

**RECENT IP  
UPDATES**

**AUSTRALIA:**

**Issuance of new Guidelines for Computer-Implemented inventions.**

On February 1st, 2016, the Australian Patent Office released the new guidelines for assessing whether computer-related inventions relate to patentable subject matter.

These considerations take into account, among other things, (i) whether the contribution of the claimed invention is technical in nature; (ii) whether the invention solves a technical problem within the computer, (iii) whether the claimed method merely requires generic computer implementation, (iv) whether the computer is merely an intermediary or tool for performing the method or (v) whether the alleged invention lies in the way the method or scheme is carried out in a computer.

**BRAZIL:**

**The Brazilian PTO strengthens its position against ANVISA's issuance of opinions.**

The Brazilian PTO strengthens its position against ANVISA's issuance of opinions regarding patentability of applications related to pharmaceutical inventions. Within the frame of a litigation raised by a pharmaceutical company against ANVISA, the Brazilian Patent Office has filed an opinion regarding the role that ANVISA is adopting in the examination of patent applications.

The Patent Office states that there is no legal provision supporting the issuance of opinions on patentability by ANVISA and claims for avoiding the "subterfuges" that ANVISA's interpretation imply. The divergent interpretation will most likely be maintained but this opinion reinforces the position of the Brazilian Patent Office against ANVISA's interference in the examination of patent applications.

**CHINA:**

**Announcement to introduce new measures to facilitate the prosecution of Trademarks.**

On March 24th, the Chinese Trademark Office announced the introduction of new measures to facilitate the prosecution of trademarks.

Some of the measures include (i) the possibility to request the expedition of some administrative procedures in case of emergency (for instance trademark assignment and renewal), (ii) the inclusion of more explanatory content in office actions to help applicants in making amendments, (iii) the possibility to share evidence in multiple connected oppositions or (iv) the extension of the scope of combined examinations on oppositions if the parties involved, marks opposed and the evidence are the same.

**COLOMBIA:**

**Obligation to pay Examination Fees after every amendment of the claims or spec.**

Some important changes recently imposed by the Colombian Patent Office, effective immediately, will impact the procedure of patent applications. The Colombian Patent Office has issued Resolution No.3719 dated February 2, 2016, by means of which it has regulated, (i) divisional and conversion of patent applications (a complete information will follow shortly as the changes need to be further explained) and (ii) the examination of patent applications in process.

In relation to this second (ii) issue, when the applicant in its response to the examination of patentability modifies: the claim chapter, the description of the invention or presents a new claim chapter, it is necessary to pay again, the fee for the examination of patentability. Please note that the Patent Office, if deemed necessary, can request up to two (2) new exams and/or office actions. However, the Patent Office will have 18 months from the publication of the patent application and 9 months for utility mode applications to issue the office actions. These changes are effective also to pending prosecution of patent applications.

**EUROPEAN PATENT  
OFFICES:**

**Pending enlarged board of appeal decision on partial priority.**

In case G1/15, the EPO's Enlarged Board of Appeal is considering the question of whether a patent publication can be cited as prior art against a second application which derives from the same parent.

The referral aims at obtaining clarification on the assessment of partial priority as well as regarding the so-called "poisonous divisional". A decision is expected during 2016.

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**EUROPEAN UNION: Trade Secrets.**

The European Parliament voted in favor of the Trade Secrets Directive on April. The Directive pretends to harmonize trade secrets laws across Europe, defying what constitutes trade secret and providing remedies for misappropriation.

Once the Directive is adopted and published, it will come into force. EU Member States will have two years to implement it into national law.

**GUATEMALA: Approval of Accession to the Trademark Law Treaty and Regulations, signed in Geneva on 1994.**

Guatemala has approved the accession to the Trademark Law Treaty (TLT) (1994), administered by the World Intellectual Property Organization which will enter into force on March 31, 2016. The accession is aimed at simplifying the filing of applications and expediting the registration of trademarks.

Among other things, it should result in the acceptance of multiclass applications. The TLT will have to be now implemented by the Guatemalan authorities.

**INDIA: New guidelines for Computer-related inventions**

On February 19th, the Indian Patent Office amended its guidelines to provide clarity for patent examiners and practitioners on patenting computer-related inventions (CRIs).

The guidelines, among other things, clarify that: (i) the substance of the invention must be evident outside of subject-matter that is otherwise excluded from patentability; (ii) all components must be fully described and shown; and (iii) any working relationships between components, and the effect of those relationships, must be described.

**INDIA: New trademark rules are expected.**

The new trademark rules have been published for "Public Comments". These changes bring significant Amendments to current Trademark Rules.

It needs to be highlighted that Official Fees may increase substantially (up to 110 per cent), including fees for new trademark application, request for expedited examination, renewal, title update, etc. It is highly recommendable to consider these changes as the new fees are expected to be applicable as soon as the changes are effective.

**INDIA: Stay on the abandonment of trademark applications and oppositions.**

On March 29th, 2016 the Indian Trademark Registry surprisingly decided to abandon approximately 200,000 applications and 20,000 oppositions.

After the confusion that this resolution created in the IP community, the High Court of Delhi issued a stay on all the abandonment orders that have been passed and directed not to undertake further abandonment of any trademark application without following due process provided under the Act. A hearing on May is expected to decide on this matter, which must be followed closely.

**INDONESIA: Issuance of the implementing regulation for recording license agreements.**

Current applicable Law in Indonesia requires that all license agreements regarding IP rights (copyright and related rights, patents, marks, industrial design, integrated-circuit layout design, and trade secrets) are registered for recordation at the Ministry of Law and Human Rights of the Republic of Indonesia.

Otherwise, the license agreement will not be opposable to third parties. On February 24th, 2016, the new Regulation setting forth the procedure to record such license agreements have been published. Once recordation has been effective, it is valid for a period of five years after which, a request for recordal will need to be refilled.

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JAPAN:

**Paris Route applications can be filed in any language / Examination handbook for Product-by-process claims.**

As of April 1st, Paris route applications filed in Japan can be filed in any language and then, within 16 months of the priority date, file the Japanese translation. [read more](#)

Also, on March 30th, the Japanese Patent Office published a Handbook on the examination of Product-by-process claims which should provide further indications to draft them in a manner acceptable for the Patent Office.

LAOS:

**License agreements need to be registered locally.**

The Lao People's Democratic Republic has notified that the recording of licenses in the International Register of the WIPO shall have no effect in the Lao People's Democratic Republic.

Consequently, a license relating to an international registration of a mark shall be recorded in the national Register of the Office of Lao People's Democratic Republic in order to have effect in such country.

SOUTH KOREA:

**Amendment of the patent and trademark laws.**

As of June 30th, some relevant amendments in the Korean Patent Act will enter into effect. Among others, (i) any interested party can file a cancellation action against a patent application, (ii) the time frame to request examination for patents filed after March 1st, 2017, will be shortened to 3 years from the filing date and (iii) the burden of proof in patent infringement actions will be switched to the alleged infringer, in case they do not produce relevant material or information if requested by the Court.

In relation to trademarks, a complete amendment of the Korean Trademark Law will be effective on September 1st, 2016. Changes such as the following are introduced: (i) a less restricted definition of "trademark" is used; (ii) any person (not only the interested ones) may file a cancellation action against a trademark registration; and (iii) a trademark may be rejected if a similar mark exists at the time of the registration (prior, if it had existed at any time before the registration, it could already be basis for an objection).

SOUTH KOREA -  
TAIWAN:

**The Taiwan-Korea Electronic Exchange of Priority Documents (PDX) Program launched on January 1, 2016.**

Under the PDX program, an applicant who first files an invention or utility model patent application with the TIPO and who subsequently files an application with the KIPO claiming priority of the earlier Taiwan patent application may request the KIPO to adopt electronic priority documents.

Such electronic priority documents can replace the paper priority documents. Likewise, an applicant who first files a patent application with the KIPO and later files an application with the TIPO may also claim priority of the earlier Korean application in the same manner. In addition, this PDX program is applicable to applications with priority claims filed within 16 months prior to the launch of this program.

TAIWAN:

**New Guidelines for examination of Design Patents.**

In April 2016, amended Guidelines for the substantive examination of design patents are applicable in Taiwan.

They have been amended to facilitate the practical implementation of the guidelines and affect, essentially, the interpretation of the disclosure of design drawings.

VIETNAM - JAPAN:

**Patent Prosecution Highway Pilot Program.**

Vietnam launched on April 1st a PPH pilot program with the Japan Patent Office applicable to Vietnamese patent applications (i) claiming priority to a Japanese application under the Paris Convention, (ii) PCT national stage entries in Vietnam of applications filed with the Japanese Patent Office without priority, as well as (iii) applications as indicated in (ii) which claim priority from a PCT application.

There may be other applications which may be eligible although requests will not be accepted if the Vietnamese Office has already started examination. The program is intended to be applicable for a period of three years.