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## 1. European Cooperation: Austria implements e-filing for trade marks

**AUSTRIAN  
PATENT OFFICE  
HAS IMPLEMENTED  
THE SOFTWARE PACK-  
AGE FRONT OFFICE  
FOR THE E-FILING OF  
TM EUIPO**

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*The Austrian Patent Office (Österreichisches Patentamt, ÖPA) has implemented the Software Package Front Office (SPFO) for the e-filing of trade marks, a tool developed under the EUIPO's European Cooperation Projects. The new e-filing system represents a step forward in the way trade marks are processed and registered and is expected to serve more than 5,500 trade mark applications per year. The e-filing software is able to process standard, fast track and divisional applications of trade marks.*

*ÖPA started the analysis phase of the project in March 2018, with the aim not only to start using a new software but to also contribute to the transposition of the Directive for new type of trade marks (Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks) as... [Read more](#)*

## 2. Expansion of the Patent Prosecution Highway between Japan and Brazil

**JPO AND THE  
NATIONAL INSTITUTE  
OF INDUSTRIAL  
PROPERTY OF BRAZI  
WILL EXPAND THE  
PPH BETWEEN THE  
TWO OFFICES TO  
MORE TECHNICAL  
FIELDS**

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*On April 1, 2019, the Japan Patent Office (JPO) and the National Institute of Industrial Property of Brazil (INPI) will expand the Patent Prosecution Highway (PPH) between the two Offices to more technical fields. Brazil, boasting the largest economy and population in South America, has recently been achieving dramatic economic development and attracting many manufacturers including automobile companies. Meanwhile, the INPI has been facing a serious problem with delays in patent examinations, spending over 10 years on average from receiving an application to issuing a notice of the first examination results. Given this situation, the JPO started a pilot program of the Patent Prosecution Highway (PPH)\*1 with the INPI on April 1, 2017 to allow companies that have obtained Japanese patents to obtain Brazilian patents in a shorter time. According to the INPI's website... [Read more](#)*

## 3. PCT Patent Prosecution Highway (PCT-PPH) Pilots

**NATIONAL  
INSTITUTE FOR  
THE DEFENSE OF  
COMPETITION AND  
INTELLECTUAL PROPER-  
TY PROTECTION (PERU)  
JOINS THE GLOBAL  
PPH PILOT**

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*National Institute for the Defense of Competition and Intellectual Property Protection (Peru) joins the Global PPH pilot. On 6 January 2019, the National Institute for the Defense of Competition and Intellectual Property Protection (Peru) joined the Global Patent Prosecution Highway (GPPH) pilot, bringing the number of Offices that have joined the pilot to 26.*

*It is recalled that under this pilot, it is possible to make a request for accelerated processing at any participating office based on work products (including, where applicable, a PCT written opinion from either the ISA or the IPEA, or an international preliminary report on patentability (IPRP) (Chapter II)), from any one of the other participating offices, provided that at least one claim has been found to be patentable by the office of earlier examination, and that any other applicable eligibility criteria are... [Read more](#)*

## 4. Information about Obtaining Patent Protection in Montenegro

**EPO, TO EXTEND  
EUROPEAN PATENTS  
AND EUROPEAN  
PATENT APPLICATIONS  
TO MONTENEGRO,  
INCLUDING APPLICA-  
TIONS FILED UNDER  
THE PCT**

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*It is recalled that since 1 March 2010, it has been possible, via the extension procedure of the European Patent Office (EPO), to extend European patents and European patent applications to Montenegro, including applications filed under the PCT (see PCT Newsletter No. 02/2010). The extension of a European patent to Montenegro via the PCT route is deemed requested for any PCT application, provided that neither the designation of Montenegro nor the designations of all Member States of the European Patent Convention are withdrawn. The Intellectual Property Office of Montenegro has informed the International Bureau (IB) that applicants wishing to obtain patents in Montenegro should enter the regional phase before the EPO, as there is no national phase in place before the Intellectual Property Office of Montenegro. In view of this, applicants should be aware of the... [Read more](#)*

## 5. WIPO Report: Both Chinese and Oversea Companies Potent in Patenting in China

**BOTH CHINESE  
AND OVERSEA  
COMPANIES POTENT  
IN PATENTING IN  
CHINA**

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*Both Chinese and foreign company are aggressively filing patent applications in China in a bid to take advantage of IP protection and promote commercialization of their IPRs, according to the World Intellectual Property Indicator (WIPI) issued by the World Intellectual Property Organization in Geneva, Switzerland. "At present, China is tightening the screw of IP protection, a step further from the previous policy of gradually enhancing protection. Chinese government's determination in creating a sound business climate is clear when it stressed protection of the lawful rights and interests of foreign businesses and heightening of IP protection," said Li Shunde, Researcher of Institute of Law, Chinese Academy of Social Sciences.*

*Innovators across the globe filed 3.17 million patent applications in 2017, up 5.8% for an eighth straight yearly .... [Read more](#)*

## 6. Amended German trademark law in force 14 January 2019

**THE TM LAW  
MODERNIZATION ACT  
WAS EXECUTED AND  
PUBLISHED IN THE FED-  
ERAL LAW GAZETTE ON  
11/14 DEC. 2018 AND  
WILL ENTER INTO FORCE  
ON 14 JAN. 2019**

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*The Trade Mark Law Modernization Act (MaMoG) was executed and published in the Federal Law Gazette (Bundesgesetzblatt) on 11/14 December 2018 and will enter into force on 14 January 2019. The Act contains revisions whose aim is to mainly transfer the provisions of EU Trade Mark Directive 2015/2436 of 16 December 2015 into German law. Most changes will have an immediate effect. Like in most other EU member states, the amendments will not fundamentally change the German trade mark law system. However, there are certain amendments which we deem relevant for trade mark owners:*

**Changes regarding term of protection and renewals :-**

*- The term of protection for trade marks registered on or after 14 January 2019 will end exactly ten years after the filing date and not, as before, ten years after the end of the month ... [Read more](#)*

## 7. Cadbury fails to safeguard UK purple TM registration

**CADBURY  
TRIED, AND UNFORTU-  
NATELY FAILED,  
TO SAFEGUARD, TO  
THE EXTENT POSSIBLE,  
ITS UK TRADEMARK  
REGISTRATION  
FOR THE COLOUR  
PURPLE**

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*This a case in relation to which Cadbury tried, and unfortunately failed, to safeguard, to the extent possible, its UK trade mark registration for the colour purple. Cadbury decided to take action to change the description of its 1995 UK trade mark registration no. 2020876a, for the colour purple, following the successful opposition by Nestlé against Cadbury's later filed application (dating from 2004) to register the colour purple under trade mark no 2376879. The 2004 trade mark application was refused on the basis that it was not considered to be a sign that is "graphically represented". The later application described the sign as "The colour purple (Pantone 2685C), as shown on the form of application, applied to the whole visible surface, or being the predominant colour applied to the whole visible surface, of the packaging of the goods". The earlier trade mark registration bears .... [Read more](#)*

## 8. Madrid E-Filing Now Available for Austrian Brand Owners

**AUSTRIAN  
TRADEMARK HOLDERS  
LOOKING TO PROTECT  
THEIR MARKS ABROAD  
CAN NOW APPLY  
ONLINE THROUGH  
MADRID E-FILING**

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*Austrian trademark holders looking to protect their marks abroad can now apply online through Madrid e-filing. The Madrid e-filing service is a simpler and more secure way for trademark applicants to expand the scope of international protection for their mark through the Madrid System.*

*Following the launch of the service in the Georgian IP office in November 2018, the Austrian Patent Office is now also offering the e-filing service to its trademark community. The Austrian Office for Trademark Applications highlights that applications via Madrid e-filing are not only cheaper than paper applications, but also include national fees in just one payment to WIPO.*

**Other benefits include:**

*- Reduced application irregularities, thanks to the national IP office's database prepopulating key information. [Read more](#)*

## 9. INTA Adopts Guidelines for Examination of Industrial Designs

**INTA BOARD OF DIRECTORS RECENTLY APPROVED A RESOLUTION ADOPTING GENERAL GUIDELINES ON A RANGE OF ISSUES RELATED TO THE EXAMINATION OF INDUSTRIAL DESIGNS**

**NEW YORK, NY** - The International Trademark Association (INTA) Board of Directors recently approved a resolution adopting general guidelines on a range of issues related to the examination of applications for industrial designs. According to INTA, the Guidelines for Examination of Industrial Designs are intended to serve as a reference document for Industrial Property Offices and are meant to reflect various international systems in an effort to harmonize design law practice. "These new guidelines will allow INTA to comment on the administration of designs by Industrial Property Offices and to assist Offices to set up and implement their practices and procedures," said INTA President Tish Berard. "INTA has been focusing on design rights themselves, independent of their impact on trademark law and practice. [Read more](#)

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## 10. Contribute to our Strategic Plan 2023 in our public consultation

**EPO IS INVITING ALL STAKEHOLDERS TO PARTICIPATE IN A PUBLIC CONSULTATION WHICH WILL PROVIDE INPUT FOR ITS STRATEGIC PLAN 2023**

The EPO is inviting all stakeholders to participate in a public consultation which will provide input for its Strategic Plan 2023. Stakeholder input will play a key role in helping us to formulate our strategic priorities for the next few years. The Strategic Plan will steer all our activities over the period 2019 to 2023 in different areas, be translated into concrete actions and projects and be subject to regular monitoring of progress and achievements.

**We invite your input on the following three topics:**

1. Evolution of the patent system and future challenges
2. Delivering high-quality products and services
3. Social responsibility and transparency

The public consultation will run until 15 March 2019. The Strategic Plan will be submitted to the Administrative... [Read more](#)

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## 11. EPO's new vice-presidents take up their posts

**STEPHEN ROWAN,  
EPO NEW  
VICE-PRESIDENT  
DIRECTORATE-  
GENERAL  
PATENT  
GRANTING PROCESS**

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*Stephen Rowan, Nellie Simon and Christoph Ernst have taken up their posts as vice-presidents at the European Patent Office (EPO). They were elected by the Administrative Council of the European Patent Organisation, the supervisory body of the Office, in October 2018 for a five-year term.*

*Stephen Rowan will head the EPO's Directorate-General Patent Granting Process, which is responsible for the entire patent granting process from end to end, including search, examination, publication, opposition and all related formalities, and for delivering support for the patent granting process to internal and external users of EPO services. Mr Rowan joins the EPO from the UK Intellectual Property Office, where he most recently served as Director of Patents, Trade Marks, Designs and Tribunals. He has extensive experience in intellectual property, working across ... [Read more](#)*

## 12. Trade Secret Disputes: Identifying Mutual Interest in the Face of Major Disagreement

**IT'S A CHALLENGE  
TO RESOLVE BUSINESS  
DISPUTES WHEN  
EMOTIONS RUN HIGH,  
WHICH INCLUDES  
ALMOST ALL TRADE  
SECRET CASES**

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*"The most popular way of getting more streamlined resolution is arbitration. A major advantage of arbitration is that it is completely private. But there are some systemic drawbacks of arbitration for trade secret disputes. I am willing to put the case into any shape you choose. – Lord Ellenborough, 1816 It's a challenge to resolve business disputes when emotions run high, which includes almost all trade secret cases. So, I was especially pleased when, in a hard-fought litigation where I had been appointed as a "referee" to resolve discovery disputes, both lawyers eventually reached out to tell me how much they appreciated my involvement in the case, which had settled.*

*What was it about this variation on typical legal combat—where a private party is selected to rule on some important aspects—that they found so satisfying? First, they had saved their clients a lot of time, and probably money, compared to the... [Read more](#)*

## 13. New Non-Legislative Instruments for Patents, Trade-marks, Designs and Plant Breeder's Rights

**IP LAWS  
AMENDMENT ACT  
2018 MOVES A  
NUMBER OF FILING,  
FORMALITY AND  
FEE-PAYING  
REQUIREMENTS  
TO NON-LEGISLATIVE  
INSTRUMENTS**

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**ANBERRA** - *The Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Act 2018 (IP Amendment Act) moves a number of filing, formality and fee-paying requirements to non-legislative instruments. These instruments will commence on February 24, 2019, along with Parts 3, 7 and 14 of Schedule 2 to the IP Amendment Act. Moving these requirements to non-legislative instruments provides flexibility to adopt more efficient processes as they become available, according to the official website of Australia IP. IP Australia has published the instruments in preparation for commencement. They set out the requirements in relation to: The approved and preferred means of paying a fee, the means and form of filing evidence and opposition documents, and the means and form of filing/lodging/giving documents, in accordance with ... [Read more](#)*

## 14. USPTO Announces Revised Guidance for Determining Subject Matter Eligibility

**USPTO  
ANNOUNCED  
IN A PRESS RELEASE  
REVISED GUIDANCE  
FOR SUBJECT  
MATTER ELIGIBILITY  
UNDER 35 U.S.C. § 101**

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**WASHINGTON** – *The United States Patent and Trademark Office (USPTO) announced in a press release revised guidance for subject matter eligibility under 35 U.S.C. § 101. The USPTO also announced guidance on the application of 35 U.S.C. § 112 to computer-implemented inventions. The documents take effect Monday, January 7, 2019.*

*"These guidance documents aim to improve the clarity, consistency, and predictability of actions across the USPTO," said Under Secretary of Commerce for Intellectual Property and Director of the USPTO Andrei Iancu. "The USPTO will provide training to examiners and administrative patent judges on both documents to ensure that guidance is being properly administered."*

*The "2019 Revised Patent Subject Matter Eligibility Guidance" makes two primary changes to how patent exam.... [Read more](#)*

## 15. Copyright Registration of an Art Work irrelevant for proving its use as Trade Mark, Delhi HC

**DELHI HIGH COURT HAS HELD THAT COPYRIGHT REGISTRATION OF AN ART WORK IS IRRELEVANT FOR THE PURPOSE OF PROVING ITS USE AS TRADE MARK**

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The **Delhi High Court** has held that Copyright registration of an art work is irrelevant for the purpose of proving its use as Trade Mark. The order was passed by a Single Judge Bench of Justice Suresh Kait in a challenge to the Intellectual Property Appellate Board's (IPAB) order dismissing the Petitioner's plea seeking registration of its trademark. By way of background, M/s Khushi Ram Behari Lal (Export Division) was established in 1978 and carried on the business of processing, marketing and exporting of rice. The rice was sold under the trademark 'TRAIN BRAND WITH DEVICE OF TRAIN' (trademark). In 1996, the Firm was taken over as a going concern by the Petitioner, M/s. Khushi Ram Behari Lal Ltd. Subsequently, the name of M/s. Khushi Ram Behari Lal Ltd. was changed to be M/s. KRBL Ltd. In order to acquire..... [Read more](#)

## 16. DIPP's Proposed Patent Rules Amendment to Legitimize India-Japan Patent Prosecution Highway

**POST BY ROSHAN JOHN, EXAMINING THE AMENDMENTS PROPOSED PATENT RULES 2018 AMENDMENT TO LEGITIMIZE INDIA-JAPAN PATENT PROSECUTION HIGHWAY**

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We're pleased to bring to you an insightful guest post by Roshan John, examining the amendments proposed by the recently published Draft Patent (Amendment) Rules, 2018 in light of the India's recent agreement with Japan on having a patent prosecution highway program. Roshan works as a Trade and IP analyst for Access Campaign of Médecins Sans Frontières.

**Roshan John :-** The Department of Industrial Policy and Promotion (DIPP) had recently notified "Draft Rules" to further amend the Patent Rules, 2003. The Draft Rules seek to (a) expand the list of applicants who can apply for an expedited examination of the application and (b) amend the rules of procedure of pre-grant opposition. The Patent Rules details the procedure to be followed while implementing the provisions of the Patents Act, 1970 and guides the Indian Patent Office (IPO) in..... [Read more](#)