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## 1. Irish Supreme Court clarifies patent injunction test

**HOLDERS OF  
PATENT-LIKE RIGHTS IN  
THE MEDICINES MARKET  
ARE NOT  
AUTOMATICALLY  
BARRED FROM WINNING  
INJUNCTIONS...**

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*Holders of patent-like rights in the medicines market are not automatically barred from winning injunctions to prevent generics launching rival products when there is an ongoing dispute over the validity of their rights even if it is possible to compensate them for the loss of their monopoly with damages in the event validity is subsequently proven, Ireland's Supreme Court has said. The Court confirmed the position when considering the legal test for determining when applications for interlocutory injunctions should be granted in cases where there is a dispute over the validity of supplementary protection certificates (SPCs). SPCs serve to extend the life of patents owned by pharmaceutical manufacturers by up to a maximum of five years... [Read more](#)*

## 2. Brazil: Notification for Individual Fee in International Applications

**MADRID  
PROTOCOL AND  
NOTIFICATION MADE  
UNDER RULE 34(3)(A)  
OF THE COMMON  
REGULATIONS: BRAZIL**

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*The Government of Brazil has declared, under Article 8(7) of the Madrid Protocol, that it wants to receive an individual fee when Brazil is designated in an international application, in a designation subsequent to an international registration and in respect of the renewal of an international registration in which Brazil has been designated. Together with that declaration, the Government of Brazil has, under Rule 34(3)(a) of the Common Regulations, notified the International Bureau of WIPO that the individual fee in respect of a designation of Brazil is to be paid in two parts. In accordance with Rule 35(2)(b) of the Common Regulations under the Madrid Agreement and Protocol, the Director General of WIPO has, after consultation with.. [Read more](#)*

## 3. New measure for acknowledging claim of priority of design patents comes into force

**NEW MEASURE  
FOR ACKNOWLEDGING  
CLAIM OF PRIORITY  
OF DESIGN PATENTS  
COMES INTO  
FORCE**

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*On claiming priority of design patents, in the future, only when it is discovered that the date of a previous application or the date of publication of relevant data falls between the claimed priority date and the filing date of a later application, may the competent authority decide whether to recognize the priority claim or not, based on verification documents. If it is not discovered during the search, in principle, the priority claim will be published in the Patent Gazette as requested by the applicant. If the applicant makes several priority claims at once, based on the aforementioned principle, the claims will still all be published in the Patent Gazette. However, this does not mean the... [Read more](#)*

## 4. EMA Offers Edits on FDA Draft Guidance on Biosimilars

**EUROPEAN  
MEDICINES AGENCY  
OFFERS EDITS ON FOOD  
AND DRUG  
ADMINISTRATION  
DRAFT GUIDANCE ON  
BIOSIMILARS**

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*Although regulators rarely offer public comments on another regulator's guidance, the European Medicines Agency (EMA) late last month offered line-by-line comments and edits on a recently released draft guidance from the US Food and Drug Administration (FDA) on comparative analytical assessments for biosimilars. While noting the close collaboration between EMA and FDA on the statistical aspects of comparative analytical assessments, the EMA comments feature questions for clarification, recommendations to omit and areas of commonality. EMA pledges its support for the sections of the guidance related to the preparation of a "(prospective) comparative analytical assessment plan" and "accounting for lots/batches to.. [Read more](#)*

## 5. China Ranks 14th in 2019 Global Innovation Index

**WIPO  
RELEASED  
THE 2019 GLOBAL  
INNOVATION  
INDEX REPORT (GII)  
IN INDIA**

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Recently, the World Intellectual Property Organization (WIPO) released the 2019 Global Innovation Index Report (GII) in India. According to the GI, China ranks 14th, ascending three spots to join the ranks of the top 15 innovative economies for the first time. "I am very pleased to see that China ranks 14th in the Global Innovation Index this year and completes its goal of 'making the top 15 of Global Innovation Index in 2020' ahead of schedule. The efforts of the Chinese government and enterprises have paid off," Sacha Wunsch-Vincent, head of the Economics and Statistics Division of WIPO made the above assessment and applauded China's achievements Wunsch-Vincent be... [Read more](#)

## 6. Patent Litigation: Dutch Court of Appeal guidance on formal entitlement to priority

**COURT OF APPEAL  
OF THE HAGUE RULED  
ON THE FORMAL  
ENTITLEMENT TO  
PRIORITY FOLLOWING  
FROM A US PROVIS.  
PATENT APPLICATION**

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On 30 July, the Court of Appeal of The Hague ruled on the formal entitlement to priority following from a US provisional patent application (judgment in Dutch here). The attack on priority in this case is part of a recent trend by parties in patent litigation which aims to challenge entitlement to invoke priority under the Paris Convention and the European Patent Convention. Biogen Inc., F. Hoffmann-La Roche AG and Genentech Inc. jointly own a European Patent ("EP") which invokes the priority of a US provisional patent application ("P1"). P1 was filed by the two inventors, as was required under US law at that time. At the time of filing P1, one of the inventors was a Biogen employee (the "Inventor"). The EP originates from an international ... [Read more](#)

## 7. INTA Collaborates with Chinese Officials to Encourage Improvements in Trademark Registration Process

**INTA DELEGATES  
MEET WITH THE  
CHINA NATIONAL IP  
ADMINISTRATION  
IN BEIJING,  
CHINA**

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*With 4.34 million trademark applications filed in the first half of 2019, and an examination period of only five months, China remains the world's largest filer of trademark applications. Against this backdrop, INTA President David Lossignol (Novartis Pharma AG, Switzerland) led a delegation in early July to engage with the China National Intellectual Property Administration (CNIPA) in Beijing, China. Discussions included CNIPA's priority of implementing the amended Trademark Law, which becomes effective November 1, 2019, and ways in which INTA and CNIPA can work together to combat the issue of bad-faith trademark applications. CNIPA Deputy Commissioner Zhao... [Read more](#)*

## 8. Invalidation of Chinese patent based on a finding of lack of domestic priority

**INVALIDATION  
OF CHINESE PATENT  
REEXAMINATION  
BOARD BASED ON A  
FINDING OF LACK OF  
DOMESTIC PRIORITY**

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*Recently, the Chinese Patent Reexamination Board (PRB) published a written decision where patentee Chen He's Electric Unicycle patent (CN102275621B) was invalidated based, partly, on a failure to establish sufficient domestic priority. The case is significant because of: a) its consideration of whether the patent can be invalidated due to not applying for a foreign filing license (FFL) and b) its two-part test for establishing domestic priority. **Requirements for a foreign filing license:-** The requirements for a foreign filing license are set out in Article 20, paragraph 1 of the Chinese Patent Law. This Article 20 requires that for any technical subject matter pertaining to invention and utility model applications that are completed in China, the appli.. [Read more](#)*

## 9. IPR challenges already subject to civil action will be denied: PTAB

**INTELLECTUAL  
PROPERTY RIGHTS  
CHALLENGES  
ALREADY SUBJECT  
TO CIVIL ACTION WILL  
BE DENIED: PTAB**

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*The US Patent Trial and Appeal Board (PTAB) has designated an earlier decision, in which it denied an inter partes review on the basis that claims of the disputed patent had already been challenged in a civil action, as precedential. The designation, yesterday August 29, was of a decision in a patent dispute between Cisco Systems and non-practicing entity Chrimar Systems. Cisco had asked the board to review several claims of one of Chrimar's patents (US number 8,902,760 B2) which relates to a system for managing, tracking and identifying remotely located electronic equipment. According to Chrimar, one of the difficulties in managing a computerised office envir... [Read more](#)*

## 10. New USPTO rule: Applicants and registrants to provide email address

**NEW UNITED  
STATES PATENT AND  
TRADEMARK OFFICE  
RULE: APPLICANTS AND  
REGISTRANTS TO  
PROVIDE EMAIL  
ADDRESS**

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*The USPTO's new all-electronic processing initiative has imposed a new requirement on all applicants and registrants to update their application and registration records to provide an email address for correspondence with the office. That requirement is effective as of 5 October 2019 and applies even for applications that already identify an appointed attorney for USPTO communications. The email address will appear in the USPTO's public records and will not be private. Accordingly, our recommendation is to provide a general contact email address rather than one associated with a particular person to avoid the necessity of frequent updates/revisions with internal changes of personnel. And, of course, to make sure that general... [Read more](#)*

## 11. USPTO Now Requires U.S. Licensed Attorneys in all Trademark Matters

**UNITED STATES  
PATENT AND  
TRADEMARK OFFICE  
NOW REQUIRES U.S.  
LICENSED ATTORNEYS  
IN ALL TM MATTERS**

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*As of August 3, 2019, the U.S. Patent and Trademark Office ("USPTO") now requires that all foreign-domiciled[1] trademark applicants and registrants, as well as foreign-domiciled parties to Trademark Trial and Appeal Board ("TTAB") proceedings, must be represented by an attorney who is licensed to practice law in the United States. This U.S. attorney requirement applies to all foreign entities, and includes individuals and entities domiciled in Canada [2]. At present, foreign entities filing applications via the Madrid Protocol may still do so without U.S. counsel because the International Bureau's form does not offer the option of designating a U.S. attorney. For Madrid Protocol fil... [Read more](#)*

## 12. Earlier international preliminary examination under PCT Chapter II

**EARLIER  
INTERNATIONAL  
PRELIMINARY  
EXAMINATION TO BEGIN  
EARLIER FOR APPLICANT  
WHO CHOOSE TO ENTER  
PCT CHAPTER II.**

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*As of 01 July 2019, changes to Rule 69.1(a) PCT encourage international preliminary examination to begin earlier for applicants who choose to enter PCT Chapter II. Chapter II is an optional stage of the PCT that allows examination of an application in the international phase. When entering Chapter II, users may voluntarily amend their application and engage in discussion with international examiners. Users often enter Chapter II with the goal of obtaining a positive International preliminary examination report (IPRP) indicating that their application meets the major requirements for the grant of a patent. A positive IPRP is not legally binding, but it can be a useful tool for speeding up grant of an application in.. [Read more](#)*

### 13. Accelerated processing before the EPO Boards of Appeal

**ACCELERATED  
PROCESSING BEFORE  
THE EUROPEAN  
PATENT OFFICE (EPO)  
ANNUAL REPORT OF THE  
BOARDS OF APPEAL**

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*Appeal proceedings at the European Patent Office (EPO) typically last in excess of three years, but can last significantly longer (according to the 2017 Annual Report of the Boards of Appeal, technical appeal proceedings lasted 38 months on average, but some cases had been pending for eight years). With this long duration of proceedings, it is no surprise that there is a substantial backlog of pending cases (over 9,000 at the end of 2018, according to the 2018 Annual Report of the Boards of Appeal). Often appeal proceedings concern matters of great commercial importance to, for example, applicants/proprietors looking to work, license or enforce a patent, and opponents... [Read more](#)*

### 14. USPTO Proposes Fee Hikes And New Fees

**USPTO HAS TAKEN  
ANOTHER MAJOR STEP  
IN THE FEE-SETTING  
PROCESS FOR FEE  
ADJUSTMENTS IT  
EXPECTS TO IMPLEMENT  
IN JANUARY 2021**

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*The USPTO has taken another major step in the fee-setting process for fee adjustments it expects to implement in January 2021, and published the proposed fees in the Federal Register. The major changes are the same as those originally proposed in August of 2018, and include two new fees that will impact all applicants and practitioners. As before, all fees not specifically targeted for adjustment will increase by about 5%. Public comments are due by September 30, 2019.*

**USPTO Fee-Setting Process** - Under the Leahy-Smith America Invents Act (AIA) the USPTO fee-setting process is a multi-step process that requires input from the Patent Public Advisory Committee (PPAC), a public hearing, and a public notice and comment period. We are now at the public notice... [Read more](#)