RECENT IP UPDATES

ARGENTINA:

Applicants keep on struggling to get pharmaceutical patents in Argentina.

The new guidelines published in 2012 keep on putting obstacles and limitations to the patentability of pharmaceutical products. These guidelines are subject to revision of the competent Courts.

As of today, they contain provisions such as the following: A polymorph is not an invention but rather a property of the corresponding substance; when the molecular structure of a racemic compound is revealed, also its enantiomers are revealed for an expert in the art; the disclosure of the basic formula of compounds described through Markush formula equals to the disclosure of each compound resulting of the substitution of the radicals; a compound described through a Markush formula will have to be exemplified in the specification for it to be protected; there will be no selection inventions even if an element of the previously described group provides superior properties.

AUSTRALIA:

Patent Office indicates that it no longer has any reservations relating to the standards required for Electronic Filing and Processing of International Patent Applications

The Australian Patent Office announces that it is now in a position to withdraw its notification of incompatibility under Section 703(f) of the Administrative Instructions (in relation to filing requirements and the basic common standard as to the means of transmittal), with effect from 13 February 2015

CAMBODIA:

A MOU has been signed to recognize in Cambodia search and examination reports from the IP Office of Singapore.

On 20 January 2015, the Intellectual Property Office of Singapore and Cambodia's Ministry of Industry signed a Memorandum of Understanding according to which patent search and examination reports from IPOS will be recognized in Cambodia.

The MOU aims at facilitating the process for obtaining protection in Cambodia, although details of the work procedures between IPOS and MIH are not yet available.

CAMBODIA:

ZIMBABWE AND CAMBODIA - Accession to Madrid System.

The Madrid Protocol will enter into force, with respect to Zimbabwe, on 11 March 2015 and to Cambodia on 5 June 2015. With regard to Cambodia, said instrument of accession was accompanied by a declaration whereby the time limit of one year to notify a provisional refusal of protection is replaced by 18 months, and a provisional refusal resulting from an opposition may be notified after the expiry of the 18 month time limit.

CHINA:

China creates new specialized IP Courts.

Three specialized IP courts in Beijing, Shanghai and Guangzhou have become operational in China. The new IP courts will serve as the court of first instance for, among others, (1) technically complex civil and administrative patents cases, technology secrets, computer software, (2) administrative cases related to copyright, trade mark and unfair competition conducted by departments of the State Council or local people's governments at county level or above, and (3) civil cases involving the recognition of well-known trademarks. It is expected that this specialization will quickly increase the effectiveness of the legal system and the Chinese IP environment in general.

COSTA RICA:

The Patent Office's Practice in relation to granting fees is changing.

Until recently, the Patent Office was not enforcing the provision in Costa Rican Patent Law which set forth a deadline of three months as from the notification of favorable examination to pay the granting fees.

After serving the favorable notice, no deadline was applied. Going forward, examiners will now enforce the mentioned provision and will require payment of granting fees within a period of three months. This practice is expected to be applied to applications which have already received a favorable report but whose granting fees have not been paid.

RECENT IP UPDATES

EUROPE:

European Court of Justice: A resolution states that an organism which is incapable of developing into a human being does not constitute a human embryo within the meaning of the Biotech Directive.

The Court of Justice of the European Union issued a resolution providing some clarification regarding the meaning of human embryo used in the Biotech Directive. It concludes that an organism which is incapable of developing into a human being does not constitute a human embryo within the meaning of the Biotech Directive. Formerly, the European Court of Justice (C 34/10) sustained that the concept of "human embryo" includes unfertilized human ova whose division and further development have been stimulated by parthenogenesis, based on the fact that such ova are capable of commencing the process of development into a human being.

In the ECJ´s resolution it is held that in order to be considered a human embryo, an unfertilized human ovum must have the inherent capacity of developing into a human being. Consequently, the mere fact that a parthenogenetically activated human ovum can commence a process of development is insufficient for it to be regarded as a human embryo.

EUROPE:

"European Court of Justice" A resolution states that it is not possible to obtain a second SPC for a combination comprising a product containing an active ingredient (sole subject-matter of the invention) and a not novel substance.

In case C-577/13 the ECJ has resolved that when a basic patent claims a product comprising an active ingredient which is the sole-subject matter of the invention, it is not possible to obtain a second SPC conferring protection to a combination of that active ingredient and another substance which is not novel. read more

Based on this consideration, the ECJ did not answer the questions referred for a preliminary ruling related to the possibility of amending the claims after the grant of a patent and considers such amended claims to be the "basic patent in force" for the purposes of fulfilling the conditions set out in Article 3(a) of Regulation No. 469/2009

INDIA:

Amendments on design rules have entered into force, affecting the official fee structure.

On January 1st, the Indian Patent Office released a notice announcing the enforcement of the amendments to the Indian rules on designs.

These amendments basically affect the official fee structure and in certain administrative functions, introducing as well a new type of entity for calculation of applicable fees.

ISRAEL:

Circular on 3D Trademarks.

The Israeli Patent Office has issued a Circular which aims at providing clarity with regards to the possibility of registering shapes of objects and containers either as trademarks and/or as designs.

JAPAN:

Withdrawal of Notifications of Incompatibility of Certain PCT Rules with National Laws.

The Japan Patent Office withdraws certain notifications of incompatibility with its national law regarding the notification and effect on restoration of right of priority.

This means that the Japanese Office, as receiving or designated office, would consider requests for restoration of the right of priority and, if the necessary conditions are met, would accept such a decision made by another Office acting as receiving office (for international applications filed on or after 1 April 2015). Furthermore, the Japanese office has announced that it applies the "due care" criterion to requests for restoration of the right of priority, and no fees will be due for such requests.

JAPAN:

New Japanese Laws took effect on 1 April 2015.

As of 1 April 2015, Japanese IP laws were amended. Among other things, Patent Law will (1) adopt a post grant opposition system, 2) non-traditional marks including sounds, moving marks, holograms, colors will be protected and (3) the abandonment of an IP right may be avoided for a legitimate reason, even when a critical deadline has passed.

RECENT IP UPDATES

JAPAN:

US and Japan - Join the Hague System.

The United States of America and Japan have joined the Hague System for the International Registration of Industrial Designs, adding two of the world's biggest economies to a WIPO-administered registry that supports creators worldwide.

MEXICO:

New guidelines for approval and renewal of biological products.

Since 9 February 2015, new guidelines apply in Mexico for the approval and renewal of Biologics.

The Mexican Official Standard Rule NOM-257-SSA1-2014 for Biologics entered into effect. In addition to reinforce those provisions already existed in the Mexican Law to guarantee safety, efficacy and quality of biologics, it confers to the Evaluation Subcommittee on Biotechnological Products the authority to evaluate the data related to clinical trials, approval or renewal of innovator biologics and to evaluate the characterization of biologics as innovators, reference or bioequivalent products.

MOROCCO:

Morocco accepts validation of European Patents.

Applicants of European patents filed as of 1 March 2015 have the option of requesting validation in Morocco, which would have the same effect as a national Moroccan patent and whose enforcement will be subject to Moroccan patent law.

The formalities are similar to the validation in the other member states of the EPC and French or Arabic translation of the granted EP claims should be valid. European Patent applications will enjoy "provisional protection" in Morocco as with any other state party to the EPC.

NORWAY:

Norway does not require translation into Norwegian of the specification of European Patents granted after January 1st, 2015, as long as the patent is granted in English or an English translation is supplied.

On 26 September 2014, Norway joined the London Agreement. As a consequence, all European patents granted on or after 1 January 2015 will enjoy the provisions of the London Agreement pursuant to which a Norwegian translation of the specification will not be required as long as it is available in English (either because the patent has been granted in English or because an English translation has been provided).

However, a Norwegian translation of the claims is indeed required. It is relevant to note that these rules will not apply to patents granted before January 1st which are amended later on, within opposition, appeal or limitation proceedings.

SAUDI ARABIA:

The Saudi Patent Office has begun acting as a Patent Cooperation Treaty Receiving Office on 1 January 2015.

As a consequence of the Saudi Patent Office becoming a Receiving Office, international applications may be filed at the using WIPO's ePCT filing system.

The SPO received the first PCT national stage entries on 3 February 2015. The requirements, annuity due dates, and fees are the same as for national filings.

SINGAPORE:

PPH pilot program between the European Patent Office and the Intellectual Property Office of Singapore.

The EPO and the IPO of Singapore signed an agreement to set forth a pilot program enabling an applicant whose claims have been determined to be patentable to have a corresponding application filed with a PPH partner office processed in an accelerated manner.

A PPH request can be based either on the latest PCT work product (WO-ISA or IPER) or on the national work product established during the processing of a national application or a PCT application that has entered the national phase before the EPO or IPOS, where this work product determines one or more claims to be patentable. The PPH pilot program commenced on 6 January 2015 and will end on 5 January 2018.