign and local multinational clients from a wide range of industries. She also advises clients on general IP and regulatory matters as well as issues of gaming, product advertising, labeling, and branding strategy.

Siau Wen handles various facets of IP commercial transactions. They include due diligence; negotiations; and drafting and reviewing licensing, franchising, sale and transfer, confidentiality, distributorship, and consultancy agreements relating to IP rights.

Siau Wen is also active in the area of intellectual property litigation and enforcement. She focuses on disputes involving anti-counterfeiting matters, trademarks, copyright, domain names, designs, and confidential information.

As a leading IP practitioner, Siau Wen is recommended by prominent legal publications: *The Legal 500 Asia Pacific*, *Managing Intellectual Property*, *IAM Patent 1000* and *World Trade Mark Review 1000*. She is described as *“thorough and reliable”*, and is prized for her ability to *“dispense practicable and commercially sensible advice and always find ways to add value”*.



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IP LITIGATION

Yvonne Tang actively practices in all aspects of intellectual property work. She has more than 20 years of experience in IP matters, having devoted her entire legal career to the IP field, and her clients include multinational and local companies alike.

On contentious IP matters, Yvonne's key areas include trademarks and copyright infringement, and passing off. She is regularly involved in trademark opposition proceedings, and has handled criminal raids of counterfeit goods as well as domain name recovery claims under the Singapore Domain Name Dispute Resolution Policy (SDRP).

Yvonne's legal experience extends to trademark and patent registration, searches and strategic advisory work, as well as corporate IP matters, such as the drafting and review of licensing and franchise agreements relating to IP assets.

She is constantly recommended by prominent legal publications, earning praise from The Legal 500 Asia Pacific for "*her strong legal knowledge of patent law*". Yvonne is commended as an "*all-rounder*" and "*invaluable asset*", known for providing advice that is "*always comprehensive, in tune with business goals and objectives*". She has also contributed to a number of articles on IP, including Atkin's Court Forms – Singapore, Copyright, Lexis Nexis and Practical Law Practice Notes on Patent Prosecution and Ex Parte Proceedings and Patent Revocation Proceedings at the Intellectual Property Office of Singapore (IPOS).

Yvonne is co-editor of the Asian Patent Attorneys Association (APAA) e-newsletter Group, and a member of the Executive Committee of the APAA, Singapore Group, and the Institute of Singapore Trade Mark Agents. She is also a Fellow of the Singapore Institute of Arbitrators and a Certified Patent Valuation Analyst.



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IP LITIGATION

Tony Yeo is the managing director of Drew & Napier's intellectual property department, and a director in its dispute resolution department. He also heads the firm's healthcare and life sciences practice.

Tony is a litigator with an active court practice as an advocate. He has acted as lead counsel in many complex matters, including numerous patent infringement cases. Tony's expertise lies in IP litigation and enforcement including patent, trade mark and copyright. He has represented various leading biotech and pharmaceutical companies, government statutory boards and listed companies. His civil and commercial litigation practice includes banking litigation and contract disputes.

Prestigious legal publications have consistently recognized Tony as a leading practitioner in IP, dispute resolution and life sciences. He is commended for being a "*fantastic strategist*" and "*formidable litigator*" who renders "*first class service and quality work*". Tony impresses clients

with his ability to "*value-add by strategising approaches for the best outcomes*". Tony was also named as one of Asia's top 15 IP lawyers for 2 consecutive years in 2021 and 2022 by Asian Legal Business (ALB). Under his leadership, the firm clinched a double win at the Managing IP Asia-Pacific Awards 2023, winning both the Singapore Patent Disputes Firm of the Year and Singapore Trademark Disputes Firm of the Year.

Tony was appointed by the Intellectual Property Office of Singapore (IPOS) as an IP Adjudicator to hear disputes at IPOS for a two-year term. He is also the President of the International Association for the Protection of Intellectual Property (AIPPI) – Singapore Group, and a member of the Law Society's Inquiry Committee and Disciplinary Tribunal.


He has contributed to numerous publications in the domains of IP and life sciences such as The Legal 500's Patent Litigation Country Comparative Guide, and the Lexology Getting the Deal Through's Life Sciences.



Singapore's IP Experts is based solely on independent editorial research conducted by *Asia IP*. As part of this project, we turned to in-house counsel in Singapore, Asia and elsewhere around the world, as well as Southeast Asia-focused partners at international law firms, and asked them to nominate private-practice lawyers including foreign legal consultants, advisers and counsel.

The final list reflects the nominations received combined with the input of editorial team at *Asia IP*, which has nearly 45 years of collective experience in researching and understanding Singapore's legal market.

All private practice intellectual property lawyers in Singapore were eligible for inclusion in the nominations process; there were no fees or any other requirements for inclusion in the process.

The names of our 50 IP Experts are published here. Each IP Expert was given the opportunity to include their biography and contact details in print and on our website, for which a fee was charged. 



RISE OF PLANT-BASED MEAT PUSHES REVIEW OF IP STRATEGIES

Due to shifting consumer preferences, flexitarian diets and increased global food demand, plant-based products are on the rise. *Excel V. Dyquiango* discusses the evolution from using plant-based alternatives and the need to continually adapt and refine the IP strategy for their creations.

The popularity of plant-based products has grown in recent years, driven by changing consumer attitudes, the adoption of flexitarian and plant-based diets, and an increase in the worldwide need for food.

Foods like tofu and tempeh have been used as meat substitutes for as long as there have been written records, and plant-based diets have long been supported for moral, ethical and health reasons. The emphasis has changed in recent decades from finding alternate protein sources to developing reliable meat replacements that appeal to a wider consumer base.

The first-generation of these “plant-based meat” substitutes, such as textured vegetable protein (TVP) and Quorn made from mycoprotein, were largely marketed to vegetarians but had trouble gaining widespread acceptance. The recent explosion of novel plant-based meat products is difficult to ignore. These products seek to appeal to a broad audience and match or even outperform traditional meat in terms of flavor and texture.

But what recent technological advancements are responsible for this quick growth, and how can companies ensure that their products stand out on store shelves among the expanding selection of plant-based options? More important, why should plant-based companies adopt a comprehensive IP strategy?

Technological innovations

According to Panisa Suwanmatajarn, a managing partner at The Legal Co. in Bangkok, to be successful in plant-based meat businesses, the meat replacement should not only look and feel like meat in the traditional way but in taste as well. It should be healthy, too.

“Technological innovations that make plant-based meat have the same functions and play significant roles in the expansion of plant-based companies,” she said. “Obviously, 3D printing, which allows for the creation of complex and customizable plant-based food products, and electrospinning, which involves using an electrical field to create nanofiber mats that can be incorporated into plant-based products to improve their texture, flavour and nutritional profile are keys to the success.”

Louise Buckingham, a former senior lawyer and head of the knowledge and innovation function at Gilbert + Tobin in Sydney and now the CEO of Arts Law Centre of Australia, said the technological innovations that have fueled the growth of plant-based companies include the development of products that are close to whole cuts of meat, using non-meat proteins.

“Extrusion technology, sheer-shell technology and the use of gelling an emulsifying property that are yet ‘clean’ and high-quality so that they meet consumer expectations around less-processing in terms of food production have propelled possibilities,” she explained. “With the neat values-based alignment between consumer concern for environmental, social and governance and good corporate citizenship, plant-based companies can leverage their product outputs with ethical and sustainable R&D practices

and marketing and create enduring brand loyalty. They want to stand out for the quality of their offerings, ultimately, and this quality may extend literally beyond – beyond-meat, if you will – to the positive impact of the company, constructed, protected and communicated to consumers and competitors alike with the help of their IP strategy.”

Should patenting be an appropriate commercialization pathway in the particular context of the company at issue, Buckingham noted that “the more widely utilized are certain innovations, the greater will be the challenges around patentability.”

“Recently, in Australia, the patent office determined that Marlow Foods, the maker of Quorn, can’t patent – for now – a vegan burger with a non-egg binding agent for lack of inventive step,” she said. “In this case, QIP Nominees had challenged Marlow’s patent application on the basis that it was cast widely enough to include fungus-based protein capturing existing foods.”

In addition to technological innovations, Buckingham said IP strategies can help plant-based companies stand out from the crowd.”

Fueling a comprehensive IP strategy

As plant-based meat is gaining popularity, various companies are rushing into the market. Everyone is using new technologies to create plant-based meat, and more patent filings are increasing to block competitors as much as they can. Thus, a comprehensive IP strategy will come to play – patent for technological innovations, design for the visual appearance of the products and packaging, and trademark for brands, logos and trade dress.

Suwanmatajarn said to create a good comprehensive IP strategy for plant-based companies, the following inclusions should be considered:

- Conduct an intellectual property audit. This involves identifying existing IP assets and determining areas where protection is needed. The audit should also include an assessment of any potential infringement risks.
- Determine appropriate forms of IP protection. This includes patents, trademarks and designs, and will depend on the specific needs of the plant-based company.
- Work with an experienced IP attorney. Experienced attorneys specializing in the food industry can offer guidance on navigating complex patent and trademark laws and assist in crafting a robust IP strategy.
- Develop strong branding. This can help create brand recognition and value and should be protected with trademarks.
- Monitor and enforce IP rights. This helps protect the plant-based company against IP infringement and maintains competitive advantage.
- Continuously evaluate and refine the IP strategy. As the plant-based industry evolves, the IP strategy should also evolve to ensure continued protection and success.

"Plant-based companies should make sure confidentiality clauses are included in the contract with their employees and NDA signed with other relevant parties to prevent confidential information from leaking. Externally, the companies shall register all IP rights at the earliest opportunity and actively enforce against any infringement of IP rights."

—STEPHANIE NING, senior managing associate, Bird & Bird, Hong Kong

"In Australia, the patent office determined that Marlow Foods, the maker of Quorn, can't patent - for now - a vegan burger with a non-egg binding agent for lack of inventive step. In this case, QIP Nominees had challenged Marlow's patent application on the basis that it was cast widely enough to include fungus-based protein capturing existing foods."

—LOUISE BUCKINGHAM, CEO, Arts Law Centre of Australia.

"Technological innovations have helped plant-based 'meat' have the same functions and play significant roles in the expansion of plant-based companies by improving the texture, flavour and nutritional profile of plant-based products."

—PANISA SUWANMATAJARN, managing partner, The Legal Co., Bangkok



Meanwhile, Buckingham said top legal advisers will take a whole of business approach to ensure they understand the objectives and hopes for outcomes of plant-based companies and will have deep understanding all the possibilities for IP protection and exploitation related to the products and company goals.

Every company is different and each should ensure that their adopted comprehensive IP strategy is tailored precisely to them considering their context overall. In addition to their purposes as mentioned, Buckingham added that this will include “where they’re based, operate and wish to expand, and will take into account product lines, focus for ongoing research and

development. It’ll be mindful of consequent innovation and commercialization pathways, often building in flexibilities to accommodate rapid change.”

“Different types of IP – or IP ‘regimes’ – interact with each other, and with other legal and regulatory requirements in relevant jurisdictions in various ways that need to be considered in the specific instance of any strategy or strategies,” she said. “Legal market knowledge as well as understanding of markets surrounding the product and related offerings is super important.”

She continued: “Internal factors about the nature of the company, where it plans to spend its energies, and external market factors will drive considerations

about utilization of what we think of as ‘traditional’ registrable forms of IP. Trademarking the company logo or brand name, patenting the underlying innovation where possible, and beyond the formula for the product – this may include innovation in packaging to preserve the product for longer, for instance. Also, potentially in this context, what we call plant breeders rights in Australia, or plant variety rights in New Zealand and the UK, or plant patents in the U.S., may come into play.”

Within this, the lifecycles of the products and other company goals must be considered to weigh up whether going down the registration route makes sense for the company. It may be that relying on confidential information or protection for trade secrets, bolstered by physical and contractual measures for protection better suits the business, for example.

Buckingham said that the commercial strategy that most suits the company to adopt as far as assigning or licensing elements of their IP comes into play. Or they may wish to retain control outright and want to focus their energies exclusively on a monitoring and enforcement approach.

“There are as many variations to include within any strategy as there are companies and it’s difficult to generalize,” she said. “Our firm has deep expertise in non-registrable forms of IP protection such as copyright, which may protect the text of the underlying recipes in the plant-based product, for example, as well as elements of the packaging, text and images. In ‘non-traditional’ forms, such as trade dress (get up), domain names and so on, our clients often benefit from learning how these forms of what we sometimes call ‘quasi-IP’ might relate to their situation, too.”

Challenges in using IP strategies

Stephanie Ning, senior managing associate at Bird & Bird in Hong Kong, said there are challenges that these companies may encounter.

“In terms of trademark, it is important to note

that the same trademark may not be registrable in all jurisdictions due to different standards on the level of distinctiveness and/or descriptiveness required of a mark,” she said. “For example, ‘Beyond Meat’ is registrable in Hong Kong but its registration was refused in China because the word ‘Meat’ was regarded as misleading when used in relation to the applied for goods in Class 29 violating Article 10(7)(1) the PRC Trademark Law.”

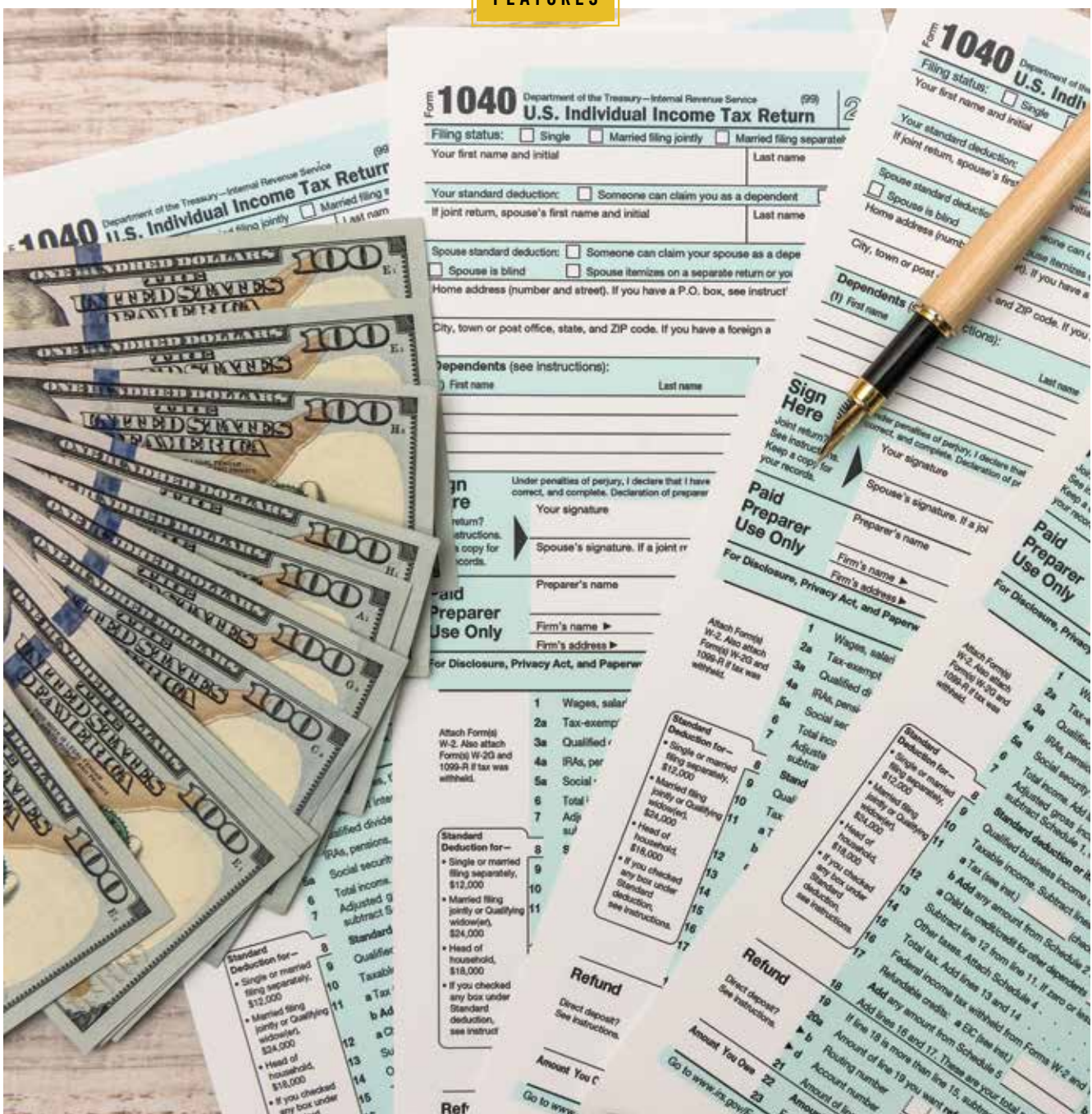
Ning advised seeking local advice before filing the trademarks. It is also worth having an alternative trademark if the first choice does not go through. She added that another important point to note is that a registered trademark may become generic if it is commonly used as a descriptive sign in the market – such as if the word “impossible” is being used generically by third parties when referring to meat-alternatives.

To prevent this from happening, the registered trademark symbol, ®, should always be in use together with the trademark, Ning said. If there is any infringement sighting, the trademark owner should take active action.

As for patents, companies are reminded that they only gain full protection once their patent is granted. However, prior to publication of the patent application, they may be subject to risks of information of invention being disclosed to competitors. To fully protect the process of invention, Ning said that companies should sign NDA and include a confidentiality clause in the employment contract with all parties involved in the project.

“Internally, plant-based companies should make sure confidentiality clauses are included in the contract with their employees and NDA signed with other relevant parties to prevent confidential information from leaking. Externally, the companies shall register all IP rights at the earliest opportunity and actively enforce against any infringement of IP rights,” she advised. ^{AlP}





MANAGING THE TAX IMPLICATIONS OF TRANSACTIONS WITH IP RIGHTS

There is a growing interaction between intellectual property rights and taxation, as taxation laws increasingly encompass valuable assets in economic development and innovation. *Excel V. Dyquiango* discusses the evolving connection between the two, including IP rights under tax regimes.

Taxation is essential for funding public spending and fostering a nation's economic development. As such, intellectual property rights have also gained popularity in recent years as a priceless resource that may considerably boost a nation's economy. This has resulted to taxation laws now covering IP rights. IP is transferred either through assignment or licensing, both of which have different tax ramifications. A strong tax structure for IP rights would demonstrate how well an IP regime would function in a country.

"Taxation has a significant impact on the development and commercialization of IP rights due to the way tax treatment and incentives are applied," said Sudhir Ravindran, attorney-at-law, solicitor and founder of Altacit Global in Chennai. "In the past, the relationship between IP rights and taxation was not prominent. However, as IP rights gained prominence in commercial transactions, the tax system had to adapt to keep up with the changes. The primary purpose of taxation is to generate revenue for government expenditures, and as economic activities involving IP rights increased, the connection between taxation and IP rights became more robust. Today, transactions involving IP rights are subject to various forms of taxation."

IP rights laws do not generally contain provisions relating to taxation laws since they are of differential characters. Taxation laws, however, rely on the provisions of IP rights law to determine the nature of transaction and monetary considerations, such as royalty payments, rights holder and assignability, among others, to determine the applicability of taxation.

In Singapore, the tax treatments of IP rights and their related transactions are set out in the Income Tax Act and/or the Economic Expansion Incentives (Relief from Income Tax) Act, and not the respective laws governing the various IP rights (Copyrights Act, Patents Act). That said, IP law considerations may come into play when determining the tax treatment of IP rights-related transactions in a restructuring exercise. As an example, where a licence for IP rights is granted to a company, one consideration is whether the company can take the position that it has acquired economic ownership of the IP rights, such that it can claim writing-down allowances on the IP rights in Singapore.

IP rights under taxation regimes

According to Ravindran, IP rights are subject to various accounting treatments under different taxation regimes. How they are classified – either as capital or revenue expenditure under income tax laws – determines whether they are treated as assets or revenue expenses. When transactions involving IP rights occur, such as selling or licensing them, he said they become trigger points for taxation and the income generated from these transactions is taxable under the relevant tax laws.

"Transborder transactions involving IP rights,

which occur across national borders, are also subject to taxation in specific countries. However, taxing such transactions can be challenging due to the intangible nature of IP rights, which doesn't involve physical movement like traditional goods," he further said. "In certain jurisdictions, instruments that document IP rights transactions are also subject to taxation, meaning that legal agreements, licenses, or contracts related to IP rights may attract taxes based on the applicable laws."

For Jaclyn Ho, principal and tax advisor at Baker McKenzie Wong & Leow in Singapore, IP rights are not taxed per se. However, she said that what countries are competing for is the tax on the income derived by companies on the commercialization and exploitation of IP rights, and for some, the gain on disposal of the IP rights.

"In fact, IP rights and its corresponding activities, such as R&D, came into the spotlight in 2015 when BEPS Action 5 on Countering Harmful Tax Practices was introduced by the OECD to combat regimes that facilitate base erosion and profit shifting," she said. "Given the intangible nature of IP rights, the provision of IP rights was regarded as a geographical mobile activity that could be used to shift profits across jurisdictions which offer various preferential tax treatments. To level the playing field, the 'nexus approach' was introduced as a substantial activity requirement for IP regimes. This means that the extent to which companies may benefit from an IP regime, such as a concessionary tax rate incentive, in a jurisdiction is linked to the amount of qualifying R&D expenses incurred that gave rise to the IP income."

When it comes to ownership and management of IP rights, jurisdictions may provide for tax amortization on the IP rights acquired, as this helps reduce a company's taxable income in that jurisdiction. For example, in Singapore, writing-down allowances can be claimed on capital expenditure incurred in the acquisition of certain IP rights (which includes patents, copyrights and trademarks), subject to conditions.

"Where a company decides to in-license the IP rights which may comprise patents, copyrights and trademarks instead, such royalty payments made to a non-resident would usually attract withholding tax," she said. "Certain jurisdictions may provide a reduction in the withholding tax rate to encourage companies to access technology and know-how for their activities in-country. In Singapore, there is the Approved Royalties Incentive that provides a tax exemption or a concessionary withholding tax rate on approved royalties, subject to conditions."

Turning to the commercialization of IP rights, whether and how the income will be taxed would depend on the characterization of the income, and the source rules that follow. "Many jurisdictions provide for a preferential tax rate on the income derived from the commercialization of the rights," she said. "Depending on the characterization of the income derived from the rights, different regimes may be applicable. In

"Given the intangible nature of IP rights, the provision of IP rights was regarded as a geographical mobile activity that could be used to shift profits across jurisdictions which offer various preferential tax treatments. To level the playing field, the 'nexus approach' was introduced as a substantial activity requirement for IP regimes."

—JACLYN HO, principal, tax advisor, Baker McKenzie Wong & Leow, Singapore

"In the past, the relationship between IP rights and taxation was not prominent. However, as IP rights gained prominence in commercial transactions, the tax system had to adapt to keep up with the changes. Today, transactions involving IP rights are subject to various forms of taxation."

—SUDHIR RAVINDRAN, attorney-at-law, solicitor, founder, Altacit Global, Chennai

"Although the tax code does not specifically define IP rights, it does recognize intangible assets such as patents, copyrights, trademarks, etc. - all of which fall under IP rights as defined under the intellectual property code."

—MARIA TERESA MERCADO-FERRER, associate, SyCip Salazar Hernandez & Gatmaitan, Manila

"Income from the sale or assignment of IP rights are also subject to tax. If the

IP is considered an ordinary asset of the taxpayer, then any income derived from its sale shall form part of the taxpayer's gross income and is subject to regular income tax. On the other hand, if the intellectual property sold is a capital asset, the income is considered capital gains and will be subject to certain rules applicable to dealings in capital assets."

—CARINA LAFORTEZA, partner, SyCip Salazar Hernandez & Gatmaitan, Manila

Singapore, the IP Development Incentive provides a concessionary tax rate on qualifying IP income derived by a company as consideration for the commercial exploitation of patents and copyrights subsisting in software. The IP Development Incentive adopts the modified nexus approach set by the OECD in BEPS Action 5."

IP rights are now a major force behind innovation and economic prosperity. However, they also bring up intricate tax ramifications for people, companies and governments. To maintain compliance and maximize the advantages of these priceless intangible assets, stakeholders must be knowledgeable about the tax laws and regulations relevant to intellectual property.



To successfully navigate the complex web of intellectual property tax rules and regulations, tax experts' counsel can be helpful. Understanding the tax consequences of intellectual property rights will continue to be a crucial component of successful company strategies as the global economy continues to rely on knowledge-based assets.

Royalties and tax

Carina Laforteza, a partner at SyCip Salazar Hernandez & Gatmaitan in Manila, said the income derived from licensing the use of IP rights – for example, royalties – is subject to tax. She explained royalties are considered as active income subject to regular income tax if a taxpayer generates royalties in the active pursuit and conduct of its primary business purpose. On the other hand, if the royalties are merely incidental to the taxpayer's primary business purpose, royalties are considered passive income subject to a final withholding tax.

"Income from the sale or assignment of IP rights are also subject to tax. If the IP is considered an ordinary asset of the taxpayer, then any income derived from its sale shall form part of the taxpayer's gross income and is subject to regular income tax," she said. "On the other hand, if the intellectual property sold is a capital asset, the income is considered capital gains and will be subject to certain rules applicable to dealings in capital assets."


Value-added tax is also due on royalties and ordinary gains from the sale of IP rights.

Laforteza said: "The tax code provides that 'goods' or 'properties' subject to VAT are understood to include intangible objects capable of pecuniary estimation, such as the right or privilege to use patent, copyright, design or model, plan, secret formula or process, goodwill, trademark, trade brand or other like property or right. In the Philippines, Section 88.4 of the IP code provides that Philippine taxes on all payments relating to technology transfer arrangements, which includes the licensing of all forms of IP rights, must be borne by the licensor."

"However, it is possible to ask for an exemption from this provision with respect to value-added tax,

which is an indirect tax and generally shifted to the licensee," added Maria Teresa Mercado-Ferrer, an associate at SyCip Salazar Hernandez & Gatmaitan. "Although the tax code does not specifically define IP rights, it does recognize intangible assets such as patents, copyrights, trademarks, etc. – all of which fall under IP rights as defined under the intellectual property code."

Being intangible assets, Section 42 of the country's tax code provides for the situs of income derived from IP rights and states that rentals and royalties from the following are considered as income from sources within the Philippines:

- Use or the privilege to use in the Philippines any copyright, patent, design or model, plan, secret formula or process, goodwill, trademark, trade brand or other like property or right;
- The use of or the right to use in the Philippines any industrial, commercial or scientific equipment;
- The supply of scientific, technical, industrial or commercial knowledge or information;
- The supply of any assistance that is ancillary and subsidiary to and is furnished as a means of enabling the application or enjoyment of any such property or right as mentioned in paragraph (a), any such equipment as mentioned in paragraph (b) or any such knowledge or information as mentioned in paragraph (c);
- The supply of services by a nonresident person or his employee in connection with the use of property or rights belonging to or the installation or operation of any brand, machinery or other apparatus purchased from such nonresident person;
- Technical advice, assistance or services rendered in connection with technical management or administration of any scientific, industrial or commercial undertaking, venture, project or scheme; and
- The use of or the right to use – motion picture films; films or video tapes for use in connection with television; and tapes for use in connection with radio broadcasting. 

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COMPETENCE

It would be easier to ascertain exact competence of a firm by, e.g. 1) sending it a pending or granted patent for its comments about how it can improve the claims, 2) sending it a pending patent specification without the claims for it to draft the claims for the client's comparison with the original claims, or 3) sending to it and the firm the client is currently using at the same time an initial disclosure so that the client can compare and find out which firm can provide the better claims. This firm welcomes such challenges.



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ASEAN

Tiger Pictures Entertainment Ltd v. Encore Films Pte Ltd: An expedited process in the interest of justice?

A recent High Court judgment was the first of its kind that concerned the “simplified process” for intellectual property claims in Singapore. The simplified process took effect in Singapore from April 1, 2022. It is a discretionary, streamlined process to expedite the management of intellectual property disputes to enable disputants (particularly SMEs) to save costs and time when invoking their rights.

Encore Films Pte Ltd (the defendant) sought a declaration that the simplified process did not cover Tiger Pictures Entertainment Ltd’s (the claimant) claim. The claimant, a company established in China, is a global film distribution business. The defendant is a company established in Singapore that distributes films in Southeast Asia.

The claimant began discussions with the defendant,

using text messages and emails, with the intention of crafting a distribution agreement for the release of the movie *Moon Man* in Singapore.

However, the parties did not come to an agreement on significant points and never formalized a written distribution agreement. Nevertheless, the defendant took the initiative to launch the movie in Singapore, arguing that an agreement had been implicitly established through their electronic communications.

In response, the claimant accused the defendant of copyright infringement regarding the movie. The defendant denied any wrongdoing and, in turn, levelled two counterclaims against the claimant: one, for supposed baseless allegations of copyright infringement, and two, for the supposed infringement of the defendant’s copyright in a completely different movie.

In order to resolve the claim, the claimant opted for the simplified process, which is aimed at saving costs and time. For the simplified process to apply, the following requirements must have been met:

(i) The dispute concerns

intellectual property;

(ii) Generally, the damages sought by each party would not go above S\$500,000 (US\$370,000), or would be unlikely to do so; and


(iii) The matter was an appropriate one for the simplified process, with due consideration of, amongst others, the following:

- a. Whether the simplified process was the only option available to a party given its financial circumstances;
- b. The complicity of the matter; and
- c. Whether the duration of the trial would probably run over two days.

The defendant took issue with this approach and submitted a request for an order stating that the simplified process was not applicable in this case as the trial would probably run over two days and would require four days. The defendant leaned on a number of considerations to support its proposition. Firstly, it stated that the matter was a fact and context-sensitive enquiry which would require its five witnesses to testify on a wide range of factual issues.

Secondly, it stated that two of its five witnesses would be testifying in Chinese which will require interpretation by an interpreter.

Notwithstanding the defendant's position above, the judge held that the above requirements had been satisfied. First, the matter was concerned with intellectual property because it was a claim in copyright infringement. Second, the relief sought was unlikely to go above S\$500,000. The judge also found that just because either or both disputants had the means to pursue "normal" litigation, this in and of itself did not preclude the applicability of the simplified process. The dispute was also not particularly complicated. Further, duration of the trial would not exceed two days, particularly considering that the defendant's expert witness was unlikely to be called.

Accordingly, the matter qualified for the simplified process, and the defendant's application was dismissed. 



INDIA

India: The perils of not naming the correct inventors

Patent rights are granted to inventors. When an invention is created by the joint efforts of many persons, all of them qualify to be named as inventors in the patent application. Section 6 of India's Patents Act, 1970 states that an application for a patent may be made by any of the following persons, that is to say:

(a) *By any person claiming to be the true and first inventor of the invention.*

Section 2(y) defines "true and first inventor" in an exclusive definition that "true and first inventor" does not include either the first importer of an invention into India, or a person to whom an invention is first communicated from outside India. This leaves enough room for subjective determination of the true and first inventor.

Technically speaking, the named inventors in the application for a patent are presumed to be correct for the purpose of examination proceedings. No evidence is required to prove the inventorship.

A declaration under Paragraph 9 of Form 1 signed by the inventor(s) to the effect that "I/we, the above-named inventor(s), is/are the true and the first inventor(s) for this invention" is sufficient to meet the requirement of Section 6(1)(a). Legally speaking, all the inventors who contributed to the development of the invention must be correctly named as inventors in the application for a patent. If this is not done, the person who is not named as an inventor can

seek intervention of the controller before the grant of the patent under Section 28 or intervention of the court after grant. The named inventors in an application for patent are presumed correct, and the party seeking correction of inventorship must show by clear and convincing evidence that he should have been listed as a joint inventor. This correction in list of inventors is essential to claim the legal benefits available to the co-owners under Section 50 of the Patents Act.

According to Section (50)(2) of the Patents Act, "Subject to the provisions contained in this section and in Section 51, where two or more persons are registered as grantee or proprietor of a patent, then, unless an agreement to the contrary is in force, each of those persons shall be entitled, by himself or his agents, to rights conferred by Section 48 for his own benefit without accounting to the other person or persons."

This means each co-inventor "may make, use, offer to sell, or sell the patented invention within India or import the patented invention into India, without the consent of and without accounting to the other owners." By implication, this provision provides for an undivided share in the patent for every co-inventor.

How to prove joint inventorship

Inventorship is a question of law based on underlying facts. The claimant inventor's testimony standing alone is insufficient to establish inventorship by clear and convincing evidence. The claimant co-inventor must supply evidence to corroborate his testimony. The corroborating evidence may be in multiple forms like

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contemporaneous documents or physical evidence, circumstantial evidence or oral testimony of someone other than the alleged inventor. To determine whether testimony has been sufficiently corroborated, courts apply a “rule of reason” test where all pertinent evidence is examined in order to determine whether the inventor’s story is credible. A court’s conclusion about corroboration under this “rule of reason” analysis is a factfinding. Additionally, the claimant inventor must show that he contributed significantly to the conception with the definite and permanent idea of the invention or reduction to practice of at least one claim. The right of the claimant in respect of the invention must be finally established by the decision of a court.

This is what happened in the United States in *Blue Gentian, LLC v. Tristar Products, Inc.*, in which Blue Gentian, National Express and Tele-brands Corp (collectively, Blue Gentian) sued Tristar Products in a case decided on June 9, 2023, by the U.S. Court of Appeals, where failure to properly list a co-inventor resulted in the only named inventor losing their exclusive patent rights to enforce the patents.

Facts of the case

Blue Gentian, National Express and Tele-brands Corp. sued Tristar Products for infringement of four U.S. patents, Nos. 8,291,941, 8,291,942, 8,479,776 and 8,757,213, and two design patents, D722,681 and D724,186. Tristar counter-claimed to correct inventorship of all six patents.

After an evidentiary hearing, the district court determined that a non-party, Gary Ragner, should have been a named co-inventor on all asserted patents. Accordingly, the district court entered judgment on the inventorship counterclaim in Tristar’s favour and ordered correction of the patents. Blue Gentian appealed. The Court of Appeals affirmed the correction of the patent in favour of Tristar and Ragner was declared as a co-

inventor of all the patents. Tristar received rights equal to those of Blue Gentian. Consequential to this finding, the infringement lawsuit was dismissed. In fact, Blue Gentian lost its exclusive right on these patents. This means Blue Gentian cannot enforce these patents alone and it no longer had exclusive rights to sell the patented product related to an expandable hose.

This case highlights that leaving an inventor off your application will not be in your favour in a long run. The question before the applicant for the patent now is how to ascertain the inventorship where many persons were involved during the development of the invention.

There is no guiding provision in the patent law to ascertain who is an inventor. Patent law and procedure presumes that the listed named persons who have signed the declaration in application for a patent are the inventors. If the name of any inventor is not included in the list of inventors, he may claim in the court to be declared as joint inventor. In fact, Ragner only fought to have himself added to the list of inventors. Ragner was able to establish before the court that he conceived elements claimed in at least one of the claims of each patent. He was able to prove that he conceived of the invention that was claimed by Blue Gentian’s principal, Michael Berardi. In this case, Berardi and Ragner met to discuss the invention. Ragner was able to corroborate his testimony with clinching circumstantial evidence to the court to prove his claim as a joint inventor. In this case, Ragner was able to prove that he was also the inventor.

Failed attempt to claim joint inventorship

In another dispute for correction of inventorship of U.S. patent No. 8,042,586 for a ‘self-inflating tire’ between Coda Development and Goodyear [*Coda Development. v. Goodyear Tire & Rubber Co.* United States District Court, N.D. Ohio,

Eastern Division, March 31, 2023], the court held that the claimant inventor Frantisek Hrabal of Coda Development had failed to prove by clear and convincing evidence that, before December 21, 2009, he conceived a definite and permanent idea of the complete and operative inventions claimed in the ’586 patent, including every feature or limitation of the claimed inventions. The court dismissed the Coda’s claim for correction of inventorship as to the ’586 patent. In this case, the claimant had failed to prove inventorship by clear and convincing evidence. This case highlights that mere testimony is no sufficient to get favourable order for joint inventorship in a patent. The claimant should corroborate it with supporting evidence.

Cautionary remarks

It is not unusual for companies to collaborate on the inventions with others. It is generally believed by the companies that the eventual invention was their idea and the others only contributed to the development of the product. It is sometimes a case of where the outsiders were hired and paid to assist in development of some elements of the invention. Such loose collaboration on invention leads to errors in adding all of the inventors to the patent application. Companies applying for a patent may confuse the owning of the patent – ownership – with who should be named as inventor – inventorship.

This situation is avoidable in many ways. The company with the inventive idea should identify all inventors carefully. They can get an assignment agreement signed by all the inventors, which transfers their rights to a single entity. This entity can be an individual or the company that will proceed to obtain a patent and exploit the invention. In *Blue Gentian*, had Berardi entered into an agreement with Ragner to assign Ragner’s rights to *Blue Gentian* before working with him, this awkward situation could have been avoided.

Similarly, had Ragner gotten a non-disclosure agreement or confidentiality agreement signed by Berardi, Blue Gentian could not have used the patent without his written authorization. Before the collaboration meeting ever happens, it is best that an agreement stating to whom any improvements resulting from the meeting should be assigned.

We must appreciate that patent rights are not easy to obtain. They are valuable and utmost care should be exercised to ensure that all inventors are properly named in the patent application. An expert opinion can make a difference to ensure that exclusive patent rights are not lost for the want of missing the name of an inventor, as happened in *Blue Gentian*. In *Goodyear*, the court dismissed claims of the inventor for lack of clear and convincing evidence. We have not come across such cases in Indian courts, but with the collaborations of multidisciplinary fields becoming common, disputes relating missing of inventors may crop up if proper precautions are not taken by the applicant for the patents. ^{ALP}

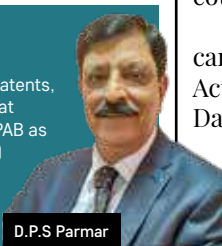
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D.P.S. Parmar heads the Patents, Contentious practice group at LexOrbis. After joining the IPAB as Technical Member (Patents) in 2011, he has been instrumental in writing some path breaking and insightful decisions on Indian patent law issues.

These include establishing legal positions on excluded subject matter under Section 3(d), 3(i) and 3(k), divisional applications, disclosure requirements under Section 8, working statements and compulsory license, to name a few. Before joining the IPAB, Parmar worked with the Indian Patent Office (IPO) for more than 27 years, where he played a vital role both at the administrative and policy levels.



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PHILIPPINES

Quo Vadis, cannabis patents?

About 60 countries around the world permit the use of medical marijuana, and a few allow its use for recreational purposes. In 2022, Thailand decriminalized the use of cannabis, but recreational use remains illegal. Possession, cultivation, distribution, consumption and sales of all cannabis plant parts are now legal in Thailand – the first ASEAN country to do so.

In the Philippines, the use of cannabis is illegal under Republic Act 9165 or the Comprehensive Dangerous Drugs Act of 2002.

Under this law, cannabis is listed as a dangerous drug which sale, possession, use, importation, manufacturing, cultivation, among others, are prohibited and punishable by law. R.A. 9165 defines cannabis, commonly known as “Marijuana” or “Indian Hemp” or by any other name as “embracing every kind, class, genus, or specie of the plant Cannabis sativa including, but not limited to, Cannabis americana, hashish, bhang, guaza, churrus and ganjab, and embraces every kind, class and character of marijuana, whether dried or fresh and flowering, flowering or fruiting tops, or any part or portion of the plant and seeds thereof, and all its geographic varieties, whether as

a reefer, resin, extract, tincture or in any form whatsoever.” Cannabis is on the list of the 1961 United Nations Single Convention on Narcotic Drugs as amended by the 1972 Protocol.

President Bongbong Marcos, during his campaign for the 2022 presidential election, stated that he agrees with the legalization of medical marijuana. He believes in the effectivity of marijuana for medical use, and emphasizes that in case of passage of a bill legalizing it, there should be safeguards and strict implementation to avoid abuse.

According to a survey conducted by Capstone-Intel Corp. and published online by *The Thaiger*, 63 percent of the Filipino respondents favored the legalization of medical marijuana for therapeutic purposes, provided further research is done and that there are strict policy guidelines for access and dosage control, and that there are increased efforts to raise awareness and education about it.

There is no consensus among medical experts in the Philippines on the use of medical cannabis. In an article published on the ABS-CBN news portal, representatives from the government as well as advocates weighed in on medical cannabis. The Philippine Food and Drug Administration (FDA) expressed support for legalizing medical cannabis as long as it is made available in “pharmaceutical” or “dosage” form like tablets or injectables. Representatives from the Department of Health and the Department of Neurosciences of the University of the Philippines noted that while medical cannabis could provide relief to some symptoms, it does not cure the disease. Advocates, however, asserted that Filipinos have a right to get the treatment they need. According to the Philippines Cannabis Compassion Society, “Science has already been established that cannabis is medicine, and we highly believe as patients this is a basic human right of Filipino citizen, the basic human

right to access our right to health.”

Because cannabis is classified as a dangerous drug, patent examiners in the Intellectual Property Office of the Philippines (IPOP HL) tend to reject applications containing cannabis on the ground that it is excluded from patent protection because it falls within the list of non-patentable inventions under Section 22 of the IP Code. To be patentable, an invention must meet three requirements: novelty, inventive step and industrial applicability, and must not fall within the exclusions, one of which refers to “anything which is contrary to public order or morality.” An example is application No. 1/2017/500733 for “Cannabis Extracts and Methods of Preparing and Using the Same”, which entered the Philippines claiming priority from U.S. applications. The examiner rejected all claims for being drawn to a subject matter contrary to public order or morality since the cultivation and use of cannabis is illegal under R.A. 9165. A quick search of the IPOP HL’s data base as of September 15, 2023, shows 26 cannabis patent applications, with five registered patents, to wit:

Registration No.	Title
1/2014/500452 2021.05.20	A pharmaceutical composition comprising the phytocannabinoids cannabidiol (CBD) and cannabidiol (CBD)
1/2013/501389 2018.10.29	Use of the phytocannabinoid cannabidiol (CBD) in combination with a standard anti-epileptic drug (SAED) in the treatment of epilepsy
1/2018/502733 2023.05.08	[1,2,3]Triazolo [4,5-D] pyrimidine derivatives with affinity for the type-2 cannabinoid receptor
/2014/50081303 2016.06.17	Novel [1,2,3] Triazolo [4,5-D] pyrimidine derivatives as agonists of the cannabinoid receptor
1/2013/501726 2016.12.22	Crystalline forms and processes for the preparation of condensed azacycles (cannabinoid receptor modulators)

Fifteen of the applications have been marked as “Inactive” with its actual status either as abandoned for failure to meet the annuity payments, or not responding to office actions. As seen on the table, all the patents issued were for medical purposes.

There are several bills pending in the Philippine Congress to legalize medical cannabis, such as:

- House Bill 7817 (re-filing of HB 6517)
Title: AN ACT PROVIDING COMPASSIONATE AND RIGHT OF ACCESS TO MEDICAL CANNABIS, EXPANDING RESEARCH INTO ITS MEDICINAL PROPERTIES AND FOR OTHER PURPOSES
Date Filed: March 29, 2023
Bill Status: Pending with the Committee on DANGEROUS DRUGS since May 8, 2023

The bill’s proponent, former President Gloria Macapagal-Arroyo, said the current HB 6517’s “objective is for the patient to have access to safe, affordable, available medical cannabis prescribed by a registered treatment and management of specified symptoms, illnesses and diseases.” In the bill’s explanatory note, Arroyo said: “In the Philippines, thousands of patients suffering from serious and debilitating diseases will benefit from legalizing the medical use of cannabis.” She emphasized recent studies showing positive effects of cannabis use, and the fact that it is being recommended by many licensed physicians in the United States.

According to HB 7817, medical cannabis shall only be accessed through the Medical Cannabis Compassionate Center, an entity duly registered and licensed by the DOH and PDEA to acquire, possess, deliver, transfer, transport, cultivate, manufacture, store, import, sell, supply and dispense medical cannabis. The bill also provided that there shall be a cannabis plant monitoring system which will be used for testing and data collection

established and maintained by the cultivation facility and available for inspection for regulatory agencies for purposes of documenting each cannabis plant and for monitoring plant development throughout the life cycle from seed planting to final packaging.

It defined medical use as the use of medical cannabis to treat or alleviate a registered qualified patient’s debilitating medical condition or symptoms associated with his debilitating medical condition, and shall include its acquisition, possession, transportation, delivery, dispensation, administration, cultivation, or manufacturing for medical purposes.

The bill also states that no instance shall cannabis be used in its raw form.

- House Bill 6783
Title: AN ACT REMOVING CANNABIS AND ANY FORM OR DERIVATIVE THEREOF FROM THE LIST OF DANGEROUS DRUGS AND SUBSTANCES UNDER EXISTING LAWS, AMENDING FOR THE PURPOSE SECTIONS 3(J), 11, AND 16 OF REPUBLIC ACT NO. 9165, OTHERWISE KNOWN AS THE COMPREHENSIVE DANGEROUS DRUGS ACT OF 2002, AS AMENDED
Date Filed: January 16, 2023
Bill Status: Pending with the Committee on DANGEROUS DRUGS since March 21, 2023

This bill seeks to decriminalize marijuana use not only for medical purposes but also for recreational purposes. In its explanatory note, proponent Rep. Pantaleon Alvarez emphasized that marijuana’s benefits outweigh its supposed harm. He also explained that aside from its medical use, other reasons for legalizing cannabis are for economic and tax purposes.

Should any of the above pending bills get approved, it is expected that more cannabis patent applications will be filed. ^{AP}

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Editha R. Hechanova leads the HECHANOVA Group's intellectual property law practice. The HECHANOVA Group is made up

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**RUSSIA****Russia: Free use of patents**

Any process of creating a result of intellectual activity is accompanied by a certain source of inspiration, which can often be the same for several authors at once. As a consequence, two authors who do not know each other can create similar but creatively independent intellectual property objects.

In copyright law, this situation is called "parallel creativity". However, if copyright arises by virtue of its creation in an objective form, then in order to obtain exclusive rights to a patent, it is necessary to comply with a number of formalities established by law, in the form of obtaining a patent for the corresponding solution. In order to support the scientific, technical and design spheres, the legislator introduced a separate provision of the law, in which he granted authors who did not exercise their right to obtain a patent, but conscientiously use the patented technology, a special right called the "prior use right".

By virtue of paragraph 1 of Article 1361 of the Civil Code of the Russian Federation, *"a person who, prior to the priority date of an invention, utility model or industrial design (Articles 1381 and 1382), in good faith used on the territory of the Russian Federation an identical decision or decision created independently of the author, which differs from the invention only in equivalent features (paragraph 3 of Article 1358), or has made the necessary preparations for this, retains the right to further free use of the identical solution without expanding the scope of such use (the right of prior use).*

In other words, the right of prior use provides the possibility of free use of an identical solution to a certain extent without expanding it.

As noted by the Supreme Court of the Russian Federation in paragraph 126 of the Decree of the Plenum No. 10 of April 23, 2019,

"On the Application of Part Four of the Civil Code of the Russian Federation", *"the right of prior use does not arise by virtue of a court decision, but if there are 1 article 1361 of the Civil Code of the Russian Federation of the conditions...».*

When considering cases on establishing the right of prior use, the courts identified the following conditions:

- 1) the use by the prior user of a solution that is identical to the patented object;
- 2) creation of an identical solution regardless of the author;
- 3) good faith in the use of the solution;
- 4) use or preparation for use of an identical solution on the territory of the Russian Federation before the priority date of the patented object;
- 5) the amount of prior use.

Moreover, it is important for the prior user to simultaneously prove all the above circumstances (for example, the ruling of the Court for Intellectual Property Rights dated August 28, 2018, in case No. A71-13515 / 2017).

Meanwhile, the current legislation does not exclude the possibility of applying to the court with an independent claim (including a counterclaim) for the recognition (establishment) of the right of prior use (paragraph 126 of Resolution No. 10).

And if everything is quite clear with the use of an identical solution, then, as a rule, more questions arise in making the preparations necessary for this.

According to paragraph 128 of Decree No. 10, *"by virtue of paragraph 1 of Article 1361 of the Civil Code of the Russian Federation, the right of prior use arises for a person who has made the necessary preparations for using an identical technical solution protected by a patent for an invention, utility model or identical to a solution protected by a patent for an industrial design in appearance or a solution that differs from the invention only by equivalent features.*

In order to determine



the actions related to the implementation of the necessary preparations, paragraphs 2 and 3 of paragraph 128 of Decree No. 10 indicate that *“under the necessary preparation is understood as the intention established by the circumstances of the case to use at a particular enterprise an existing solution identical to the object protected by a patent at a technological stage that determines the procedure for its implementation, which can be objectively successfully implemented.”*

At the same time, it was noted that *“scientific and other studies not related to the direct introduction into production of the manufacturing technology of the product (product) or the application of the method do not constitute the necessary preparation for the use of an identical solution.”*

According to judicial practice, the purchase of the necessary raw materials, material, equipment for the production of products, the availability of production facilities, trained personnel, technical and accounting documentation, etc. can be taken into account as evidence of the necessary

preparations. (For example, the decision of the Nineteenth Arbitration Court of Appeal dated March 9, 2016, in case No. A14-9941 / 2015).

It is interesting that the right of prior use in itself is not negotiable, however, it can be transferred to another person together with the enterprise where the use of the identical solution took place or the necessary preparations were made for this. in accordance with paragraph 2 of Article 1361 of the Civil Code of the Russian Federation.

By virtue of the provisions of Article 132 of the Civil Code of the Russian Federation, *“an enterprise as an object of rights recognizes a property complex used to carry out entrepreneurial activities.”*

The structure of the enterprise as a property complex includes all types of property intended for its activities, including land plots, buildings, structures, equipment, inventory, raw materials, products, rights of claim, debts, as well as rights to designations that individualize the enterprise, its products, work and services (commercial designation,

trademarks, service marks), and other exclusive rights, unless otherwise provided by law or contract.”

In order to avoid qualifying the acquirer of such a property complex as an infringer of the exclusive right in the subsequent production of products using a patented technology, the parties are recommended to prescribe in the relevant agreement on the sale of the enterprise an independent condition on the inclusion of the right of prior use in the transferred enterprise.

Also, the actions of third parties to introduce goods using a patented solution into civil circulation, which were purchased from a prior user, are not a violation of exclusive rights to patents, since, by virtue of paragraph 6 of Article 1359 of the Civil Code of the Russian Federation, *“they are not a violation of the exclusive right to an invention, utility model or industrial design introduction into civil circulation importation into the territory of the Russian Federation, application, offer for sale, sale, other introduction into civil circulation or storage for these purposes of a product in which an invention or utility model is used, or a product in which an industrial design is used, if this product or this product was previously introduced into civil circulation on the territory of the Russian Federation by the patent owner or another person with the permission of the patent owner or without his permission, but on the condition that such introduction into civil circulation was carried out lawfully in the cases established by this Code.”*

Similar conclusions were made in the decision of the Nineteenth Arbitration Court of Appeal dated March 9, 2016, in case No. A14-9941/2015.

In the event of a dispute regarding the existence of the right of prior use, the burden of proving the absence of such a right lies with the person denying this right, since its existence is assumed until the opposite is proved (paragraph



29 of the Review of Judicial Practice in Cases Related to the Resolution of Disputes on protection of intellectual rights, approved by the Presidium of the Supreme Court of the Russian Federation on September 23, 2015).

At the same time, the prior user should not forget that, despite being given the opportunity to produce products using a patented technology, such production should always be limited to the amount determined on the priority date of the patent.

As explained in paragraphs 28, 30 of the Review, “in order to assess the scope of the right of prior use, it is necessary to take into account not only the actual use of the object of exclusive rights, but also the preparations made for this.

When determining the scope of use of an identical technical solution, it is necessary to take into account the criterion of the possibility of implementing this technical solution with all the resources that existed at the time of the creation of such a solution, as if they were all used only for the production of products based on it.

The rights of the prior user are limited to the scope of application of the identical solution that he achieved on the priority date, or, if the use was not started before this date, to the extent corresponding to the preparations made.

The prior user is not entitled

to use the identical solution to a greater extent than the one in which the solution was used or intended to be used before the priority date of the application. At the same time, the established scope of use of the identical solution must be documented.”

This position was further confirmed later by the Supreme Court of the Russian Federation in paragraphs 4, 5, 6 of clause 127 of Decree No. 10, where it was noted that “the quantitative change in the volume of output (in pieces, kilograms, meters, etc.) should not exceed the volume of use (necessary preparation for use), which took place before the priority date of the invention, utility model or industrial design, including that established by the court when recognizing the right of prior use.

To determine such a number, the court, at the request of the person participating in the case, or with the consent of the persons participating in the case, may appoint an expert examination.

Similarly, the territory of use of an invention, utility model or industrial design cannot be extended.”

In the event that the prior user nevertheless decides to expand the scope of use of the patented solution in any way, including by indicating the types of manufactured products, he will have to obtain permission

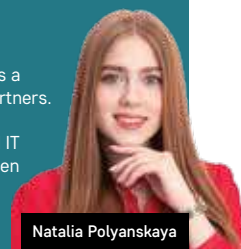
from the patent holder to use the patented invention, utility model or industrial design, in accordance with paragraph 3 of clause 127 Decree No. 10.

Accordingly, lawful introduction into civil circulation and subsequent use can be recognized only in relation to the volume of products, the use of which or the necessary preparations for which were achieved by the previous user before the priority date of the corresponding registered patent. In the rest, the volume of products that goes beyond the limits, in the absence of an appropriate permission, of the patent owner may be recognized as illegal use of patents.

Thus, the current legislation guarantees the protection of the exclusive rights not only of holders of patents for an invention, utility model or industrial design, but also of persons who have created and used in good faith an identical solution before the priority date of the corresponding patent, which, in my opinion, has a beneficial effect on scientific and technical and design field of activity. ^{AIPL}

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Natalia Polyanskaya is a lawyer at Zuykov and partners. Natalia has a degree in intellectual property and IT law. Polyanskaya has been working with Zuykov and partners since 2019 and is in charge of defending the interests of clients in courts and the Federal Antimonopoly Service, reviewing of dispute issues which are related to IP objects, and advising clients on issues related to the acquisition, protection, and disposal of IP rights.



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